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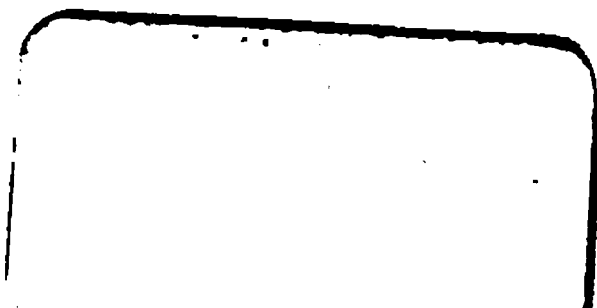
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REPORTS
OF
CASES ARGUED AND DETERMINED
IN THE
Circuit Court of the United States
FOR THE SECOND CIRCUIT.

BY SAMUEL BLATCHFORD,
AN ASSOCIATE JUSTICE OF THE SUPREME COURT OF THE UNITED STATES.

VOLUME XX.

:

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JUDGES
OF THE CIRCUIT COURTS OF THE UNITED STATES
WITHIN THE SECOND CIRCUIT,
DURING THE TIME OF THESE REPORTS.

**WARD HUNT, Associate Justice of the Supreme Court
of the United States.***

**SAMUEL BLATCHFORD, Associate Justice of the
Supreme Court of the United States.***

**SAMUEL BLATCHFORD, Circuit Judge of the Second
Judicial Circuit.†**

**WILLIAM J. WALLACE, Circuit Judge of the Second
Judicial Circuit.†**

DISTRICT JUDGES.

ADDISON BROWN, Southern District of New York.

**WILLIAM J. WALLACE, Northern District of New
York.†**

ALFRED C. COXE, Northern District of New York.‡

**CHARLES L. BENEDICT, Eastern District of New
York.**

HOYT H. WHEELER, Vermont.

NATHANIEL SHIPMAN, Connecticut.

* The Honorable **WARD HUNT** resigned the office of Associate Justice of the Supreme Court of the United States, and the Honorable **SAMUEL BLATCHFORD** was appointed in his place March 27th, 1882, and took the oath of office April 3d, 1882.

† The Honorable **SAMUEL BLATCHFORD** resigned the office of Circuit Judge of the Second Judicial Circuit, and the Honorable **WILLIAM J. WALLACE** was appointed in his place April 6th, 1882, and took the oath of office April 25th, 1882.

‡ The Honorable **WILLIAM J. WALLACE** resigned the office of Judge of the District Court of the United States for the Northern District of New York, and the Honorable **ALFRED C. COXE** was appointed in his place May 4th, 1882, and took the oath of office May 15th, 1882.

***** The following corrections should be made in this
Volume:***

Page 278, line 28 of syllabus, for "same" read "some."

" 467, " 6 " " " "license" read "lease of a machine."

" 499, " 18 " " " "destructive" read "distinctive"

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C A S E S

ARGUED AND DETERMINED

IN THE

Circuit Courts of the United States

WITHIN THE SECOND CIRCUIT.

IN THE MATTER OF GEORGE ESSELBORN, ON HABEAS CORPUS.

A person was, on an examination on a criminal complaint, committed by a Commissioner to await the action of the grand jury. On a *habeas corpus* and a *certiorari*, the Court allowed the accused to depart without giving any recognizance, subject to the issuing of a new warrant of arrest, if ordered by the Court. After the lapse of five months, the Court was asked by the accused to determine whether the evidence before the Commissioner was sufficient to warrant his commitment. Meantime a grand jury had met and been discharged, without indicting the accused, and no information had been filed against him. He was not in actual or constructive custody: *Held*, that the Court would not determine the said question, and that, if desired, an order would be entered discharging the accused, because no indictment or information had been filed against him.

(Before BLATCHFORD, J., Southern District of New York, September 20th, 1881.)

BLATCHFORD, J. In this case, a writ of *habeas corpus*, returnable before this Court forthwith, was issued on the 5th of April, 1881, to the marshal of the United States for this District, to produce the body of George Esselborn, with the cause of his imprisonment. At the same time a writ of *certiorari*, returnable before this Court forthwith, was issued to a United States Commissioner to certify the cause of the detention of said Esselborn. The Commissioner certified the proceedings before him, consisting of a complaint, alleging a

In re George Esselborn, on Habeas Corpus.

criminal offence, and the testimony taken on the examination on the surrender of the defendant on the complaint. The return of the marshal to the writ showed that a warrant of arrest on the complaint was issued by the Commissioner to the marshal; that the defendant appeared before the Commissioner, and an examination was had, and the defendant was held to await the action of the grand jury; that, for the purpose of enabling a writ of *habeas corpus* and a writ of *certiorari* to lie, the Commissioner ordered that the defendant be discharged on his own recognizance; that the defendant refused to give such recognizance; and that the Commissioner then committed the defendant to the custody of the marshal in default of his having given such recognizance. The case came before the Court on the foregoing papers, and, on the 5th of April, 1881, the Court made an order "that the defendant may depart without giving any recognizance, subject to the issuing of a new warrant of arrest, if ordered by this Court." Nothing has since been done in the matter, and the counsel who appeared for the defendant, now, in September, 1881, asks the Court to pass on the question as to whether the evidence before the Commissioner constituted probable cause for holding the defendant to await the action of the grand jury, and to hold that it did not, and to discharge the defendant. The District Attorney states, that, since the said order of April 5th, 1881, was made, a grand jury has met and been discharged without indicting the defendant; that no information has been filed against him; that he is not in actual or constructive custody; that there is nothing to discharge him from; and that it would be a waste of time to pursue the *habeas corpus* proceedings any further.

Under § 752 of the Revised Statutes, the writ of *habeas corpus* is granted "for the purpose of an inquiry into the cause of restraint of liberty." There is not now in this case any such restraint of liberty, or any such state of facts as requires that this Court should pass on the question as to whether the defendant ought originally to have been held or committed to await the action of the grand jury, even if it

The New York Bung and Bushing Company v. Hoffman.

would at any time have passed on that question. The defendant was held and committed only to await the action of the grand jury, and, as no indictment or information has been filed against him, he is entitled to be discharged on that ground, and an order to that effect and for that cause may be entered, if desired.

Sutherland Tenney, (Assistant District Attorney,) for the United States.

Roger M. Sherman, for the defendant.

THE NEW YORK BUNG AND BUSHING COMPANY

vs.

JACOB HOFFMAN. IN EQUITY.

Re-issued letters patent No 8,488, granted November 12th, 1878, to William C. McKean, George H. Jackson, and Jefferson Brown, Jr., for an "improvement in bushings for faucet holes," the original patent, No. 141,473, having been granted to Samuel R. Thompson, August 5th, 1873, are for an invention not described in the original, the original being for a particular form of wooden bushing, encased in an iron one, and the re-issue being for any form of wooden bushing in an iron one.

The original patent was not void for want of novelty.

The defendant was held to have infringed, because he furnished wooden bungs in iron casings, with a hole nearly through the bung, and intended to become the compound bushing of the re-issue, by the driving in of the remaining wood by the purchaser, by inserting a vent tube in tapping the barrel.

(Before WHEELER, J., Southern District of New York, September 29th, 1881.)

WHEELER, J. This suit is brought upon letters patent No. 141,473, dated August 5th, 1873, issued to Samuel R. Thompson, for an "improvement in bushings for faucet

The New York Bung and Bushing Company v. Hoffman.

holes," and re-issued, November 12th, 1878, in No. 8,483, to William C. McKean, George H. Jackson and Jefferson Brown, Jr., assignees, and now owned by the plaintiff. The principal defences set up are, that the original patent was void for want of novelty; that the re-issue is for an invention different from that described in the original; and that the defendant, in what he does, does not infringe.

The only anticipations necessary to be noticed are the English patent to William Rowland Taylor, dated August 6th, 1864, and sealed February 3d, 1865, for, among other things, the employment in beer barrels of peg holes smallest in the middle of the stave, and conical both outward and inward; the patent of the United States to John Ruegg, assignor to J. G. Marriott, No. 70,024, dated October 22d, 1867, for a wooden bung screwed into an iron casing or bushing, having screw threads on both its outer and inner circumference, and screwed into the stave of beer barrels; the patent No. 111,352, dated January 31st, 1871, issued to Josiah Kirby, for wooden bungs, with a hole in the middle for a vent tube, filled with a plug, both bung and plug being made with the grain of the wood running horizontally; and the patent No. 123,789, dated February 20th, 1872, to Otto Netzow and John F. Heck, for an elastic bushing for faucets, tapering towards the interior of the barrel, both on its outer and inner circumferences, with a shoulder on the inside at the inner end, to bear against the inner end of the faucet.

The original patent of Thompson was for a wooden bushing having the hole for the faucet smallest in the middle and conical both outward and inward, screwed into another bushing or casing made of iron, with screw threads, to be screwed into the barrel. The claims were for the bushing, constructed and arranged as described, and for the combination of the bushing and casing, constructed and arranged as described, for the purposes specified. The specification of the re-issue states, that "the invention consists, broadly, in a device composed of a rigid sleeve or casing, to be inserted within the faucet hole, and provided with a yielding lining:" and

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the claims are for a compound bushing for faucet holes of barrels, consisting of a rigid sleeve or casing, and a yielding lining, as set forth, and the combination of a casing and a lining having a double beveled internal formation, as shown and described, and for the purpose set forth.

The defendant sells beer in casks having iron casings screwed into the staves, for the bung, like that in the Ruegg patent, and like that for the wooden bushing in the plaintiff's patent, with bungs having a hole nearly but not quite through them, in the centre, filled with a plug to be driven in by a vent tube, carrying with it the solid portion of the bung opposite, when the barrels are tapped, like the bungs described in patent No. 148,747, dated March 17th, 1874, and re-issued in No. 5,937, dated June 30th, 1874, to Rafael Pentlarge, for an improvement in bungs for casks. When these bungs are so tapped by the insertion of the vent tube, the remaining portion of the bung, with the iron casing about it, forms a compound bushing of wood within iron, for the vent tube, similar to that described in the plaintiff's re-issued patent for faucets, and the defendant sells the beer in casks provided with such bungs and casings, intending and expecting that the bungs will be so tapped with vent tubes, and used until the beer is withdrawn, and that then the barrels will be returned to be refilled and supplied with new bungs, and the process repeated.

It is true, as has been argued for the defendant, that the double-conical hole for the faucet is shown in the double-conical peg hole in the patent of Taylor, and the rigid casing for the wooden bushing in the iron casing for the wooden bung, in the patent of Ruegg, the simple wooden bushing of the re-issue in the yielding bushing of the patent of Netzow and Heck, and the wooden bushing of a vent tube driven through a bung in the patent of Kirby; but still, as argued for the plaintiff, no one of these shows all the elements of this invention, as shown in either the original patent or the re-issue. None of them had a yielding bushing, like one made of wood, in an iron outer bushing or casing, forming a com-

The New York Bung and Bushing Company v. Hoffman.

pound bushing, yielding to the faucet or vent tube, and rigid and supporting to the barrel as the plaintiff's bushing and casing is. It is also true, as has also been argued for the defendant, that the defendant does not himself make, or use, or vend to others to be used, the whole patented invention of the plaintiff, so but that, if the whole stopped where he stops, there would be no infringement. But it does not stop there; he furnished the means which afterwards became, and intended they should become, the compound bushing described in the re-issued patent, and in that manner directly procured the infringement to be done, if any was done, by those tapping the bungs to draw the beer, and he is himself liable, if any one is, for that infringement. (*Wallace v. Holmes*, 9 *Blatchf. C. C. R.*, 65; *Cotton Tie Supply Co. v. McCready*, 17 *Id.*, 291.) So, the original patent was valid, and the re-issued patent is infringed, and the turning question in the case is, whether the original patent will support the re-issue.

The original patent described a wooden bushing inside an iron one, or a yielding one inside a rigid one, and, if the description had been general, as this statement is, it would have covered what the re-issue describes and claims broadly. Such, however, is not the case. The original describes the double conical form of wooden or yielding bushing only, and this form is described to be of the very essence of that part of the invention, and of the combination of which the wooden bushing was an important part. Thompson was not the original inventor of bushings, nor of wooden bushings, nor of iron bushings, for which any patent has been granted, underlying all others of either class, so as to give a monopoly of them: he is subsequent to Taylor, Ruegg, and Kirby, and could only have a patent for what was distinguishable from their inventions, and his patent could be valid only for that. (*Railway Co. v. Sayles*, 97 *U. S.*, 554.) The form of the wooden bushing was an important part of what so distinguished it, and, when form is of the substance of an invention, it is not to be disregarded. (*Machine Co. v. Murphy*, 97 *U. S.*, 120.) Thompson invented a particular form of wooden bush-

McCloskey v. Dubois.

ing, encased in an iron one, and took a patent for that, describing no other. The re-issue is for any form of wooden bushing in an iron one. That is for an invention not described in the original. If he had discovered, as he now has, that other forms were useful, he might, doubtless, have had a patent covering them, or, if he had described them in his patent, had a valid re-issue covering them, but he did not do either.

Let there be a decree dismissing the bill, with costs.

Wyllys Hodges, for the plaintiff.

Preston Stevenson, for the defendant.

JOHN McCLOSKEY

v8.

FREDERICK N. DUBOIS AND OTHERS. IN EQUITY.

The decision (19 *Blatchf. C. C. R.*, 205) that letters patent No. 220,767, granted to John McCloskey, October 21st, 1879, for an improvement in soft metal traps, are void, for want of invention, confirmed.

A motion to open the case for new evidence was denied, the new evidence being designed to show only the improved quality of the metal in the traps of the patent, and such result being due to the process of manufacture.

(Before WHEELER, J., Southern District of New York, September 29th, 1881.)

WHEELER, J. This cause has been heard, since a decretal order for dismissing the bill of complaint, (19 *Blatchf. C. C. R.*, 205,) and before decree signed, upon a motion of the plaintiff to re-open the case, for the introduction of new evidence as to the novelty and utility of the patented trap. It is plain that the motion should not be granted unless the new evidence would vary the case and probably lead to a different

result. The patent is simply for a die-drawn seamless soft metal plumber's trap, made by forcing the metal through dies at varying velocities on opposite sides. It describes nothing to distinguish these traps from others, except the mode of manufacture and longitudinal striations appearing upon them which are merely the result of the manufacture, and have nothing to do with the quality or operation of the traps. The patent assumed that soft metal traps were before known and in use, and, besides, that fact was a matter of common knowledge, of which the Court took judicial notice. There was no evidence as to the quality and characteristics of the die-drawn traps, as compared with the cast traps before most in use. The new evidence would tend to show that their walls have greater solidity and more perfect uniformity, and that they are more elastic, and that the quality of the metal is changed and improved by the process of drawing, and that they have largely superseded all others in use. All these differences are due to the process of manufacture, in forcing the metal through dies, all of which effects were before well known. They are the same as the differences between cast and drawn lead pipe as was shown in *Le Roy v. Tatham*, (14 How., 156.) There, the testimony was that the drawn lead pipe "was superior in quality and strength, capable of resisting much greater pressure, and more free from defects than any pipe before made; that, in all the modes of making lead pipe previously known and in use, it could be made only in short pieces, but that by this improved mode it could be made of any required length and also of any required size; and that the introduction of lead pipe made in the mode described had superseded the use of that made by any of the modes before in use, and that it was also furnished at a less price." Still the Court said, through Mr. Justice McLean: "A patent for leaden pipes would not be good, as it would be for an effect, and would, consequently, prohibit all other persons from using the same article, however manufactured. Leaden pipes are the same, the metal being in no respect different. Any difference in form and strength must

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arise from the mode of manufacturing the pipes. The new property in the metal claimed to have been discovered by the patentees belongs to the process of manufacture and not to the thing made." And, in *Collar Company v. Van Deusen*, (23 Wall., 530,) Mr. Justice Clifford said: "Articles of manufacture may be new in the commercial sense when they are not in the sense of the patent law. New articles of commerce are not patentable as new manufactures, unless it appears, in the given case, that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production."

The plaintiff did not discover that soft metal could be wrought through dies, nor that the quality of wrought soft metal is generally superior to that which is merely cast, and does not pretend that he did; and his patent is not for any such discovery, nor for the application of it. He constructed a machine by which crooked pipe could be made of soft metal the same as straight pipe had before been made; and the crooked pipe could be cut off so as to constitute traps. His patent is for the traps made in that way, for the effect merely of that machine. He has not the discovery of any principle, even such as Tatham had, in the working of soft metal, to support his patent, as the minority of the Court, in *Le Roy v. Tatham*, thought Tatham had to support his patent. This newly offered evidence of the differences in quality between the drawn traps and cast traps shows merely the differences between drawn pipe and cast pipe, or wrought lead and cast lead, and could not affect the decision of the case at all, in the view taken of it by the Court. If this construction of the patent and view of the case are wrong, they can be corrected by appeal.

The motion must be denied.

James A. Whitney, for the plaintiff.

Peter Van Antwerp and *Rodney Mason*, for the defendants.

Sharp v. Reissner.

JAMES L. SHARP

vs.

CHRISTOPHER REISSNER AND OTHERS. IN EQUITY.

The defendant in a suit in equity for the infringement of letters patent, without answering the bill, filed a plea merely denying infringement. The plaintiff moved that the plea be stricken from the files as improper or else be ordered to stand as an answer. In answer to the motion, the defendant showed, by affidavit, that he had other defences which he wished to raise by answer, especially prior patents anticipating the plaintiff's patent, and, also, limiting its scope so as to render infringement impossible, and that to take evidence in regard thereto would be expensive to both parties: *Held*, that the plea must be stricken from the files, with leave to the defendant to answer.

(Before BLATCHFORD, J., Southern District of New York, October 5th, 1881.)

BLATCHFORD, J. The bill in this case is brought for the infringement of a patent. The bill alleges that the defendants, without the license of the plaintiff, and in violation of his rights, and in infringement of the patent, did "make, construct, use and vend to others to be used the said invention, and did make, construct, use and vend to others to be used hydro-carbon stoves, made according to, and employing and containing, said invention," and "have made and sold, and caused to be made and sold, large quantities of said hydro-carbon stoves." Two of the defendants have put in a plea to the bill, which sets forth "that neither they, nor either of them, have, since the issuing of the letters patent set forth in said bill, ever made, constructed, used or vended to others to be used the invention described in said letters patent * * * or made, constructed, used or vended to others to be used hydro-carbon stoves, made according to, and employing and containing, said invention." The plea also denies that the defendants, "or either of them, have ever infringed upon or violated any exclusive right secured by said letters patent, in

any manner whatever." There is nothing else in the plea and there is no answer to the bill or to any part of it. The plaintiff moves that the plea be stricken from the files as improper, or else be ordered to stand as an answer. The defendants show, by affidavits, that they are advised and believe that the stoves they have made were not infringements of the patent sued on; that, by the advice of their counsel, and for the purpose of avoiding expense to both parties, the simple defence of non-infringement was interposed in the form of a plea; that the defendants have other defences which they wish to embody in an answer, should it be necessary for them to answer, the most important of which defences are prior patents anticipating the plaintiff's patent, and, also, limiting its scope so as to render infringement impossible, and prior knowledge on the part of various individuals; and that, to take evidence in regard to all such prior patents and prior knowledge, would be very expensive to both parties.

The defendants contend that the plea is a proper one; that it was not necessary for the plea to be supported by an answer, even under the old equity practice; that, under the Equity Rules prescribed by the Supreme Court of the United States, no plea is to be accompanied by an answer, except where fraud or combination is alleged in the bill; and that, even if the plea be defective in form or substance, or if it should have been supported by an answer, the plaintiff has mistaken his remedy.

No authority is cited where a plea like the present one has been put in or allowed, in a suit for the infringement of a patent. By Equity Rule 34, if a plea is overruled, either on an issue of law or an issue of fact, in regard to it, the defendant has an absolute right to put in an answer to the bill, or to so much thereof as is covered by the plea. By Equity Rule 39, a defendant has a right, in all cases, to insist by answer, upon all matters of defence, (not being matters of abatement, or to the character of the parties, or matters of form,) in bar of or to the merits of the bill, of which he may be entitled to avail himself by a plea in bar. If the present plea

Sharp v. Reissner.

should be tried on the fact of infringement and the issue be found for the plaintiff, and the plea be thus overruled, it would seem difficult, under the above Rules, to exclude the defendant from contesting again, under an answer, the question of infringement, especially as, under the issues raised by an answer, and under the light thrown on the subject by the proofs on the issue on the plea, and under new proofs on the issues on the answer, the question of infringement might be presented in a very different light from that in which it was presented on the trial of the issue on the plea, and in one much more favorable to the defendants. Indeed, the defendants' affidavit on this motion states that they will desire, by answer, to put in prior patents, to limit the scope of the plaintiff's patents, so as to render infringement impossible. It is difficult to see how they are to be prevented from doing this by answer, after the overruling of their plea. The question of the infringement of a patent depends very much on the construction of its claims, and that depends very much on prior patents on the same subject. If such prior patents are to be put in they ought to be set up in an answer, and be put in once for all, and the issue of infringement ought to be tried but once, and under an answer, and not under a plea. The defendants think they will succeed on the question of infringement. But the plaintiff thinks otherwise. If the defendants succeed, expense will have been saved by having no other issue but that on the plea. But, if the plaintiff succeeds on the plea, he must, to realize his success, go through a second litigation on the same question; and no expense will have been saved. The one result is now to be contemplated quite as much as the other. Within the principles laid down in *Rhode Island v. Massachusetts*, (14 *Peters*, 210,) it would be unjust to the plaintiff to permit the issue of infringement to be determined on the plea. Besides this, none of the adjudged cases sanction, in a suit like this, a plea merely of non-infringement, under rules of practice such as those which govern this case. On the contrary, the authorities condemn such a plea. (*Bailey v. Le Roy*, 2 *Edw. Ch. R.*, 514; *Black*

In re the Appointment of Supervisors of Election.

v. Black, 15 *Georgia*, 445 ; *Milligan v. Milledge*, 3 *Cranch*, 220.)

It is only when a plea is unexceptionable in its form and character, that it is to be set down for argument or to be replied to. (*Rhode Island v. Massachusetts*, 14 *Peters*, 210, 257.) The motion to strike this plea from the files, as improper, is a correct motion, and must be granted, with leave to the defendants to answer in 30 days, on payment of costs.

Briesen & Betts, for the plaintiff.

W. H. L. Lee, for the defendants.

IN THE MATTER OF THE APPOINTMENT OF SUPERVISORS OF
ELECTION.

The Court being required, by § 2,012 of the Revised Statutes, to appoint, in each election district, two supervisors of election "of different political parties," and there being a dispute as to who should be appointed from the Democratic party in the city of New York, the Court selected persons recommended by "The New York County Democracy."

(Before BLATCHFORD, J., Southern District of New York, October 5th, 1881.)

BLATCHFORD, J. The requirement of § 2,012 of the Revised Statutes is, that the two supervisors of election, in each election district, "shall be of different political parties." By § 2,026, the chief supervisor of elections is required to receive the applications of all parties for appointment as supervisors of election, and to present such applications to the judge, and furnish information to him in respect to the appointment by the Court of such supervisors of election. A question has now arisen as to who shall be appointed supervisors from the Democratic party, in the city of New York,

In re the Appointment of Supervisors of Election.

at the coming election, in two Congressional Districts. Applications are made by persons belonging to an organization called "The New York County Democracy," and also by persons belonging to an organization called "The Democratic Organization of the city and county of New York." The former organization has come into existence since the last Democratic State Convention was held. Delegates representing "The Democratic organization of the city and county of New York" were recognized and admitted to seats at the last Democratic State Convention, and were the only delegates recognized by that Convention as representing the Democratic party in the city and county of New York. Whenever a question has arisen heretofore in respect to what political organization should be recognized by the Court, in appointing supervisors, as entitled to be considered as the regular representative organization of the political party, the practice has been to recognize that one which was recognized by the last State Convention of the party. It has been thought wise to recognize some one organization as entitled to represent the political party, and to ask that members of its organization, recommended by it, and those only, provided they were fit and proper persons, and met the requirements of the statute, should be appointed the supervisors from such political party; and no rule more likely to effect a just result, and to meet with general acquiescence, could be suggested, than the one above referred to. But, like every general rule, it must be modified by a change of circumstances. If such general rule were to be applied to the present case, without reference to any circumstances which have transpired since the last Democratic State Convention was held, the organization called "The Democratic organization of the city and county of New York" would be recognized as the regular representative organization of the Democratic party in the city and county of New York. But it has been made clearly to appear to the Court, that, since the last Democratic State Convention was held, such proceedings have been duly and regularly had by proper and authorized representatives

Meyer v. Maxheimer.

of "The Democratic organization of the city and county of New York," that, although that organization may still formally exist, the new organization called "The New York County Democracy" must be regarded as representing it and its members, and as the only organization now recommending persons to be appointed as supervisors from the Democratic party, which ought to be recognized by the Court as the regular representative organization of the Democratic party in the city and county of New York. Therefore, the persons recommended by the organization called "The New York County Democracy" will, if fit and proper persons, and meeting the requirements of the statute, be appointed by the Court as supervisors from the Democratic party.

William C. Whitney, for the New York County Democracy.

Charles W. Brooke, for the Democratic organization of the city and county of New York.

JOHN D. MEYER AND CHARLES M. NEUBAUER

vs.

JOHN MAXHEIMER. IN EQUITY.

Re-issued letters patent No. 8,594, granted to John D. Meyer and Charles M. Neubauer, February 25th, 1879, for an improvement in wire cages, the original patent, No. 139,874, having been granted to Michael Grebner, June 10th, 1878, are invalid, being for a different invention from the original. The re-issue was, apparently, expanded beyond the original, to cover the intervening inventions of others.

(Before WHEELER, J., Southern District of New York, October 5th, 1881.)

WHEELER, J. This suit is brought upon letters patent No. 139,784, granted to Michael Grebner, June 10th, 1873, and re-issued to the plaintiffs, February 25th, 1879, in No. 8,594, for an improvement in wire cages. Among the defences set up is one that the re-issue is for a different invention from that in the original patent. The original patent was for a cage having the horizontal bands provided with slots through which loops formed outwardly on the upright wires were placed and held by a locking bar extending around the cage outside the band and through the loops, making a firm and durable connection between the bands and wires. After that, and before the re-issue, cages were invented and brought into use having their horizontal bands made tubular, of sheet metal, with holes above and below, through which the upright wires were placed, having bends, like loops, extending outwardly within the hollow bands, to form a connection between the wires and bands. The re-issue is for a cage having horizontal bands of sheet metal, or other suitable material, provided with holes that engage with the vertical filling wires, which have loops or crimps that fit the holes and effectually prevent the vertical displacement of the horizontal band; and a locking-bar, like that in the original, to prevent either of the filling wires from being pressed in so as to disengage its crimps from the cross, or horizontal, band. The first claim is for the combination, in a cage, of filling wires provided with loops or crimps and cross-bands provided with holes adapted to engage with the loops or crimps.

There is nothing in the original patent about the engagement of the loops with the slots otherwise than by being held together by the locking-bar. The loops shown in the drawings are not shaped to, of themselves, hold the cross-band in place. The connection between the bands and the wires depended wholly upon the locking-bar. The combination mentioned in the first claim of the re-issue would not be an operative combination at all, with the parts made only as described in the original. The invention sought to be covered by the re-issue is of a cage held in shape by the fitting of crimps in

Maxheimer v. Meyer.

the wires to holes in the cross-bands, while that in the original is of a cage held in shape by the locking of loops on the wires through slots in the cross-bands. These inventions are essentially different. The re-issue was, apparently, expanded beyond the original to cover the intervening inventions of others. The language of the Supreme Court in *Mfg. Co. v. Ladd*, (102 U. S., 408,) seems peculiarly applicable to this case. It is said there, that the statute was never intended to allow a patent to be enlarged except in a clear case of mistake, and that there is no safe or just rule but that which confines a re-issued patent to the same invention which was described or indicated in the original. This re-issue seeks to enlarge the invention as well as the patent, and is not supported by the original.

Let there be a decree that the re-issued patent is invalid, and that the bill of complaint be dismissed, with costs.

John Van Santvoord, for the plaintiffs.

Arthur V. Briesen, for the defendant.

JOHN MAXHEIMER

vs.

JOHN D. MEYER AND CHARLES M. NEUBAUER. IN EQUITY.

Letters patent No. 162,400, granted to John Maxheimer, April 20th, 1875, and letters patent No. 218,758, granted to him August 19th, 1879, each for improvements in bird cages, are valid.

The first patent underlies all constructions of cages where the horizontal bands are held in place solely by shoulders formed on the upright wires.

An accidental and incidental effect, not observed, if it existed, held not to show prior invention.

An improvement, the use of which involves the use of a patented invention, infringes it, even though the improvement be patented.

(Before WHEELER, J., Southern District of New York, October 5th, 1881.)

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WHEELER, J. This suit rests upon two patents granted to the orator for improvements in bird cages, the first numbered 162,400, dated April 20th, 1875, for a cage in which the horizontal bands are solid wires with holes through which the upright wires are placed and which are held in place on the upright wires by short bends in the latter, forming shoulders above and below the horizontal wires, without solder or other fastening; the second, numbered 218,758, dated August 19th, 1879, after an interference between him and Michael Grebner, who prosecuted it at the instance and expense of the defendants, is for a cage in which the horizontal bands are hollow wires, through which the vertical wires pass, with short bends in them, within the hollow of the horizontal wire, which is flattened so as to lock them together. The defendants deny the novelty of the second patent and infringement of either. The plaintiff insists that they are concluded as to the novelty of the second patent by the decision in his favor against them in the interference proceedings. The defendants make and sell cages having vertical wires with bends in the hollow of horizontal bands locked by flattening the latter, like the plaintiff's, except that the bends extend in the direction of the axis of the bands, instead of radially, whereby the band can be flattened more perfectly. It does not appear, from any of the evidence, that any cages had ever been constructed before the plaintiff's invention described in his first patent, in which the upright wires and cross-band had been held together by their own conformation, without the aid of solder or some contrivance to tie or lock them together. That invention and patent, therefore, underlie all constructions of cages whereby the horizontal bands are held in place solely by shoulders formed on the upright wires. The plaintiff's second patent is for an improvement upon his first by bringing the bends within a hollow cross-band and making the connection more firm by flattening the cross-band and bringing the shoulders formed by the holes through it more closely to the shoulders on the vertical wires. The cross-bands are held in place solely by the shoulders on the upright wires in both, the

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improvement in the latter consisting merely in the better mode of bringing the shoulders to bear. In the defendants' cage the cross-bands are held in place solely by these means, and the shoulders are brought to bear by the plaintiff's improved method. They, therefore, infringe both patents, if the second is valid. The only near approach to the plaintiff's invention sought to be patented in this patent, and the only one to which special reference is deemed to be necessary, prior thereto, is in some cages made by John L. Fisher, inventor and assignor in letters patent No. 167,325, dated August 31st, 1875, for an improvement in bird cages, in 1876, at Buffalo. This patent is for a cage with a hollow cross-band like the plaintiff's, with short bends on the upright wires, within the hollow of the cross-band, but held in place by a wire key inserted within the bends and through the wire, and locking the upright wires to the cross-band. This is not the plaintiff's invention, which does away with all contrivances for fastening except the shape of the cross-band and upright wires. The evidence shows clearly that Fisher made some cages, before the plaintiff's invention, without this wire key. Those so made, without other fitting than the insertion of the upright wires with their bends through the holes in the cross-band, would not have a firm attachment of the cross-band to the wires. It is said in behalf of the plaintiff, that none of these had all the cross-bands without the key, but this is not material, for, one cross-band and its connections with the wires would show the invention as well as more. The evidence tends to show, that, in shaping some of those cages, the cross-bands out of which the key had been left were flattened and a firm connection thereby made between them and the upright wires. That, if done, would show the construction of the plaintiff's second patent. But, it is doubtful whether that was done. If done, it was not for the purpose of making a better connection between the bands and wires, nor known then to have that effect, but was accidental, and incidental to the process of shaping the cages. Neither does this effect appear to have been observed before the date of the plaintiff's invention,

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if it existed. This would not show that Fisher or those who saw his work invented, or had prior knowledge of, this thing patented by the plaintiff, before he invented it. (*Rev. Stat. U. S., sec. 4920; Andrios v. Carman*, 13 *Blatchf. C. C. R.*, 307.) These conclusions make it unnecessary to consider the effect of the decision in the interference proceedings, even as to the invention of Grebner set up in his application, which set on foot those proceedings. The defendants' mode of placing the bends in the upright wires lengthwise in the hollow of the cross-band may be an improvement upon the plaintiff's mode, but, if it is, in employing that improvement they make use of the plaintiff's patented invention without right, although that improvement is patented.

The plaintiff's second patent also contains a claim for a feed cup in connection with the vertical wires of the cage, and it is insisted for the defendants that this invention is independent of the other and that the patent for both is, therefore, void. But, these inventions are connected together by being appropriate for use in the same cage for the common purpose of making a bird cage, and, under these circumstances, the joinder of both in one patent does not render the patent void. (*Emerson v. Hogg*, 2 *Blatchf. C. C. R.*, 1; *Hogg v. Emerson*, 6 *How.*, 437.)

Let a decree be entered for an injunction and an account, according to the prayer of the bill, with costs.

Arthur V. Briesen, for the plaintiff.

John Van Santvoord, for the defendants.

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HENRY O. BERNARD AND ROBERT GRAY

vs.

JULIUS HEIMANN AND OTHERS. IN EQUITY.

Letters patent granted to Robert Gray, September 9th, 1879, for an "improvement in head-coverings," are valid.

The invention defined and distinguished from prior inventions.

(Before BLATCHFORD, J., Southern District of New York, October 7th, 1881.)

BLATCHFORD, J. This suit is brought on letters patent granted to Robert Gray, September 9th, 1879, for an "improvement in head coverings." The specification, which is accompanied by, and refers to, a drawing which represents a sectional side view of a hat embodying the invention, says: "This invention relates to the manufacture of hats, bonnets or other head-coverings, with a top layer of flock. Hats of this description have been made by applying the flock to a buckram support, but have invariably been stiff, owing to the fact that, in order to give the article the required body or strength, it was necessary to use a heavy or thick piece of buckram. One objection to this hat is the stiffness referred to, it being desirable in some cases to furnish a soft hat, and another the visibility of the buckram tending to defeat the object of the flock layer, which is to produce a felt-like article. My invention is a head-covering, consisting of a support of buckram or the like, a top layer of flock, and a canton flannel or other similar lining, whereby the article is rendered capable of taking a soft finish, while both surfaces thereof have the appearance or semblance of felt—one of plain felt and the other of napped felt. In the drawing the letter A designates the support, B the flock layer, and C the canton flannel or other similar lining. In carrying out my invention I first cement the lining C to a piece of buckram or other

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like fabric, by a suitable adhesive substance, with the nap of the lining exposed, and then press the two together, in any usual or suitable manner, to the desired shape. In lieu of canton flannel the fabric known as 'glove lining' may be used. I now apply to the buckram a layer of cotton, woolen or other flock, this process consisting in coating the buckram with an adhesive substance and strewing the flock thereon in finely powdered form. The article is then in a state for trimming. The buckram A supports both the flock layer B and the lining C, and, being reinforced by the lining, a light or thin piece of such material may be used, rendering the article pliable or soft, substantially like soft felt. The appearance of the article, moreover, is felt-like, inasmuch as the lining has the semblance of napped felt and the flock layer that of plain felt." The claim is as follows: "A head covering consisting of a support of buckram or the like, a top layer of flock, and a canton flannel or other similar lining, substantially as and for the purpose described."

The only defence is want of novelty. It is plain that the hat of the patent must be a hat made by pressing the materials into the shape of a hat, and not made the top in one piece, the side crown in another and the brim in another, and then these joined. There must also be (1) a layer of flock on a support of buckram or the like; (2) a support of buckram or the like next the flock, with a coating of adhesive substance on the buckram, on which the flock is strewn; (3) a canton flannel or other similar lining on the face of the buckram to which the flock is not applied, with the napped face of the canton flannel exposed and not next to the buckram.

The Kendall turban, defendants' exhibit No. 3, has no side crown or brim. Irrespective of this, it is not satisfactorily established that that article had in it any stockinet support, or any thing but canton flannel with flock applied directly to the unnapped face of the canton flannel.

Bracher's frame, No. 6, if made with the unnapped face of the canton flannel exposed, had only flock enough put on the buckram to take an impression of straw braid, and was made

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not for use in that condition as a hat, but solely to be stamped as an imitation of a straw hat. The flock was put on only as a pulp on which to emboss, and the flock, by the embossing, lost its identity and parted with all resemblance to felt.

The Morse hat, No. 13, is a flocked buckram hat, with a strip of canton flannel put in separately as a brim.

Hats such as the Novelty Company hats of 1876, made of canton flannel, muslin and flock, with the napped face of the canton flannel not exposed, were not the Gray hat. It is plain that cementing the nap to the buckram tended to destroy the pliability or softness aimed at by Gray; by reason of the absorption of the nap by the cement, and that there could be no appearance of napped felt.

The case is one where there was sufficient invention to support the patent, and there must be a decree for the plaintiffs, with costs.

S. J. Gordon, for the plaintiffs.

J. H. Goodman, for the defendants.

THE STEAM STONE CUTTER COMPANY

vs.

THOMAS SEARS. IN EQUITY.

Rule XI of the Circuit Court for the District of Vermont, providing that "the creation, continuance and termination of liens and rights created by attachment of property, or the arrest of a defendant, shall be governed by the laws of this State," covers the issuing and serving of a writ of sequestration in a suit in equity in the Circuit Court, after an interlocutory decree for the plaintiff, in a suit in equity for the infringement of letters patent, for an account of profits, under which writ real estate of the defendant in the writ is attached,

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to be held as security for a final recovery, and the Circuit Court had power to make such Rule, applying to suits in equity.

Service of such writ by a return of attachment on a copy of it lodged in the town clerk's office where the town records are kept, without possession, is sufficient to create a lien on the real estate.

The writ is, in effect, strictly an attachment to create a lien.

(Before WHEELER, J., Vermont, October 11th, 1881.)

WHEELER, J. The orator, as owner of a patent, brought a bill in this Court against the Windsor Manufacturing Company for infringement, and obtained a decree establishing the title to and validity of the patent, the fact of infringement, and for an account of profits. After this decree, on application of the orator, a writ of sequestration, in the nature of an attachment, to create a lien for satisfying the decree, was issued and served by attaching the real estate of that defendant, in accordance with statutes of the State of long standing, which enable the Courts of Chancery of the State to issue such process and create such liens. After this attachment that defendant conveyed to this defendant, who had full knowledge of the attachment, a portion of the estate so attached. The orator obtained a final decree for the payment of money in the original cause, took out execution thereon, and caused it to be levied upon that estate, and caused the estate to be set out to the orator in satisfaction of so much of the execution as it would apply to, at its appraised value, agreeably to the statutes of the State in relation to levy of execution upon real estate. The defendant refused to recognize the validity of the attachment and levy, and claimed to hold the land against them. This bill is brought to confirm and enforce the orator's attachment and levy and to obtain possession of the estate, and the cause has been heard upon bill and answers. No question is made about the propriety or regularity of the writ of attachment issued in this case, if there was authority to issue such a writ at all; nor about the regularity of the attachment upon the writ, or the levy of the execution and setting out the estate by the marshal according to the laws of the State, if the attachment could effectually be

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so made, or the estate be so levied upon, in any case in equity. The only questions made are as to whether the Court has the power to issue such writs, and whether the service of such a writ in that manner creates a lien that will hold until decree. It has been the practice of the Court for about thirty years to issue such writs, upon cause shown, in this manner, some of which have been served by attaching real estate in this manner, but doubts have arisen latterly in respect to the legality of this course. In no case has the question arisen, so far as is known, except upon the application for the writ, and not then so as to involve appearance for the opposite party or argument. It is presented now for the first time for debate, and has been argued with thoroughness and ability upon each side.

An attempt has been made to rest these proceedings upon the general authority, usage and practice of Courts of Chancery. That such Courts have issued writs of sequestration, from the earliest times, is abundantly shown. (*Hinde's Chan.*, 127; *Colston v. Gardner*, 2 *Ch. Ca.*, 44; *Francklyn v. Colhoun*, 3 *Swanst.*, 276; *Peck v. Crane*, 25 *Vt.*, 146.) But these writs were always issued in the nature of distresses to compel appearance, or performance of some decree or order, and not for the purpose of creating a mere lien upon property, to be held for the satisfaction of a money decree. These proceedings must be maintained, if at all, by the force of the statutes of the United States, the rules and practice of the Courts in pursuance thereof, and the laws of the State adopted thereby; although the practice of Courts of Chancery, both ancient and modern, is to be looked into for the purpose of understanding and applying these statutes and rules.

The statutes of the United States make a distinction between common law causes and equity and admiralty causes, as to provision for process and forms and modes of procedure. For the former the practice, proceedings, and remedies, by attachment and execution, of the Courts of the States, are adopted. (*Rev. Stats. U. S.*, secs. 914, 915, 916.) For the latter it is merely provided, that "the forms of mesne pro-

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cess, and the forms and modes of proceeding in suits of equity and of admiralty and maritime jurisdiction, in the Circuit and District Courts, shall be according to the principles, rules and usages which belong to Courts of equity and of admiralty respectively, except when it is otherwise provided by statute or by rules of Court made in pursuance thereof; but the same shall be subject to alteration and addition by the said Courts respectively, and to regulation by the Supreme Court, by rules prescribed, from time to time, to any Circuit or District Court, not inconsistent with the laws of the United States," (*Rev. Stats., sec. 913*;) and that the Circuit and District Courts shall have power to issue all writs necessary for the exercise of their respective jurisdictions and agreeable to the usages and principles of law. (*Sec. 716.*) There are no provisions in the statutes for execution upon decrees in equity or admiralty causes; and none for liens thereby, except that it is provided, that "judgments and decrees rendered in a Circuit or District Court, within any State, shall cease to be liens on real estate or chattels real in the same manner and at like periods as judgments and decrees of the Courts of such State cease, by law, to be liens thereon." (*Sec. 967.*) Still, decrees in equity and in admiralty in the Circuit and District Courts become liens upon the lands of defendants therein, in States where like decrees of the State Courts become such liens, the same as the decrees of the State Courts do. (*Ward v. Chamberlain*, 1 *Black*, 430.) And suits *in personam* in admiralty may be commenced by attachment of the property of the libellee, to be held to answer the demand. (*Manro v. Almeida*, 10 *Wheat.*, 473.) These remedies rest upon the principles and usages which belong to such Courts, and the rules of the Courts respectively, and not upon any express provision of the statutes. And, in giving construction to the statute prescribing those principles and usages, as guides of procedure, reference is to be had to the practice of those Courts in this country, as grafted upon the English practice. This was expressly laid down as to admiralty proceedings, in *Manro v. Almeida*. The form of the writ of execution in equity cases,

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upon decrees for the payment of money, has been provided by the Supreme Court, in Equity Rule 8, and no other provision is made in those Rules in regard to such executions. All the rest is left to the Circuit and District Courts. This Court provided, by Rule XI, that "the creation, continuance and termination of liens and rights created by attachment of property, or the arrest of a defendant, shall be governed by the laws of this State." This State has, and has had almost from its organization as a State, the English equity system, with its jurisdiction vested in Courts of Chancery, and those Courts have had the power from nearly as early a period to issue writs of attachment like the one in question, having the force and effect claimed in behalf of this one. Such writs were within the principles and usages belonging to those Courts. Such a writ of attachment was as well settled in the jurisprudence of the State as belonging to the Courts of equity as attachments upon mesne process were settled to belong to the Courts of common law. The Rules of this Court are not divided into Rules in equity and Rules at law at all, but are all together in one body and left to operate on the law side or equity side of the Court as they may be applicable. The laws of the State adopted by this Rule are as applicable to equity cases as they are to common law cases, and, not being restricted by the Rule to either, must have been intended for both. This Rule covers the issuing and force of this writ. The power to make such a Rule in cases where the Supreme Court has not acted is as well conferred as the power of that Court to make Rules for the Circuit and District Courts is. The language conferring it is as explicit and comes from the same authority. In *Beers v. Haughton*, (9 *Pet.*, 329,) Mr. Justice Story said: "State laws cannot control the exercise of the powers of the National Government, or in any manner limit or affect the operation of the process or proceedings in the National Courts. The whole efficacy of such laws, in the Courts of the United States, depends upon the enactments of Congress. So far as they are adopted by Congress they are obligatory. Beyond this they

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have no controlling influence. Congress may adopt such State laws directly by a substantive enactment, or they may confide the authority to adopt them to the Courts of the United States." "The constitutional validity and extent of the power thus given to the Courts of the United States to make alterations and additions in the process as well as in the modes of proceeding in suits was fully considered by this Court in the cases of *Wayman v. Southard*, (10 *Wheat.*, 1,) and the *Bank of the United States v. Halstead*, (10 *Wheat.*, 51.)" "The result of this doctrine, as practically expounded or applied in the case of *Bank of the United States v. Halstead*, is, that the Courts may, by their Rules, not only alter the forms but the effect and operation of the process, whether mesne or final, and the modes of proceeding under it." In *Bank of the United States v. Halstead*, it was held, that the law of the United States authorizing the Courts of the United States to alter their processes, authorized them to so alter them as to make lands subject to execution which were not so subject under State laws. The objection was made there, as it had been in *Wayman v. Southard*, that Congress could not delegate such powers to the Courts, because they were legislative powers. In *Wayman v. Southard*, Chief Justice Marshall said, as to this objection: "If Congress cannot invest the Courts with the power of altering the modes of proceeding of their own officers in the service of executions issued on their own judgments, how will gentlemen defend a delegation of the same power to the State legislatures? The State assemblies do not constitute a legislative body for the Union. They possess no portion of that legislative power which the Constitution vests in Congress, and cannot receive it by delegation." In *Bank of the United States v. Halstead*, Mr. Justice Thompson said: "If the alterations are limited to mere form, without varying the effect and operation of the process, it would be useless. The power here given, in order to answer the object in view, cannot be restricted to form, as contradistinguished from substance, but must be understood as vesting in the Courts authority so to

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frame, mould, and shape the process as to adapt it to the purpose intended. The general policy of all the laws on this subject is very apparent. It was intended to adopt and conform to the State process and proceedings, as the general rule, but under such guards and checks as might be necessary to insure the due exercise of the powers of the Courts of the United States." "It is said, however, that this is the exercise of legislative power, which could not be delegated by Congress to the Courts of justice. But this objection cannot be sustained. There is no doubt that Congress might have legislated more specifically on the subject and declared what property should be subject to executions from the Courts of the United States. But it does not follow that because Congress might have done this, they necessarily must do it and cannot commit the power to the Courts of justice."

These authorities well establish the validity of the Rule of this Court regulating attachments. It is strenuously contended, in behalf of the defendant, that, if this writ was valid, its service, which was by copy of the writ and return of attachment upon it lodged in the town clerk's office where the land records are kept, without possession, was not, and that it did not create any lien upon the land. If this was strictly a sequestration, this point would be well taken, but it is not, although it is called so to some extent. A sequestration is intended to accomplish its object by the actual taking of goods and chattels, or the rents and profits of lands, and withholding them until the distress brings compliance with what is then required, and it creates no lien in favor of future judgments or decrees, while an attachment creates such a lien and nothing more. This is, in effect, strictly an attachment to create a lien, and is so understood in the laws of the State adopted by the Rule. (*French v. Winsor*, 36 *Vt.*, 412.) The creation of the lien provided for by the Rule includes as well the mode of service as the issuing of the writ, and adopts the State law for both purposes. Besides, if the writ was valid and there was no law or Rule providing any mode of service, the return upon the process, of an attachment of land, would

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be sufficient without any taking possession, or entry upon the land, by the officer. (*Taylor v. Mixer*, 11 *Pick.*, 341.) And this argument would prove too much, for, if the Rules of Court did not provide for the service of executions in equity cases, there would be no provision at all for that purpose, nor, in fact, for issuing executions in such cases. Executions are satisfied by levy on land only by appraisal and setting out the land to the creditor under the State laws, which make specific provision for that purpose, in this State, and, if that mode was not adopted by the Rules of the Courts in equity, and the statutes of the United States in common law, cases, there would be no way to levy executions issuing out of the United States Courts upon lands within this State. Still, if this land had not been conveyed, and the record title had stood in the execution debtor, it probably would not be contended but that, upon a decree for the payment of money, an execution could be taken out and satisfied by levy upon the land, as was done. It was said in argument, that such a Rule could no more be made here than it could where attachments upon mesne process are not known, which may be true, but the effect of it and of all such Rules in either place is limited to the continuance of liens by decrees in the State Courts, by the statute before mentioned. (*Rev. Stat. U. S.*, sec. 967.) The effect of the whole is to keep the liens in proceedings in the United States Courts within the same bounds as in those of the State Courts, according to the policy of the laws of the United States, as stated by Mr. Justice Thompson, in *Bank of United States v. Halstead*, as before quoted. These proceedings are according to the principles, practice and usages of Courts of equity, as they obtain within the State, and as the same have been recognized by this Court by granting such writs for many years, some of which have been served in the same manner as this. That practice is entitled to great weight, on account of the learning and character of the Judges adopting it, and on account of its effect in showing the cases to which the Rules were understood to apply. Chief Justice Marshall, in speaking of the legality of an arrest by the mar-

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shal in Connecticut, and commitment to jail without a *mittimus*, as required by the laws of the State, said: "The uniform course of that Court from its first establishment, dispensing with this *mittimus*, may be considered as the alteration in this particular which the Court was authorized by law to make." (*Wayman v. Southard*, 10 *Wheat.*, 1.) These authorities and considerations lead to the conclusion that this lien was valid, and that the levy transferred the title to this land to the orator. This conclusion is reached with less reluctance, because the defendant knew of this attachment and purchased at a time when, so far as appears, all supposed it to be valid, and when he could protect himself against it by any provision he might require. The doubts which afterwards arose were shared in by the Court, and the issuing such writs has since been avoided where the service of them might expose the marshal to suit for taking property, or the refusal by him to take property on them to prosecution for neglecting to serve them, until the question of their validity should arise, so that it could directly be argued and determined. This argument and examination has removed these doubts.

Let there be a decree establishing the validity of the attachment and levy, according to the prayer of the bill, with costs.

Prout & Walker, for the plaintiff. .

E. J. Phelps and *William Batchelder*, for the defendant.

THE MALLORY MANUFACTURING COMPANY

vs.

EDWARD MARKS AND OTHERS. IN EQUITY.

Letters patent No. 74,392, granted February 11th, 1868, to George Mallory, for an "improvement in hats," are valid.

The claim of said patent, namely, "The combination of the brim of a hat with a drooping hoop, so that the brim is caused to droop at the front and the rear, and to rise at the sides, substantially as set forth," construed.

The question of novelty examined.

(Before BLATCHFORD, J., Southern District of New York, October 19th, 1881.)

BLATCHFORD, J. This suit is brought on letters patent No. 74,392, granted February 11th, 1868, to George Mallory, for an "improvement in hats." The specification says: "Figure 1 represents a side view of a hat constructed according to my invention. Fig. 2 represents a perspective view of one of the springs of the same. Fig. 3 represents a top view of the hat. Fig. 4 represents an edge view of one of the springs of the same; and fig. 5 represents a cross section of the hoop enlarged. The object of my invention is to improve hats made from flexible fabrics, such as cloth; and the invention consists of the combination of the brim of the hat with a drooping spring hoop, by which I mean a spring hoop bent or twisted in such manner as to impart a droop to the front and rear of the brim and an elevation to the sides thereof. The hat represented in the accompanying drawings embodies my invention when the hoop is formed of concavo-convex wire, the brim being strained and shaped by a spring-hoop, which is both concavo-convex and twisted, so as to give the required droop at the front and rear. The hoop is best formed out of steel wire, which, by passing between rollers in a manner well known to metal workers, is formed rounding on one side and hollowing on the other, so that its

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transverse section is such as is represented at fig. 5. A piece of this concavo-convex wire, of the proper length to form the hoop, is cut off and is bent in the following manner: Two vises are secured to a bench, at a distance apart a little less than the length of the piece of wire, so that it can be strained between them, its ends being gripped simultaneously in both. A forked support is also fixed upon the bench, midway between the vises, and the fork or slit in this support is made just large enough to receive the wire edgewise. The piece of wire is strained between the vises and in the fork. Then a forked instrument is applied to it midway between the central support and one of the vises, and the wire is partially twisted by means of this forked instrument until the required bend is obtained. The instrument is then applied in like manner to the wire at the other side of the central support, and the partial twisting there is made equal to that imparted to the portion of the wire first twisted. The piece is then removed from the vises, and a sheet-brass clasp, *a*, similar to those used for skirt hoops, is applied to one of its ends. The piece is then inserted in a tubular socket or case, *m*, formed in the rim of the hat, through an opening left for the purpose, and its ends are secured together by the brass clasp; or the hoop may first be formed by uniting the ends of the piece by the clasp, and then it may be sewed into a tubular socket in the rim of the hat. When the ends of the hoop are united, it will be found that the hoop has the form, edgewise, shown at figs. 2 and 4, and, when it is in the hat, the brim is compelled, by the form of the spring, to droop at the front, *b*, and rear, *c*, as shown at fig. 1, and to rise at the sides, *d*. I generally apply two hoops to the brim of the hat body, placing one at about half of the breadth of the brim from the crown, as shown at *n*; and, in forming the hoops and applying them to the hat brim, I take care to make them sufficiently large, and to so apply them, as to strain or stretch the brim by distension. My invention may be used by forming the hoop of straight untwisted concavo-convex wire; also, by using flat wire for the hoop, and twisting it as above

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described. The hat possesses the advantage resulting from the light weight of a concavo-convex hoop, as well as the stylish droop resulting from the twist of the hoop; and besides, the rounded exterior of such a hoop tends to prevent the material bearing upon it from wearing away, as it has no sharp corner to cut the cloth." The claim is as follows: "The combination of the brim of a hat with a drooping hoop, so that the brim is caused to droop at the front and the rear, and to rise at the sides, substantially as set forth."

It is proper to determine, in the first place, the construction of the patent. It does not claim broadly a hat-brim which droops at the front and rear and rises at the sides. It claims the combination of the brim of a hat with a drooping hoop, substantially as set forth, which combination produces the effect specified. The specification states what is meant by "a drooping hoop" in the claim. It means "a drooping spring hoop," that is "a spring hoop bent or twisted in such manner as to impart a droop to the front and rear of the brim and an elevation to the sides thereof." A droop at the front and rear of the brim, and an elevation at the sides thereof, was not new nor claimed as new. The means of producing such droop and elevation were claimed. The hoop must be a spring hoop. It must be a hoop having a spring action. It must both strain and shape the brim. The specification calls the hoop a spring, and says that it is the form of the spring, when it is in place in the brim, that causes the brim to droop at the front and rear and rise at the sides. The hoop is required to be so large, that is, so large circumferentially, and so applied, as to strain or stretch the brim by distension, as well as to shape it. The specification also shows that when it says that the hoop is "bent or twisted," it uses the word "bent" as synonymous with the word "twisted." The hoop is so bent by twisting its material. The text says that the material is bent by twisting it in the manner described, and that it is twisted until the required bend is obtained. The remark, in the specification, that the "invention may be used by forming the hoop of straight un-

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twisted concavo-convex wire" must be rejected as not affecting the proper construction of the claim, and the hoop of the claim must be a spring hoop twisted substantially in the manner described in the patent. This construction is necessary to sustain the claim, in view of the state of the art, as shown. In addition, the brim of the hat must be made from a flexible fabric.

The answer denies infringement. The defendants, while admitting that their hat, Marks, No. 1, shows a spring hoop with a droop at the front and rear and an elevation at the sides, combined with a brim of flexible material, contend that it is not shown that the droop was imparted to the wire of the hoop by twisting it in the manner described in the patent. This is not so. The plaintiff's expert, Mr. Renwick, says that the second device entering into the combination of the claim of the patent is "a hoop made of a resilient material, such as steel wire, and bent or twisted so as to droop at the parts which correspond with the front and rear of the brim of the hat, and to rise at the parts which correspond with the sides of the brim." He then says that the hoop in Marks, No. 1, "is a drooping spring hoop, apparently identical, in its construction and in its characteristics, with the drooping spring hoop which constitutes the second device of the said plaintiff's patent." This is *prima facie* sufficient. There is no evidence in contradiction of it. On the contrary, the cross-examination of said expert seems to proceed on the view that the wire in Marks, No. 1, is twisted. If this were not so, it was easy for the defendants to have shown it.

There was sufficient invention to support the patent. The existence of straight untwisted wires before in brims made of a flexible fabric does not anticipate the patent. It required experiment and invention to pass from them to the arrangement of the patent, although it was known before that the giving a permanent twisting to a resilient wire would permanently alter its longitudinal set. The Adams and Slicer patent of December 24th, 1861, covered the giving such an excess in the length of a reed, wire, or other non-

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extensible flexible article, over that of the outer edge of the brim of a hat so formed of an extensible material, that when said reed or wire should be inserted and forced into a case on said outer edge, it would give not only firmness to the brim but also a rising curvature thereto, of any desirable configuration. This was an attempt towards the result aimed at in the plaintiff's patent. But the means were different. The means of the plaintiff's patent were not obvious. They were much superior to those of the Adams and Slicer patent, as is shown by the great success which the Mallory brim at once met with. With all the knowledge which skilled men had as to the twisting and set of resilient wire, they groped about, trying all methods but the one which was the needed one to secure the desirable result. Yet, in this case, as in all other cases like it, it is said that the means were so obvious as not to amount to invention.

The English patent to John Avery, No. 1,822, of 1856, only speaks of using a steel or other metal spring to give form and flexibility to a bonnet or bonnet foundation. There is no suggestion of twisting the wire.

The English provisional specification of John Taylor and others, of March 23d, 1860, No. 751, speaks only of giving a final shape, set or finish to a hat brim by a frame made to the required shape, either of metal, wood, composition, or any suitable metal or material. It has nothing to do with the Mallory invention.

The French patent to Langenhagen and Hepp, of October 4th, 1862, No. 56,002, speaks only of giving strength and stability to the edge of a braided hat, by folding the edge and sewing into the fold a rush, a brass wire or a sprig of whalebone. This is of no importance.

The patent to William H. Mallory, of September 8th, 1863, No. 39,822, shows only flat steel hoops or springs inserted at right angles to the brim of the hat, in hems or tucks formed in the brim.

The other patents put in evidence by the defendants were

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granted after the invention of Mallory was made. That was in July or August, 1863.

The defendants claim to have shown that the Mallory invention was made by Carl Fischer, in 1855, in New York, when he was working for Small and Stieglitz, and that Fischer then twisted wires in the manner described in the plaintiff's patent, and placed them in the brims of hats to the number of seventy or seventy-five dozen, and that such hats were sold. On all the evidence in regard to this invention by Fischer, it must be held that it has not been satisfactorily established.

The defendants also set up a prior invention by Philip Lasky, in 1861 or 1862, and one by John H. A. Nissen, at the end of 1861 or the beginning of 1862. On the whole evidence these are not made out.

The foregoing views apply also to the suits against Isidor and Hein, David Fox and others, John S. Bancroft and others, and Patrick Corbet. They also apply, except as to infringement, to the suit against Marcus Marks and Abraham Marks, in which infringement is admitted by the answer.

In the case against Marcus Marks and Abraham Marks, the answer sets up an agreement made by the plaintiff with the defendants, on or about April 1st, 1878, whereby the plaintiff licensed the defendants to make and sell hats under the patent. The evidence fails to establish such agreement.

There must be decrees for the plaintiff in all the suits, with costs.

Eugene Treadwell, for the plaintiff.

Betts, Atterbury & Betts, for the defendants.

J. MCGREGOR ADAMS AND ROBERT E. DIETZ

vs.

JOHN W. HOWARD AND DAVID R. MORSE. IN EQUITY.

A defendant in a suit in equity for the infringement of letters patent cannot demur to the whole bill and also answer the whole bill, especially where the answer sets up everything that is in the demurrer, and he will, on motion, be compelled to elect between his demurrer and his answer.

(Before BLATCHFORD, J., Southern District of New York, October 24th, 1881.)

BLATCHFORD, J. The defendant Morse has demurred to the whole bill and has put in an answer to the whole bill. The suit is one for the infringement of a patent. The grounds of demurrer set forth in the demurrer are all of them also set forth in the answer. They relate solely to the title set forth in the bill to the patent, and to the allegations in the bill respecting infringement. A replication to the answer has been filed. The plaintiffs now move for an order either that the defendant elect between his demurrer and his answer, or that the demurrer be set down for argument. By Rule 32 in Equity a defendant may demur to the whole bill, and may demur to a part of the bill and answer as to the residue. But there is nothing that allows him to demur to the whole bill and at the same time to answer the whole bill, especially where the answer sets up every thing that is in the demurrer. Putting in such an answer is a waiver of such a demurrer. The defendant must elect between his demurrer and his answer; and, to guard against misunderstanding, if he should elect his demurrer, and it should be overruled on argument, he would be held, probably, to have waived what, ordinarily and otherwise, would be, under Rule 34, his right to answer.

The defendant moves to dismiss the bill. The ground of the motion is not specified in the notice of motion. From

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the affidavit made in support of the motion, one ground would seem to be that the plaintiffs did not, under Rule 38, set down the demurrer for argument within the time required, and that they did not take any testimony within three months after the replication was filed. I think the plaintiffs sufficiently excuse the omissions. The demurrer ought to be disposed of before any testimony is taken. The motion is denied.

F. H. Betts, for the plaintiffs.

J. A. Whitney, for the defendants.

THE TRADERS' BANK OF CHICAGO

vs.

JOSIAH TALLMADGE AND EDWARD CARTER.

This case was remanded to the State Court because the petition for removal was not filed before or at the term at which it could be first tried.

This Court is to pass on such question even though the State Court passed on it.

(Before BLATCHFORD, J., Southern District of New York, October 25th, 1881.)

BLATCHFORD, J. This is a suit at law commenced in a Court of the State and removed into this Court by the plaintiff. Each defendant answered separately in the State Court. The case was duly noticed for trial by the plaintiff and by each of the defendants for a term of the State Court to be held on the first Monday of May, 1881, which was May 2d. All the notices of trial were served on or before April 18th. On April 18th, the State Court, on the application of one of the defendants, made an order that the plaintiff file

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security for costs within 10 days from the service of the order, or show cause to the contrary on April 29th, and that in the meantime, or, if security should be filed, then until such security should justify, if excepted to, the plaintiff's proceedings should be stayed. This stay continued till May 14th, when it ended. On the 7th of May each defendant gave notice of a motion for May 16th for a commission to take testimony in Missouri, and for a stay of the trial of the action till the return of the commission. On the 1st of September, the plaintiff filed a petition for the removal of the suit into this Court. The order of removal was made by the State Court on that day. It states that the petition was filed "before the term at which said cause could be first tried and before the trial thereof, to wit, on the 1st day of September, 1881." The petition bears date August 24th, and was verified August 25th. It states that issue was joined on or about April 15th, 1881, "that the said suit is not yet ready for trial, and that the same could not be tried at the last term of the Court, nor can it be tried at the present term, and no trial has been had." The order of removal was made without any prior notice to the attorneys for the defendants. There was a trial term of the State Court which commenced the first Monday of May. The plaintiff, on the 15th of April, placed the cause on the calendar of the Court for that term. There is nothing to show how long that term continued. The motions for commissions were adjourned from time to time till September 5th. A trial term of the State Court was held in the month of June, 1881. It does not appear that the case was noticed for trial for that term by either party. That term commenced June 6th and ended prior to September 1st. The defendants move to remand the suit.

It is plain that the suit was not removed in time. There was nothing to interfere with its being triable, legally, at the June term. The notice of motion for a commission and a stay was not a stay. The plaintiff was bound to remove the suit at least before the end of the June term, if he was to re-

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move it at all. (*Forrest v. Keeler*, 17 *Blatchf. C. C. R.*, 522.)

The plaintiff contends that the question of time cannot be considered in this Court, because the State Court passed upon it in its order. It is true that the State Court adjudicated upon it, but it did so *ex-parte* and without a hearing of the defendants. The Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470, § 5,) provides that if, in any suit removed to this Court, it shall appear to its satisfaction, at any time after the suit is removed, that it "does not really and substantially involve a dispute or controversy properly within the jurisdiction" of this Court, this Court shall proceed no further therein but shall remand it to the Court from which it was removed. This provision has recently been construed by the Supreme Court, in *Babbitt v. Clark*, (13 *Otto*, 606, 610.) It is there said by the Court that a decision by the Circuit Court that the necessary steps were not taken to remove the case is a decision of the question of its jurisdiction; and that the question of whether a removal was made in time is a question of jurisdiction. In that view it is for this Court to determine its jurisdiction, however that question may previously have been decided by the State Court.

The motion to remand is granted.

Strong & Cadwalader, for the plaintiff.

James C. Foley, for the defendants.

The Averill Chemical Paint Co. v. The National Mixed Paint Co.

THE AVERILL CHEMICAL PAINT COMPANY

vs.

THE NATIONAL MIXED PAINT COMPANY AND OTHERS. IN EQUITY.

Re-issued letters patent No. 7,031, granted April 4th, 1876, to Damon R. Averill, for an improvement in paints, the original patent, No. 66,773, having been granted July 16th, 1867, for an improved paint compound, are invalid. The original was for a paint composed of certain specified ingredients, two of which were emulsating agents, nothing being said about any vessel to contain the paint. The re-issue is for a paint of the same ingredients, other than the specified emulsating agents, with any emulsating agents, and packed in tight vessels.

The re-issue was granted on proof that, before the original application, the inventor had put up his paints in tight vessels: *Held*, that § 4,916 of the Revised Statutes did not authorize this to be done.

(Before WHEELER, J., Southern District of New York, October 29th, 1881.)

WHEELER, J. This suit is founded upon re-issued letters patent No. 7,031, dated April 4th, 1876, granted to Damon R. Averill, assignor, for an improvement in paints. The claim is for "A mixed liquid paint, composed of oxide of zinc or other pigments, oil, turpentine or benzine, water, and one or more emulsating agents, put up in tight vessels or cans." The original patent was No. 66,773, dated July 16th, 1867, for an improved paint compound, particularly described by ingredients and quantities like that in the re-issue, but with lime-water and silicate of soda, which were emulsating agents, but not stated to be such, specified as parts of the combination and compound. The claim was for "A paint composed of the ingredients herein named, and prepared and compounded substantially in the manner specified." There was no allusion in the patent to anything to contain the paint. Liquid mixed paints produced by the use of emulsating agents were known and used before Averill's discovery, and paints had been contained in cans and other tight vessels before that time, but no

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paint had been made by the use of his precise combinations and ingredients before. On the application for a re-issue the patentee made proof that, prior to his application for the original patent, he had put up his paint in cans and other tight packages and noticed its advantages for being put up in that way, which appears to have been satisfactory to the Commissioner that this mode of packing was a part of the original invention, and, upon that proof, the re-issue appears to have been granted. The defendants do not use the combination or compound described in the original patent. The principal defences are, that the re-issue is not supported by the original and is, therefore, void; that the patentee was not the original and first inventor of the invention described in the re-issue; and that, if the re-issue can be upheld at all, the defendants do not infringe any part for which it is valid. The original patent was valid enough, apparently, for the particular kind of paint described in it. The re-issue, if it is for that kind of paint only, packed in tight vessels, may be valid, for it would merely narrow the scope of the claim upon the same invention, from that kind of paint everywhere to that kind of paint only when so packed. But the re-issue is not limited to that particular kind of paint; it extends to all forms made from the same ingredients, other than the emulsating agents specified, by the use of any emulsating agents. This expands the original patent, not only beyond the scope of the claim upon the invention described, but beyond the scope of that invention. The whole invention there described was of a particular kind of liquid mixed paint; the invention described in the re-issue is of all kinds of liquid mixed paint packed in tight vessels. The invention of packing in vessels is not at all described or even alluded to in the original patent. So, the question is presented, whether the Commissioner of Patents is authorized to grant a re-issue of a patent for an invention in addition to that shown in the original, upon proof, in the absence of any drawing or model showing the invention in the original, that the addition was really a part of the same invention sought to be patented in the original. This question does not now seem to be open.

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In *Powder Company v. Powder Works*, (98 U. S., 126,) the patents were for compositions or articles of manufacture like that here. That part of Section 53 of the Act of July 8th, 1870, (16 U. S. Stat. at Large, 205,) which is now section 4,916 of the Revised Statutes, authorizing amendment of patents upon proof, in the absence of any drawing or model, was relied upon and came under consideration. It was there held, that this clause did not authorize the Commissioner to grant a re-issue for a different invention, or to determine that one invention was the same as another or different one, or that two inventions essentially distinct constituted but one. The question was left open as to whether that clause related to all patents or only to patents for machines, but no room was left for adding to the invention by proof. Under that decision this re-issue cannot stand. If it could stand, the only invention covered by it, of which Averill was the first discoverer, would be packing this paint in tight vessels. Such vessels impart no quality to the paint. They are no more useful to this kind of paint than to others, in proportion to the amount used. The paint, on account of its own valuable qualities, has found its way into extensive use through the ordinary vehicles for paints, and Averill has, doubtless, contributed largely to its success, but it has been done by business enterprise rather than patentable invention. What he is really the first inventor of the defendants have not taken.

Let there be a decree dismissing the bill of complaint, with costs.

John R. Bennett and George Harding, for the plaintiff.

Edmund Wetmore, for the defendants.

Van Deusen v. Nellis.

JUSTUS VAN DEUSEN AND OTHERS

vs.

JACOB H. NELLIS. IN EQUITY.

The first claim of re-issued letters patent No. 8,962, granted to John E. Hetherington, November 11th, 1879, for an "improvement in artificial honey-comb foundations," the original patent having been granted to him October 1st, 1878, namely, "As a new article of manufacture, an artificial honey-comb foundation produced from a cake of wax having on each side a series of hexagonal depressions with flat bottoms, said bottoms forming a continuous sheet, from each side of which rise the ribs which form the borders of the hexagonal depressions, substantially as shown and described," claims nothing which was patentable, in view of what existed before.

(Before BLATCHFORD, J., Northern District of New York, October 29th, 1881.)

BLATCHFORD, J. This suit is founded on re-issued letters patent No. 8,962, granted to John E. Hetherington, November 11th, 1879, for an "improvement in artificial honey-comb foundations," the original patent having been granted to him, as inventor, October 1st, 1878. The following is the specification of the re-issue, including what is inside and what is outside of brackets, omitting what is in italics: "Figure 1 [represents] is a front view. Fig. 2 is a transverse [vertical] section in the plane x, x , Fig. 1, on an enlarged scale. Similar letters indicate corresponding parts. This invention consists in [a honey-comb foundation produced from a cake of wax having on each side a series of hexagonal depressions with flat bottoms, said bottoms forming a continuous sheet, from each side of which rise the ribs which form the borders of the hexagonal depressions, whereby the cost of such honey-comb foundations is reduced and the durability of the article is increased; also,] in the combination with an artificial honey-comb foundation [produced from wax] of wires [or other strands] which pass through the foundation and prevent it from sagging and

stretching, and also strengthen it, thereby making it less liable to breakage while being handled; [further,] *The invention also consists* in the combination with a honey-comb foundation [produced from wax] of one or more supporting wires or strands, extending across the [foundation] *cake* at suitable points to prevent sagging when in the hive and breakage in handling. As is well known, artificial honey-comb foundations [are produced from] *consist of* sheets or cakes of wax, which are pressed between rollers or dies, whereby the sheets receive a series of hexagonal depressions, presenting the appearance of a honey-comb in section. These *cakes or* foundations are placed in the bee-hives, and by this arrangement the bees are caused to build their cells regularly. [In all the artificial honey-comb foundations of this class known to me, the bottoms of the hexagonal depressions have been made in the form of an inverted pyramid, and, in order to produce this shape, a considerable depth of wax is required, and, furthermore, the operation of forming such foundations requires great care. My foundation is made of a cake, *A*, of wax with a series of hexagonal depressions, *a*, the bottoms, *b*, of which are flat, and, in fact, form a continuous flat sheet, (see Fig. 2,) from each side of which rise the ribs, *c, c*, forming the sides of the hexagons. In order to give additional strength to the flat bottom of each depression, the ribs, *c*, on one side of the cake, *A*, are so placed that they unite in the centre of one of the depressions on the opposite side, and *vice versa*, as indicated by dotted lines in Fig. 1 of the drawings. By this arrangement I am enabled to produce artificial honey-comb foundations with great economy of wax, since the weight of one of my flat-bottomed foundations is less than one-half of that of one of the old foundations with pyramidal bottoms covering the same; and, furthermore, my flat-bottomed foundations can be formed much easier than those with pyramidal bottoms, so that in their production a considerable saving of time and labor is effected in addition to the saving in stock. In order to increase the strength of the artificial honey-comb foundation produced from wax, I apply to the same a series of wires,

d, d.] It has been found, however, that these foundations stretch or sag when they are put into the hive, by which defect their utility is greatly impaired. Another objection is that these cakes are very frail, and consequently they are easily broken or cracked while being handled. Referring to the drawings, the letter *a* designates the depression in the cake of wax, and *b* are the elevated rims or ridges separating these depressions from each other. The letters, *d, d*, indicate a series of wires which pass through the foundation. These wires may be inserted into the sheets of wax before they are pressed between the rollers or [the] dies; or they may be inserted during the process of manufacture, in any suitable manner, the characteristic feature or principle of [my] *the* invention being that the wires or strands of inelastic material are embedded in the cake or [foundation,] *comb*, or traverse the same on either or both sides. These wires pass through or are inserted into the foundation at a distance of about seven-eighths of an inch apart. Of course, I do not limit myself to that precise distance; but I have found that the best result is obtained if the wires are thus placed. By this arrangement I strengthen the honey-comb foundation, making it less liable to injury while being handled, and also prevent it from sagging or stretching, [to which foundations of this class are subjected, particularly in hot weather.] Of course, I do not limit myself to wires to produce this result, since threads or strands of any inelastic or non-expanding material may be used as well. [I do not claim as my invention an artificial honey-comb foundation produced from a cake of wax having on each side hexagonal depressions with pyramidal bottoms, such being old and well-known.] What I claim as new and desire to secure by letters patent is—1. [As a new article of manufacture, an artificial honey-comb foundation produced from a cake of wax having on each side a series of hexagonal depressions with flat bottoms, said bottoms forming a continuous sheet, from each side of which rise the ribs which form the borders of the hexagonal depressions, substantially as shown and described. 2.] The combination, with a honey-comb foundation [produced

from wax,] Of wires [or strands,] embedded in and passing through the foundation, to increase its strength and durability, substantially as set forth. [3] 2. The combination, with a honey-comb foundation [made of wax,] of one or more supporting wires extending across the [foundation] *cake*, whereby the sagging of the [foundation] *cake* is obviated when in the hive and the liability to breakage in handling is prevented." Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, we have the text of the specification of the original patent.

The specification of the original patent does not claim a honey-comb foundation having hexagonal depressions with flat bottoms, either made of wax wholly or in part, or made of some other substance. The embedded wires are made a necessary feature of the first claim of the original, and the supporting wires are made a necessary feature of the second claim of the original. The first claim of the original is converted into the second claim of the re-issue, and the second claim of the original is converted into the third claim of the re-issue, with the limitation, in the second claim of the re-issue, that the foundation is to be produced from wax, and with the limitation, in the third claim of the re-issue, that the foundation is to be made of wax. The text of the original specification does not make any allusion to the fact that the hexagonal depressions have flat bottoms. But figure 2 of the drawings in the original shows that the bottoms are flat, and the specimen filed in the Patent Office with the application for the original patent showed it. So, also, the text of the original specification did not allude to the fact that the ribs on one side of the cake are so placed that they unite in the centre of one of the depressions on the opposite side, and *vice versa*. But that was shown in figure 2 of the drawings of the original and in the said specimen.

It is shown that the defendant has infringed the first claim of the re-issue. The main defence is that there is nothing in such first claim, in view of what existed before, which

was patentable. It is admitted that an artificial honey-comb foundation, produced from a cake of wax having on each side a series of hexagonal depressions with pyramidal bottoms, the cake forming a continuous sheet, from each side of which rose the ribs forming the borders of the hexagonal depressions, existed before. But it is claimed that the foundation with flat bottom depressions requires less wax, and is thus cheaper, besides requiring the consumer to eat a less quantity of artificial comb. It is said that where the depressions have pyramidal bottoms, or lozenge-shaped bottoms, the base and the side walls are so thick that the bees, in building up the cells, do not thin the wax sufficiently, whereas where the bottoms are flat the base is thin and the side walls are thin and can be high and sharp, so that the bees utilize the excess of wax in constructing the comb, and thus time and labor and material are saved.

The patent granted to Samuel Wagner, No. 32,258, May 7th, 1861, for "artificial honey-comb," is introduced by the defendant. The specification says: "My new manufacture consists in a substitute for the central division or foundation of the comb built by bees, either with or without the whole or any portion of the walls forming the hexagonal cells projecting from the division, which substitute is artificially and suitably formed upon both sides or faces and of any suitable material which is susceptible of receiving the desired and necessary configuration. * * * Figs. 1 and 2 of the drawings represent my new manufacture in plan, the black lines showing the salient angles on the obverse side, from which spring its walls, which form hexagonal cells. The red lines show similar angles on the reverse side, and the red and black lines illustrate the relative disposition of the cells." Figs. 1 and 2 show that the ribs on one side are so placed that they unite in the centre of one of the depressions on the opposite side, and *vice versa*. "Fig. 1 represents comb foundation suitable for the foundation of drone comb, while Fig. 2 represents that suitable for worker comb." The hexagons in the comb in Fig. 1 are of larger size than those in the comb in Fig. 2. The

specification then goes on to describe apparatus for making the foundation: "Figs. 3a and 3b are elevations of one of the hexagonal solids, which, when used as herein specified, will produce the comb foundation shown in Fig. 1 and in section on an enlarged scale in Fig. 4. A mold is prepared, similarly to those used in the production of printers' type, in which solids are cast which will accurately fill the interior of a newly formed cell of a natural comb of the kind of which it is desired to form the central division. Numbers of type or solids being produced they are locked together in a form like printers' type, and fac-similes of the assemblage are produced by either of the well-known processes of stereotyping or electrotyping. Two of these stereotypes or electrotypes are made to act, by means of a press or otherwise, upon the opposite sides or faces of an interposed sheet of suitable material, which action gives the sheet the configuration desired. It is best to obtain in this division or foundation sheet a uniform degree of tenuity, which can only be done by closely imitating the natural waxen comb, which is effected by so placing the dies that the apices formed at the juncture of the three rhomboidal facets of each hexagon shall be exactly opposite the juncture of the sides of three facets of adjacent hexagons forming the reverse side. The angles of the rhomboidal facets should be as nearly as possible 109° and 71° , and the dies should not be permitted to approach each other so nearly as to reduce the thickness of the interposed material much less than the one-hundredth part of an inch. Should it be deemed desirable to form the hexagonal walls of the cells, or any portion of them, the type or solids should be formed as seen in Figs. 3a, 3b, with a band or projection around them of about the one two-hundredth part of an inch in thickness, and some taper may be given to the type from the band toward the rhomboidal facets. * * * Amongst the many materials which may be used may be mentioned compounds of which wax forms a part, rubber and gutta percha, and compounds of which they or either of them are components, papier maché, &c., &c. Thin sheets of metal, reduced to the tenuity of

foils, may be used, though I prefer good non-conductors of heat, improved by being rendered waterproof, if not so. Very many materials and compounds not mentioned may be used, but it is unnecessary herein to attempt to specify them, as my invention is not confined to and is independent of any particular material. It may be mentioned that with some materials heat, as well as pressure, may be used in shaping the artificial comb foundation. Many variations may be made in my invention, which, though not improvements upon it, embody its essence. For example, the relative arrangement of the impressing dies may be varied, so as to produce a different arrangement of cells on the obverse and reverse sides of the comb foundation from that shown in the drawings, in which case the thickness of the division plate would have to be increased, provided the pyramidal depressions made by the three rhomboidal facets terminating each hexagon were retained. Such depressions might be dispensed with and the foundation sheet might be impressed so as to leave slightly projecting ridges of the material from which the sides of the cells can be extended on each side of the sheet. But I do not recommend any departure from the closest imitation possible of the natural central sheet of the comb as formed by bees. To render the artificial comb foundation acceptable to the bees, it is not requisite that any portion of the sides of the cells should be formed thereon, as the salient angles on either side, formed at the edges of the described depressions, are a sufficient guide to the bees, and from them they will commence the waxen sides of their hexagonal cells. By the employment of my invention in bee hives, perfect regularity of combs and their kind is insured, and the production of drones prevented to any extent desired. I propose to take honey from store combs built upon my artificial foundations, by removing the full combs from the hives, and by slicing off the natural waxen superstructure. The artificial central portion of the comb being then replaced in the hive, will be again built upon by the bees, saving to them always the elaboration of wax and the time required for the construction of this part of the comb, which consumes more

time in its natural construction than any other parts of the comb of equal weight, because fewer laborers can be engaged upon it at one time than on other portions." The claim of Wagner's patent is this: "As a new article of manufacture, artificial substitute for the central division of comb built by bees, which presents to them, on both sides thereof, guides for the construction or continuation of the sides of the comb cells, whether the same is constructed with or without the whole or any portion of the sides of the cells."

It is objected to the Wagner patent that it does not speak distinctly of a foundation made wholly of wax. It does not exclude such a foundation, and such a foundation is within the general terms of the materials spoken of in it. It names compounds of which wax forms a part. Foundations wholly of wax, and otherwise answering Wagner's description, existed before Hetherington's invention. Wagner distinctly says that the pyramidal depressions may be dispensed with, and the foundation sheet, which is, necessarily, a flat sheet, be impressed so as to leave slightly projecting ridges of the material. It is true that he says he does not recommend any departure from the closest imitation possible of the natural central sheet of the comb as formed by bees. Some persons may prefer pyramidal bottoms. Some may prefer flat bottoms. Wagner shows the use of either, as a mechanical structure. Hetherington, for certain reasons, preferred flat bottoms. Others think that such reasons for using flat bottoms are overborne by other reasons for using pyramidal bottoms. With the Wagner patent and with foundation made wholly of wax with pyramidal depressions, there was no invention in the first claim of the plaintiff's re-issue. It was a mere selection of a form of foundation which Wagner described, besides showing how to make it. The use of wax alone in such form, after wax alone had been used for the foundation with pyramidal depressions, did not make the foundation of that form made wholly of wax a new manufacture, or a new invention, in the sense of the patent law.

This is an action at law, which has been tried before the

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Court without a jury. On the facts, I find generally for the defendant and direct that judgment be entered for him, with costs.

John Van Santvoord, for the plaintiffs.

Horace E. Smith, for the defendant.

MARIETTA R. STEVENS

vs.

GEORGE F. RICHARDSON, CHARLES G. STEVENS, JOHN L.
MELCHER, AND MARK M. STANFIELD. IN EQUITY.

S., a citizen of New York, brought a suit in the State Court against R. and C., citizens of Massachusetts, and J. and M., citizens of New York. R. and C. removed the suit into this Court. There being a separate controversy between S., on one side, and R. and C., on the other, to which J. and M. were not necessary parties, and which could be fully determined as between the parties to it without the presence of J. or M.: *Held*, that the suit was removable under § 2 of the Act of March 3d, 1875, (18 U. S. Stat. at Large, 470.)

No prior notice to the adverse party of the presentation of a petition for removal is necessary.

A bond on removal is not required by § 3 of said Act to be executed by the petitioner for removal, if it be executed by sufficient surety.

A party does not, by voluntarily appearing in a suit in a State Court, waive his right of removal.

A motion that the plaintiff replead in this Court denied.

(Before BLATCHFORD, J., Southern District of New York, October 31st, 1881.)

BLATCHFORD, J. This suit was brought in the Supreme Court of New York and has been removed into this Court by the defendants Richardson and Stevens, as citizens of Massachusetts, the other defendants being citizens of New

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York. The plaintiff is a citizen of New York, and moves to remand the cause. The removal, if made, must be made under § 2 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.) The only pleading put in in the State Court, before the removal, was the complaint. The controversies set out therein are not varied by the petition for removal or by any thing now before this Court. Stevens and Richardson are trustees for the plaintiff under the will of Paran Stevens. Stevens and Melcher and the plaintiff are executors of said will. Stanfield is lessee of an apartment house in New York, which is part of the trust property, under a lease thereof made to him by Stevens and Richardson, as such trustees, by the terms of which the rent he is to pay is to be paid by him to them. The complaint alleges that a valid agreement exists between the plaintiff and said trustees, that said rent should and shall be paid directly by Stanfield to the plaintiff, at New York, that they insist on having Stanfield pay it to them, and that he refuses to pay it to her. In addition to alleging a violation of said agreement by said trustees, the complaint alleges that the trustees have wrongfully retained from the rent paid to them moneys claimed to have been paid by them for expenses of suits brought by them against Stanfield to compel him to pay the rent to them, and moneys for commissions, and have refused to pay over to the plaintiff the whole amount of moneys so received from Stanfield, and have wholly failed in the performance of their duties as trustees, and reside in Massachusetts, and have no property in the State of New York, and are of but little pecuniary responsibility, and the plaintiff has suffered great loss, and been put to great expense, in her efforts to protect herself against the wrongful acts of said trustees. There is other property besides said apartment house held by said trustees under said trust. Founded on the above allegations the complaint prays (1) that the trustees be enjoined from collecting from Stanfield the rent of the apartment house, and from receiving and disposing of any moneys as trustees of the plaintiff, and from doing any act as such trustees; (2) that they be required to ac-

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count as such trustees; (3) that they be removed as such trustees; (4) that some other and competent person or persons be appointed trustee or trustees in their place; (5) that they pay to the plaintiff such damages as she has sustained by their wrongful acts. Certainly, in the matters which are the subject of those five prayers there are controversies which are wholly between the plaintiff on the one side and the trustees on the other side. Stanfield is not an indispensable party to any of said controversies, although he may be a proper party to the suit, by reason of his being lessee of the apartment house. Melcher, as executor, has no concern with any of said controversies.

But there are other matters in the complaint. The trust for the benefit of the plaintiff is one for her life, for the sum of \$1,000,000. It has not been completed by the executors. It was for the executors, under the will, to put into the hands of the trustees property to that amount. That has been done only in part. The complaint prays that the executors may complete the trust fund by conveying real estate to the trustees, and that they pay to the plaintiff what may be due to her for interest on the trust fund, and that they pay to her or for her benefit, out of the estate, other moneys which she claims, and that they do not charge against her certain moneys which the estate has paid, and that they be restrained from paying to certain trustees of certain residuary trusts created by said will any moneys now in, or which may hereafter come into, their hands, as such executors. It also prays that the rent of said apartment house under the lease to Stanfield be paid to the plaintiff. There is nothing in any of these allegations which makes Melcher, as executor, a necessary party to any of the said controversies between the plaintiff and her trustees. Those controversies, as embodied in the said five prayers in respect to the trustees, can be fully determined as between the parties actually interested in them without the presence of either Melcher or Stanfield as a party. If the suit had sought no relief but what is embodied in said five prayers, neither Melcher nor Stanfield would have been a necessary

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or an indispensable party to those issues. The controversies involved in those five prayers do not cease to be controversies wholly between the plaintiff on the one side and the trustees on the other because the plaintiff has chosen to embody in her complaint distinct controversies between herself and the executors, or a controversy between herself and Stanfield. Whether there is or is not such a connection between the various transactions set out in the complaint as to make all of the defendants proper parties to the suit and to every controversy embraced in it, at least in such a sense as to protect the complaint against a demurrer for multifariousness or misjoinder, is a question not affecting the matter of removal. If there was any fault in pleading, in that respect, it was the plaintiff's. On the question of removal she must abide by the case made by her complaint. The question of multifariousness or misjoinder comes up after the question of removal is settled. The latter question must be settled now upon the complaint. If hereafter, under any different phase of the case, it should appear that the cause does not really or substantially involve a dispute or controversy within the jurisdiction of this Court, it will be the duty of the Court, under § 5 of the Act of 1875, to remand it to the State Court. The case is one directly within the decision in *Barney v. Latham*, (13 *Otto*, 205,) and it must be held that the case was one for a removal of the whole of the suit by the trustees, even though Melcher or Stanfield or both of them may have been proper parties to the suit. There is nothing in the case of *Blake v. McKim*, (13 *Otto*, 336,) which in any manner qualifies anything decided in *Barney v. Latham*. In that case there was a single controversy between the plaintiff, a citizen of Massachusetts, and three executors, two of whom were citizens of Massachusetts and one of whom was a citizen of New York, the suit being one to recover the amount of a bond executed by the testator of the defendants. The Court held that the case was not removable under either of the two clauses of § 2 of the Act of 1875, on the ground that all of the executors were indispensable parties to the suit, and that

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two of them were citizens of the same State with the plaintiff, and that the suit embraced only one indivisible controversy.

The State Court made an order accepting the petition for removal and the bond filed, and ordering the removal of the suit into this Court. This order was made without prior notice to the attorney for the plaintiff, and the plaintiff contends that the proceedings for removal were, therefore, irregular. The Act of 1875 does not require any notice. The filing of the petition and bond makes it the duty of the State Court to accept them and to proceed no further in the suit. In the present case the petition and the bond were filed on the 27th of July, 1881, and the Court on that day accepted them, without requiring any previous notice. As was said by this Court in *Wehl v. Wald*, (17 *Blatchf. C. C. R.*, 346 :) "If, as matter of discretion, a State Court can or does require notice in any case of removal, such notice was dispensed with in this case by the State Court; and, the matter being one of practice, it is for the State Court to regulate its own practice, and this Court will not review such a question." It has always been held, in this Court, that no notice was necessary. (*Fisk v. Union Pacific R. R. Co.*, 8 *Blatchf. C. C. R.*, 243, 247.)

The bond for removal is not executed by Stevens and Richardson, nor does it name them as obligors. It is executed by two other persons, who are named in it as obligors. It recites that Stevens and Richardson have petitioned for the removal of the suit, and is conditioned that they shall do what the statute requires. The obligors are not otherwise called in the bond sureties for Stevens and Richardson. The plaintiff contends, that, as § 3 of the Act of 1875 says that the petitioner for removal is to "make and file" the bond, the bond is void and the removal invalid. This objection is not tenable. The statute is satisfied, as to the bond, if a bond with sufficient surety is filed. The petitioner for removal makes the bond, in the sense of the statute, if he offers it to the Court as the bond required. By § 639 of the Revised Statutes he was required to offer good and sufficient surety. The Act of 1875 means no more. Aside from this, a new

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bond, running in the name of and executed by Stevens and Richardson as principals, and the former sureties as sureties, was filed in the State Court on the 28th of September, 1881, that Court having made an order, on the 22d of September, that it be filed there *nunc pro tunc*, as of July 27th. A copy was filed in this Court October 1st. The first day of the next term of this Court after July 27th was October 17th. The notice of motion to remand was not served till October 3d. Nothing to affect the status of the suit was done in the State Court from July 27th to October 1st. The objection as to the bond is overruled.

It is also objected, that Stevens and Richardson voluntarily appeared in the State Court without the summons being served upon either of them; that, therefore, they were not in Court and no action was pending as to them; that their voluntary appearance was a submission to the jurisdiction of the Court, and a waiver of their right of removal; and that they also waived such right by obtaining in the State Court an extension of their time to answer, and by giving notice of a motion in said Court to dissolve a temporary injunction which that Court had granted restraining them from collecting any rent from Stanfield, and from doing other acts as trustees. There is no force in these objections. A plaintiff, who brings his suit voluntarily, has a right to remove the cause under the same statute. The trustees were called on to appear and defend their trust, by the bringing of the suit and the issuing of the injunction, and they lost no right of removal by saving to the plaintiff the trouble, expense and delay of bringing them in compulsorily or by doing what they did. .

The defendants move that the plaintiff replead in this Court. It is not so entirely clear that there are causes of action at law set forth in the complaint which are so separate and distinct from the equitable causes of action set forth as to make it proper now, on this motion, to compel the plaintiff to divide the suit into a suit or suits at law and a suit or suits in equity. If this is to be done at all it should be done only

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as the result of pleading. The same remark applies to any questions of multifariousness or misjoinder of causes of action or of parties.

I see no sufficient ground in the papers for requiring the plaintiff at present to give additional injunction security to the trustees; and, although the notice of motion includes the giving further security to the executors, there is nothing in the moving affidavits on that subject.

John Berry, for the plaintiff.

John E. Burrill, for the defendants.

THE CORTES COMPANY

vs.

SIGMUND M. THANNHAUSER AND AUGUST THANNHAUSER. IN
EQUITY.

LUCIUS E. CHITTENDEN AND OTHERS

vs.

THE SAME. IN EQUITY.

The plaintiffs in these suits, having been sued at law by the defendants in these suits, and having equitable defences to the suits at law, which could not be availed of therein, but which, if established, would warrant a perpetual stay of the suits at law, moved, in these suits, for an order that the service of subpoenas to appear and answer therein upon the attorneys for the plaintiffs in the suits at law be deemed sufficient and proper service upon said plaintiffs as defendants in these suits, they being either foreigners or citizens of California, and residents of California: *Held*, that the motion must be granted, and that a copy of the subpoena ought also to be served on the parties personally, if they could be found, wherever they might be.

Such a suit is not an original suit and the subpoena in it is not original process,

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within § 1 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) and Rule 13, in Equity, does not apply to such a subpoena.

(Before BLATCHFORD, J., Southern District of New York, November 2d, 1881.)

BLATCHFORD, J. The defendants in these suits have brought two suits at law in this Court against the Cortes Company and one suit at law in this Court against Lucius E. Chittenden and others, to recover sums of money alleged to be due. The above are suits in equity. The first of them is brought to restrain the prosecution of all three of the suits at law, and the second to restrain the prosecution of the suit at law against Chittenden and others. Properly interpreted there is no prayer in either of the two bills for any relief except injunctions to stay the prosecution of the suits at law. The ground stated for such relief is, that there is, on the facts alleged in the bills, and which are alleged in the same terms in both bills, an equitable defence to all of the suits at law, which, if established as alleged, would warrant a perpetual stay of the suits, but that such defence cannot be availed of in the suits at law, by reason of the distinction maintained, in the jurisprudence of the United States, between proceedings at law and proceedings in equity, as shown by the ruling in *Montejo v. Owen*, (14 *Blatchf. C. C. R.*, 324,) and in the cases there cited.

The plaintiffs, on filing the bills and on notice to the attorneys for the plaintiffs in the suits at law, now move for an order that service of the subpoenas to appear and answer in these suits, or such other notices as the Court shall adjudge proper, with a view to enable the Court to proceed with these suits, upon said attorneys, be deemed sufficient and proper service upon the said plaintiffs as defendants in these suits, they being either foreigners or citizens of California, and residents of San Francisco, in California.

It is a well settled principle, that a bill filed on the equity side of a Court to restrain or regulate a judgment or a suit at law in the same Court, is not an original suit, but ancillary and dependent, and supplementary merely to the original

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suit; and that such a bill can be maintained in a Federal Court without reference to the citizenship or the residence of the parties. (*Logan v. Patrick*, 5 *Cranch*, 288; *Dunn v. Clarke*, 8 *Peters*, 1; *Clarke v. Mathewson*, 12 *Id.*, 164; *Freeman v. Howe*, 24 *Howard*, 450, 460.) On this principle, the equity suit not being an original suit, the process or notice issued on its being brought, to advise the plaintiff in the suit at law that it has been brought, is not regarded as original process, or as an original proceeding. Such plaintiff is in Court, voluntarily, for the purpose of prosecuting his suit at law and obtaining a judgment, and thereby makes himself subject to any control the Court may find it equitable to exercise over his suit at law and over the matters involved in it, to the extent of perpetually staying its prosecution, if, on equitable considerations, that ought to be done. All that is requisite is, that the plaintiff in the suit at law should have notice from the Court of the institution of the proceeding in equity. If he will not defend against it, after receiving such notice, he will have to submit to the stay of his suit at law, if, after an *ex-parte* hearing, the Court shall deem such stay proper. He is in Court for the purposes of the action of the Court on the subject-matter of the proceeding in equity, by having become the plaintiff in the suit at law. He is represented, for the purpose of giving notice to him of the institution of such proceedings, by his chosen attorney in the suit at law. This is a necessity. His residence may be unknown, or, if known, remote. His attorney is presumed to know how and where to communicate with him. Therefore, it is proper to give such notice to the attorney, and it is the duty of the attorney to bring such notice to the attention of his client. If he does not, or, until he does, it is proper that the client should submit to any stay the Court may direct of further proceedings in the suit at law, reasonable time being given for the communication of such notice to the client, that he may discontinue the suit at law, or defend the suit in equity, or put the matter into the hands of other counsel, or have a fair opportunity to take such other course as shall be

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deemed advisable. It may be proper to cause an additional and direct notice to be served on the plaintiff in the suit at law personally, if that is feasible.

It is provided, by § 1 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470,) that no civil suit shall be brought before a Circuit Court or a District Court "against any person, by any original process or proceeding, in any other District than that whereof he is an inhabitant, or in which he shall be found at the time of serving such process, or commencing such proceeding," except as provided in § 8 of the same Act, which provides for bringing in absent defendants in suits to enforce or remove liens on property within the District. Substantially the same provision as to "original process" was contained in § 11 of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) and was re-enacted in § 739 of the Revised Statutes. A subpoena or notice issued on the filing of such a bill as those in the present suits has never been regarded, in the Courts of the United States, as an original process or proceeding, and has been allowed to be served on the attorney for the plaintiff in the suit at law, and even to be served on such plaintiff out of the District. (*Logan v. Patrick*, 5 *Cranch*, 288; *Reed v. Consequa*, 4 *Wash. C. C. R.*, 174; *Ward v. Seabry*, 4 *Id.*, 426; *Dunlap v. Stetson*, 4 *Mason*, 349, 360; *Dunn v. Clarke*, 8 *Peters*, 1, 3; *Bates v. Delavan*, 5 *Paige*, 299; *Doe v. Johnston*, 2 *McLean*, 323, 325; *Sawyer v. Gill*, 3 *Woodb. & M.*, 97; *Segee v. Thomas*, 3 *Blatchf. C. C. R.*, 11, 15; *Kamm v. Stark*, 1 *Sawyer*, 547, 550; *Lowenstein v. Glidewell*, 5 *Dillon*, 325.)

It is further objected, that the Supreme Court, by Rule 13, in Equity, has provided that "the service of all subpoenas shall be by a delivery of a copy thereof, by the officer serving the same, to the defendant personally, or by leaving a copy thereof at the dwelling-house or usual place of abode of each defendant, with some adult person who is a member or resident in the family." The practical construction of this Rule has always been not to extend it to subpoenas on bills such as those in the present cases. The practice before referred to

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has existed while Rule 13 has been in force and has never been understood to be affected by that Rule.

An order for substituted service on the attorneys will be made, and, in addition, it will be ordered that a copy of the subpoena be served on the parties personally, if they can be found, wherever they may be.

L. E. Chittenden, for the plaintiffs.

S. B. Clarke and *J. W. Lilienthal*, for the defendants.

P. LORILLARD & Co.

vs.

DOHAN, CARROLL & Co. IN EQUITY.

Re-issued letters patent No. 7,862, granted, October 24th, 1876, to Charles Siedler, for an improvement in plug tobacco, the original patent, No. 158,604, having been granted to him January 12th, 1875, are valid.

The invention covered by the re-issue, defined.

The date of an invention patented in Great Britain is the date when the specification was filed in the Great Seal Patent Office.

The question of the novelty of the invention, considered.

(Before WHEELER, J., Southern District of New York, November 2d, 1881.)

WHEELER, J. This cause depends upon re-issued letters patent No. 7,362, dated October 24th, 1876, granted to Charles Siedler, upon the surrender of original letters patent, No. 158,604, dated January 12th, 1875, for an improvement in plug tobacco. Their validity is contested upon the grounds of want of patentable invention, want of novelty, and want of support of the re-issue by the original. They have been before the United States Circuit Court for the Eastern District

of Pennsylvania, in *Lorillard v. McDowell*, (11 *Off. Gaz.*, 640,) where it was held, on a motion for a preliminary injunction, by McKennan, J., that the re-issue was supported by the original, and was not void either for want of invention or novelty; and in *Lorillard v. Ridgeway*, (16 *Off. Gaz.*, 1,231,) where it was held, on final hearing, in view of the defences there interposed, by the same Judge, that there was a lack of patentable invention and novelty. The question as to the re-issue was the same there that it is here; the decision upon it in the former case was not disturbed by the change of opinion in the latter, and that decision is a sufficient authority for holding the same way here; and, besides, the reasoning upon which that conclusion was reached is fully concurred in. The same respect would be paid to the decision in the later case upon the other questions, if it had been made upon the same evidence, and it has not been claimed or urged in argument but what that case should be followed unless this case is substantially different. The invention is of a mode of marking and identifying each separate plug of tobacco as being of a particular quality, origin or manufacture, by tin labels, or tags, having the desired inscription upon them, and prongs extending backwards from their edges, pressed into the plugs, in the last processes of manufacture, with their faces even with the surface of the plugs, where they would be held by the prongs and the surrounding tobacco. Among the things in evidence in that case, as anticipations, were English letters patent No. 1,516, dated April 30th, 1874, granted to Gibson, Kennedy, and Prior, for an improvement in the manufacture of tobacco, and apparatus employed therein, the specifications of which were filed in the Great Seal Patent Office October 27th, 1874, which was before Siedler was then shown to have made his invention, and in those specifications was described, as placed in each plug of tobacco, in the process of finishing, at the surface, "a thin metal plate bearing the manufacturer's name, abode, trade-mark or mark of quality." Now, Siedler's invention is shown to have been prior to the filing of that specification. This removes that patent from

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among the anticipations to be considered. (*De Florez v. Reynolds*, 17 *Blatchf. C. G. R.*, 436.) This point is not disputed in behalf of the defendants. The use of these plates or discs was the most like Siedler's method of anything shown in that case. In view of that use it was well said, that it was "difficult to see how the mere attachment of prongs to a flat disc, which had been used before, would involve a patentable exercise of inventiveness." That use being removed, the question is now materially changed and is to be decided upon the case as now presented. (*United States Stamping Company v. King*, 17 *Blatchf. C. C. R.*, 55.) The anticipations now to be considered are screws, nails, coins, and other similar things, pressed into the surface of the plugs at these stages of manufacture, to identify some particular plugs to the manufacturers themselves, and not to go into the market with the plugs, to be observed by tradesmen or consumers; and initial letters and trade names impressed into some plugs of lots placed in the molds at the same time, by metallic letters placed loosely among the plugs, within the molds, or attached to the inner surface of the molds and intended to mark those plugs for consumers; and there were tin labels, almost exactly like Siedler's, in use upon the corks of bottles. The coins and things of that sort would not accomplish the whole object sought by Siedler's invention; they would identify particular plugs through the processes of manufacture, and that is all they were used for, but would be of no use between manufacturers and customers or consumers. The letters were not labels, and could not be made to answer the place of labels on that substance. From the nature of the tobacco the letters must be large, to be legible; too large to have enough to answer the purpose of a label put upon the surface of single plugs; and they could not, by the means used, be put upon but few of the plugs as they were subjected in a body to the final pressures. The tin labels from corks could not be placed upon the finished plugs tastefully and securely, because the hard pressed surface of the plugs would not receive and hold them. The object desired was to mark each plug so that the

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manufacturer or packer would be known by the mark on each plug throughout, until it should reach the consumer, and to do this by such means that products of one could not be placed under the marks of another, and so as to leave the plugs symmetrical, and tasteful to those who will use them. A label or tag was to be sought which would not be large enough to cover much of the surface, of such material that letters of a size small enough so a sufficient number could be used might be put upon it, which could be fastened permanently enough to remain until the plugs reached the consumer, and which would be removable then and would not injuriously affect the quality of the tobacco. Siedler accomplished this by the tin label, which could be lettered, having prongs, put into each plug in the last stages of manufacture and pressed into them, so that the shape of the plug would be preserved, the label could not be removed without disfiguring the plug, therefore, one could not be exchanged for another, and it could be removed by the consumer when that part of the plug should be reached, and which would not affect the quality of the tobacco at all. This could not be wrought out from the means at hand before, without thought and contrivance enough to warrant the decision of the Patent Office that they constituted invention. No one had done this before him. Therefore, as the case now stands, the patent must be adjudged to be valid. With the re-issue valid there is no question about infringement.

Let there be a decree for an injunction and an account, according to the prayer of the bill, with costs.

Livingston Gifford, for the plaintiffs.

Samuel S. Boyd, for the defendants.

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CHRISTOPHER C. CAMPBELL*vs.***THE MAYOR, &C., OF THE CITY OF NEW YORK. IN EQUITY.**

Letters patent No. 42,920, granted May 24th, 1864, to James Knibbs, for an improvement in steam fire-engine pumps, are valid.

The invention defined.

The question of its novelty examined.

Certain uses of the invention held to have been experimental.

Under §§ 7 and 15 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119, 123,) and § 7 of the Act of March 3d, 1839, (*Id.*, 354,) a sale or use of an invention more than two years before the application for the patent, must in order to defeat the patent, have been a public sale or use with the consent or allowance of the inventor.

(Before WHEELER, J., Southern District of New York, November 9th, 1881.)

WHEELER, J. The plaintiff has title to letters patent No. 42,920, dated May 24th, 1864, and issued to James Knibbs, assignor, for an improvement in steam fire-engine pumps, whereby such an engine, having constant power for discharging several streams of water through lines of hose of various lengths, may be made to throw fewer streams, or the same number through longer lines, when the resistance to discharge would be greater, without varying the power, or causing undue strain upon the working parts or hose, by means of a passage from the discharge to the suction side of the pump, regulated by a valve, for the removal of the surplus water on the discharge side caused by the restriction upon the discharge. This suit is brought for an infringement of this patent, which is not denied, if the patent is valid. The validity of the patent is questioned upon the ground that Knibbs was not the first inventor of this improvement; that the same had been patented abroad, prior to his invention; and that the same had been in public use and on sale in this country for more than two years prior to his application.

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The anticipations relied upon are steam fire-engines which were made by the Amoskeag Manufacturing Co., of Manchester, N. H.; the steam fire-engine Philadelphia, which was made by Reaney, Neafie & Co., of Philadelphia; and the patent of R. A. Wilder, No. 27,662, dated March 27th, 1860. The foreign patents are the English one of Joseph Bramah, No. 1,948, dated April 18th, 1793, and the French one to Benoit Duportail, No. 19,532, dated June 12th, 1857. The facts as to the existence, knowledge of, and use of the devices in these fire-engines are to be found from a comparatively large mass of evidence, consisting of documents, drawings, pictures, and the somewhat conflicting testimony of numerous witnesses as to various facts and circumstances. Upon the whole, after much examination and consideration, it satisfactorily and beyond any fair doubt appears, that, prior to the invention of Knibbs, the Amoskeag Manufacturing Co. made and put into rotary steam fire-engines manufactured by them a passage for water leading from the suction to the discharge sides of the engines, which could be opened and closed by a valve, for the purpose of having water carried through it, and past the pumping apparatus, and discharged through the hose by hydrant pressure, when the pumps were not operating, which was used at places where there was hydrant pressure for that purpose; and that Reaney, Neafie & Co. made and put into steam piston fire-engines tubes leading from the suction and discharge parts of the engine towards each other until they met, and in one tube from the place of meeting to the boiler, which could be opened and closed by valves, one in each branch, for the purpose of taking water from either the suction or discharge side into the boiler, the two branches leading from the suction and discharge sides constituting a passage controlled by two valves through which water could be taken from the discharge to the suction side, to relieve pressure on the discharge side; but it does not appear, by that measure of clear proof, beyond any fair or reasonable doubt, which is necessary to defeat a patent, that either of these devices was ever, before that time, used for the purpose of pass-

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ing water from the discharge to the suction side of the engines, to relieve undue pressure on the discharge side, caused by reducing the number of discharge openings or increasing the difficulties of discharge by lengthening the hose; nor that the utility of these passageways for that purpose was before that time known; neither does it at all appear that Knibbs derived any aid from either of these devices. The counsel for the defendant, after insisting strenuously that these passages were in fact used for the purposes of Knibbs' invention, likewise insist, that, in view of the existence only of these things, if that only should be found, Knibbs only put an old device to a new use, which would not be patentable. This presents the question, on this part of the case, whether such prior knowledge and use of a like device as is found to have been had will defeat the patent. Knibbs' invention was not to be used under all circumstances of the use of the engine. It was for use only in combination with the constant power for a larger discharge and a restricted discharge. The second claim of the patent, and the only one in controversy, is for the connecting passage and valve for the purposes described and set forth, the principal of which purposes was the use in that combination. The statutes providing for defences to suits upon patents require defendants to set forth the names and residences of persons having prior knowledge of the thing patented, and where and by whom it had been used. (*Rev. Stat. U. S., sec. 4,920.*) The proof must, of course, correspond with and support these allegations. The proofs in this case do not support the allegations that the persons knowing of and using the Amoskeag engines and the engine Philadelphia, as these persons are found to have known and used them, knew of and used Knibbs' invention. Those connected with the Amoskeag engines used the passage to avoid the pump, and those connected with the Philadelphia used only a part of it at a time, and then in connection only with contrivances for feeding the boiler, and neither of them used it in connection and combination with the working pump and over-pressed hose at all; and they respectively had knowledge co-

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extensive with the use they made. They had brought together all the parts necessary to accomplish the result he accomplished, but did not know how to use them. This is not the known use required to defeat a patent. (*Tilghman v. Proctor*, 102 U. S., 707.)

Wilder's patent is for a two-way valve in combination with apparatus for feeding a steam boiler with water, by which surplus water is returned to the tank. The combination with which it is made to work is entirely different from that in which this passage and valve is placed, and the working parts are not the same. The same may be said of the patents of Bramah and Duportail. Both were before steam fire-engines, with the necessities of their great and constant motive power, were known.

The facts in regard to use and sale of the invention prior to the application appear from the evidence to be, that Knibbs was the engineer of a steam fire-engine in use in the city of Troy for the protection of property there against fire, and, in the latter part of April, 1860, applied his invention in the form of a pipe leading from the discharge to the suction sides of the engine, with a globe valve between. The invention was tried and operated satisfactorily, except that he thought that the passage was rather small. This engine, which was called the Arba Reade, was continued in use, with the invention upon it, Knibbs continuing to be the engineer. In January, 1862, the city of Troy procured another steam fire-engine of substantially the same pattern, to which, at the request of Knibbs, his invention was applied in the form of an opening through the partition between the discharge and suction sides of the pump, with a valve working to a seat at the opening, through which the excess of water could be made to pass. This engine, which was called the J. C. Osgood, was put to use for the city and the invention operated satisfactorily to Knibbs, as well as to others concerned. The tube to the Arba Reade was made larger in February, 1863, and worked more satisfactorily to all. Knibbs thought of applying for a patent, consulted a solicitor of patents about it, and made application

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for the one that was granted, May 13th, 1864, without at any time intending to abandon his invention to the public. In 1861, and consequently more than two years before the application, the Amoskeag Manufacturing Co. made other steam fire-engines containing this invention, which were sold and went into use, and from that time until after the application such engines were occasionally made and sold by that company, and, perhaps, by other manufacturers, and went into the customary use. This was done without the consent and allowance of Knibbs. It is contended that these uses and sales, either those with or those without the consent and allowance of Knibbs, will defeat the patent. This invention, like that in *Elizabeth v. Pavement Co.*, (97 U. S., 126,) could not well be experimented with and tested in private. Its object was connected with purposes in their nature public, and its practice was necessarily somewhat of the same nature. The invention was not essentially varied by the trials and use made and was patented according to its features as first applied. Still, it was not clear to the inventor that no changes or modifications would be necessary, and necessary to be specified in the application for a patent, in order to obtain the full benefit of one. In this view, the use by him as engineer, and by the city of Troy at his request, is deemed to have been experimental and allowable, within the rule laid down in the case cited. Still, if consent and allowance of the inventor are not necessary to defeat a patent, the other sales and use were sufficient to accomplish that result. It has frequently been said, but in cases where the point was not directly raised, that such consent and allowance was not necessary. (*Egbert v. Lippman*, 15 Blatchf. C. C. R., 295; *Kelleher v. Darling*, 4 Clifford, 424.) And there are cases the other way. (*Andrews v. Carman*, 13 Blatchf. C. C. R., 307; *Draper v. Wattles*, 16 Off. Gaz., 629.) In view of these differences of opinion or statement, it may be well to recur to the statutes. In section 7 of the Act of July 4th, 1836, (5 U. S. Stat. at Large, 119,) it is provided that the Commissioner shall make or cause to be made an examination of the alleged invention or discovery, and, if it

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shall not appear, among other things, that it had been in public use or on sale, with the applicant's consent or allowance, prior to the application, and if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent for it. In section 15 of the same Act it is provided, that a defendant, in a suit for infringement, may set up, among other things, in defence, that the invention had been in public use or on sale with the consent and allowance of the patentee before his application for a patent. These are the only provisions for preventing the issue of a patent, or a recovery for the infringement of one, on account of the invention being in public use or on sale, except some provisions as to the effect of foreign patents, not material to this question, which were in force when this patent was granted. The 7th section of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 354,) does not provide for preventing the issue of a patent on this account, and does not enlarge in any direction, but is restrictive of, this defence. It saves to manufacturers and purchasers before the application for a patent the right to specific machines, manufactures, or compositions of matter, and provides that no patent shall be held invalid by reason of the sales, purchases or use, except on proof of abandonment, or that the purchase, sale or use has been for more than two years prior to the application. No purchase, sale or use after the invention would prevent or invalidate a patent but for these provisions of the Act of 1836, and it is against those provisions that the effect of the making, use, and sales of these specific articles is saved by the Act of 1839. The use saved against is the public use mentioned in the Act of 1836, as seems to have always been understood, although it is not mentioned as public, in the Act of 1839; and the being in use and on sale saved against are the public use and sale with the consent or allowance of the inventor, mentioned in the Act of 1836. (*Draper v. Wattles*, 16 *Off. Gaz.*, 629.)

Upon these considerations there must be a decree for the plaintiff. The patent has expired, and, therefore, no injunc-

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tion will be granted, unless further moved for upon some special grounds.

Let a decree be entered adjudging that the patent is valid, and that the defendant has infringed, and for an account, according to the prayer of the bill, with costs.

George H. Williams, for the plaintiff.

Frederic H. Betts and *C. Wyllys Betts*, for the defendant.

TURNER STROBRIDGE

vs.

LANDERS, FRARY & CLARK. IN EQUITY.

Re-issued letters patent No. 7,583, granted to Turner Strobridge, March 27th, 1877, for an improvement in coffee-mills, (the original patent, No. 159,467, having been granted to him February 2d, 1875, and re-issued to him as No. 7,174, June 13th, 1876,) are valid.

The first claim of said re-issue, namely, "A coffee or similar mill, having a detachable hopper and grinding shell, formed in a single piece, and suspended within the box by the upper part of the hopper, or a flange thereon, substantially as and for the purpose specified," is infringed by a mill constructed in accordance with the description and drawings of letters patent No. 204,865, granted to Rodolphus L. Webb, June 11th, 1878.

The re-issue is not for a different invention from the original, and does not contain new matter.

The questions of novelty and patentability considered.

The devices contained in the first claim held to be a combination and not merely an aggregation of parts.

(Before BLATCHFORD, J., Connecticut, November 10th, 1881.)

BLATCHFORD, J. This suit is brought on re-issued letters patent No. 7,583, granted to the plaintiff March 27th, 1877, the original patent, No. 159,467, having been granted to him,

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as inventor, February 2d, 1875, and re-issued to him, No. 7,174, June 13th, 1876. The drawings of the original and of No. 7,583 are the same. The following is the specification of No. 7,583, reading what is outside of brackets and what is inside of brackets, omitting what is in italics: "Figure 1 is a vertical section of a coffee mill embodying my invention. Fig. 2 is an under view of the cover, and fig. 3 is a perspective view of the hopper. Like letters refer to like parts, wherever they occur. My invention relates to the construction of coffee [and] *or* spice [mills in such manner that the hopper is inclosed in the box, and may be closed in turn by a sliding gate or cover, whereby a compact and neat mill is obtained.] *grinders; and it consists in suspending the hopper by means of the top of the box, and securing it in position by means of screws, which pass through the cover and through lugs or a projecting flange upon the hopper, whereby a covered hopper is obtained and the construction and attachment of the devices simplified; also, in providing the covered hopper with a sliding or movable gate, centered with the shank of the grinding nut and sliding upon the periphery or flange of the hopper, whereby hinges, springs or catches are dispensed with, and the gate slides aside, leaving an unobstructed opening for the admission of the article to be ground, and also in providing the hopper with projections or points which bite into the cover of the box and prevent the slipping or turning of the hopper, in connection with a cover projecting so as to rest upon the top of the box, and bind upon the upper edge of the hopper. * * ** A indicates the box, with its drawer, B, of any suitable construction. The top, C, of the box is cut away, [so that] *for the admission of the hopper [may be suspended therein] which I introduce from above, suspending it* by means of a projecting flange or lugs on the [hopper.] *hopper, and to [To] facilitate the suspension of the hopper, I preferably bevel the opening in top C to correspond with the curve of the hopper, as shown at [c.] c, which [This] also will diminish the liability of the splitting of the wood when the screws which secure the cover are [in-*

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roduced.] *introduced, (when a cover is used and secured, as shown.)* D represents the hopper or grinding shell, produced with a flange or lugs, *d*, by which it is suspended [in] *upon the top C of the box* [A. The hopper is fastened down, and also prevented from turning, by the screws *g*.] *A, and through which pass the screws g, which hold the hopper down, and prevent it from turning.* The hopper has the usual grinding face, *d'*, and a series of projections or points, *e*, which I provide for the purpose of taking hold upon the beveled edge *c* of the top C, to assist in preventing any movement of the hopper. These points, if sufficiently numerous, will of themselves prevent a change of position of the [hopper, so that screws may be omitted. This will be found the cheapest and most convenient way of suspending the] hopper. E is the cover, having a central opening for the passage of the shank of the grinding nut, and a sunken or recessed rim for the accommodation of the lugs *d*, or the flange of the hopper, so that the lower edge of the cover rests evenly upon the top C, and at the same time binds upon the hopper. This cover, E, is provided with a sliding gate or door, F, which is pierced, as at *f*, for the passage of, or made to rest against, the shank of the grinding nut, upon which it turns or bears, said gate F resting, by its lower edge, upon the upper edge of the hopper, and sliding or moving within or without the cover E, so as to be out of the way when the opening in the cover is unclosed. G represents the grinding nut, having a tapering shank, H, which passes through the cover, projecting portion of gate F, and the crank, and is secured above by the usual tightening nut, I. The devices are put together as follows: The cover and gate are placed upon the hopper, the shank of the grinding nut passed through the hopper, cover and crank, and secured by the tightening nut, the lugs or screw openings in the flange of the hopper are made to register with those in the cover, after which the operative parts are dropped into the opening in the top of the box, and secured by a single set of screws which pass through the cover and lugs or flange of the hopper. The projecting

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points on the outside of the hopper will bite into the top of the box, and, as the cover binds upon the upper edge of the hopper, these will, of themselves, if sufficiently numerous, be sufficient to prevent any movement of the hopper, so that, if desired, the screws need not pass through the flange of the hopper. The hopper may be suspended as shown, and the cover replaced by a bridge, to support the shank of the grinding nut. The grinding shell or hopper and the cover may be secured by a separate set of screws. The lower part of the grinding shell may be formed with lugs or projections, to guide or steady the grinding nut. Among the advantages of my invention are the simplicity of construction, and the readiness with which the several parts and the box may be adjusted or set up, whereby time and labor are saved and a serviceable article produced." Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, gives the text of the original specification. There are eight claims in No. 7,583. Only claim one is involved in this suit. It is as follows: "1. A coffee or similar mill, having a detachable hopper and grinding shell, formed in a single piece, and suspended within the box by the upper part of the hopper, or a flange thereon, substantially as and for the purpose specified." The original patent had four claims, as follows: "1. The hopper and grinding shell D, provided with points or projections *e* on its outer surface, in combination with cover E, projecting so as to rest upon the top of the box, and bind upon the upper edge of the hopper, substantially as and for the purpose specified. 2. In coffee or spice mills, the combination of box A, having a top C, with the hopper D, suspended within the box by means of lugs or projections, which rest upon or take into top C, and a cover, substantially as specified. 3. The combination of the hopper and grinding shell D, grinding nut G, having shank H and cover E, having a sliding gate or door F, substantially as and for the purpose specified. 4. The combination of cover E and grinding shell or hopper D, the latter provided with lugs or a flange, so that the two parts

may be secured to the box by a single set of screws, substantially as specified."

So far as can be discerned in the drawings of the original and the re-issue, the hopper and the grinding shell are represented as in a single piece without any indication of ever having been in two pieces. It is not stated in the re-issue that they are cast in one piece. The text says that D is the hopper or grinding shell, and that it has the usual grinding face *d*. That grinding face is shown, in the drawings, as extending down from the lower part of the hopper part proper, and as having the grinding nut revolving within it. The grinding face is the inner face of the grinding shell. There is nothing else on the point till we come to claim one, where it is said that the "hopper and grinding shell" are "formed in a single piece."

The elements which appear to be necessary, in claim one, are: (1.) A mill in the form of a box; (2.) a hopper and grinding shell formed in a single piece; (3.) the combined hopper and grinding shell detachable; (4.) such hopper and grinding shell suspended in the box by the upper part of the hopper, or a flange thereon; (5.) an arrangement of these features substantially as and for the purpose specified.

The defendant's structure which is claimed to infringe claim one of the re-issue, is constructed in accordance with the description and drawings of a patent granted to Rodolphus L. Webb, No. 204,865, June 11th, 1878, so far as anything involved in this case is concerned. That patent shows a box mill, with a cast metal top projecting, as a lateral flange, horizontally from the top edge of the hopper, on all four sides, and extending outwardly beyond the tops of the sides. The top is of one piece with the hopper proper, and the latter is of one piece with the grinding shell, as shown in the drawings; and this is the construction in the article put in evidence as infringing. The hopper and grinding shell are sunk in the box, so that there are covers which, when closed, rest on the upper face of the metal top. The patent states that the grinding shell may be cast as a part of the hopper,

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or may be attached thereto. The patent claims merely an arrangement for adjusting the grinding nut up and down, so as to make it run nearer to or farther from the grinding shell, and thus vary the quality of the grinding. This arrangement does not appear to be embodied in the mills produced and put in evidence as specimens of those made by the defendant.

The defendant's article is a mill in the form of a box. It has a hopper and a grinding shell formed in a single piece, they being cast in one piece. The combined hopper and grinding shell and top are detachable from the box by unscrewing screws which go through the sides of the box into lugs depending on the inside of the box from the under side of the top. The hopper and the grinding shell, through their connection with the metal top, are suspended in the box. Every point of advantage resulting from the combination of the features in claim one of No. 7,583, exists in the defendant's article.

Some question is made as to what is meant by the word "detachable" in claim one. It is not used in the descriptive part of the specification. But screws are shown and described which go through the lugs or flange on the hopper and into the wood of the box on top and thus fasten the hopper to the box. Of course, these are wood-screws, and removable at will; and so the hopper and shell are detachable. The defendant's hopper and shell and top are detachable in the same way, being attached in the same way. The defendant urges that its structure does not infringe because the hopper is not detachable from the top of the box. All that the defendant has done is to enlarge the size of the flange on the hopper. The sides of the box support the top of the box. When the flange is smaller than the top, it hangs in the top. When it is so large as to itself form a top and overlap the sides, the sides support the whole, that is, the flange top, the hopper and the grinding shell. The change is merely formal, and does not avoid infringement. The flange on the hopper may be gradually enlarged and the top of the box be gradu-

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ally cut away, until the wood of the top is all gone, and the flange replaces it, without in any manner affecting the principle of the Strobridge invention embodied in claim one. This is all that the defendant has done.

The answer sets up that the re-issue is not for the same invention as that described in the original, and that the re-issue contains new matter not found, suggested or described in the original. This objection is not tenable. The statement in the re-issue of that to which the invention relates is true, and is found, in substance, in the original. There is no statement in the re-issue of what the invention consists in. The statement in the original as to what the invention consists in is omitted in the re-issue. It was narrower than the real invention. The drawings of the re-issue and the original are the same. There is no new matter introduced into the re-issue. The re-issue truly describes the article and its parts. To say that the hopper is suspended in the box, when the original says that it is suspended from the top of the box, is not new matter, within the meaning of § 4,916 of the Revised Statutes.

The answer also sets up, that, in view of the previous state of the art, as shown in various patents set forth in the answer, the re-issue shows no novelty and discloses no patentable subject of invention, and that the re-issue is invalid for want of patentable quality.

This re-issued patent was adjudicated upon in the suit of *Strobridge v. Lindsay*, (2 *Fed. Rep.*, 692,) in the Circuit Court for the Western District of Pennsylvania, by Judge Acheson. The defendants' mill in that case was of the same construction as the mill of the defendant in this case. The defences there insisted on were non-infringement and want of patentable invention. The mill was held to infringe claim one of the issue. The question of the extension of the flange on the hopper was fully considered. Everything that is introduced into this case by the defendant, on the questions of novelty and patentability, was in the Lindsay case, except a mill called "Domestic Coffee Mill." In this, the hopper is

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elevated and not sunk in the box. There is a cast metal cover, covering the box and forming its top. The hopper is not of one piece with the cover, but rests on it and is secured to it by rivets. The grinding shell is loose, and has a flange at its upper edge, and is dropped into a depression surrounding the central hole in the cover, and has the hopper above it. Lugs on it, fitting into corresponding recesses in the cover, prevent it from turning. The grinding shell is supported against lateral strain or displacement by the cover. This structure has not a hopper suspended in the box, nor a grinding shell and hopper formed in a single piece, and neither meets claim one nor shows the defendant's arrangement.

The question of novelty and patentability was fully considered by Judge Acheson, especially in regard to the French mill, and the Elevated Hopper mill. Box coffee mills existed, such as the Elevated Hopper mill, the Livingston and Adams' mill and the Brown mill, in which the hopper and the grinding shell were formed in one and the same piece; and box coffee mills existed, such as the French mill, the Krutz mill, and the Clark mill, in which the hopper was suspended in the box; and, in the Domestic Coffee mill, the metal top which carried the hopper and the grinding shell was attached to the box by wood screws. But no coffee mill existed combining all the features embodied in claim one of No. 7,583. It was, however, urged, in the Lindsay suit, that it did not, in view of the prior structures, require invention to pass to a structure with the combined features of claim one of No. 7,583. Judge Acheson held that it did. The entire record in the Lindsay suit is in evidence in this suit. There is nothing new in this suit as to the matters considered and passed upon in the other suit, in regard to patentability and novelty, and the Domestic Coffee mill presents no features in regard to forming the hopper and grinding shell in a single piece, and in regard to a hopper suspended in the box, which were not presented by structures among those which were before Judge Acheson. Under these circumstances, it would be proper, as it is usual, to follow the former decision on final

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hearing, in another Circuit Court. But, irrespective of this, I entirely concur in the views of Judge Acheson.

It is strongly urged that claim one of No. 7,583 cannot be sustained, because the old devices aggregated in it do not by their combination produce a novel result which is the fruit of the combination. It is a sufficient answer to this view to say, that a hopper and grinding shell formed in a single piece and suspended in the box by the upper part of the hopper or a flange therein did not exist before, combined in a mill. The evidence shows that the suspension in the box requires, in order to dispense with the yoke or bridge which is below the grinding shell in the French mill, that the grinding shell and the hopper should be formed in a single piece, because, when the hopper is sunken, the grinding shell no longer has the lateral support of the box cover. Hence, the combination of those features do produce a novel result as the fruit of the combination. If that combination had existed before, the question whether adding to that the feature of detachability made another patentable combination might arise. But it does not arise now.

The defendant, down to 1877, was not making a mill with a sunken hopper. In that year, Webb, who was in its employ, having before him the French mill and a mill made by the Charles Parker Company, in accordance with the Strobridge patent, entered into the manufacture of the infringing mill. It desired to make a mill with a sunken hopper, which should be a cheaper mill than the French mill. It substantially copied the Charles Parker mill, merely extending the flange of the hopper. It formed the hopper and the grinding shell in one piece, and got rid of the lower supporting yoke of the French mill. In the Strobridge mill, the only lateral support of the grinding shell is the hopper. Therefore, there must be a strong, unyielding union between the grinding shell and the hopper. Where the hopper is elevated, the grinding shell is sustained laterally against the strain of grinding by the top of the box. The advantages thus resulting from Strobridge's arrangement have been availed of by the

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defendant by the use of what is covered by claim one of No. 7,583.

There must be a decree for the plaintiff, for an account of profits and damages, and a perpetual injunction, with costs.

Bakewell & Kerr, for the plaintiff.

B. F. Thurston and *C. E. Mitchell*, for the defendant.

JAMES L. PLIMPTON

vs.

SAMUEL WINSLOW. IN EQUITY.

The defendant held to have been protected, in this case, while attending the examination of witnesses for the plaintiff, in New York, in an equity suit pending in Massachusetts, brought against him by the plaintiff, from the service on him in New York of a subpoena to appear and answer in this suit.

(Before BLATCHFORD, J., Southern District of New York, November 12th, 1881.)

BLATCHFORD, J. A suit in equity brought by the plaintiff in this suit against the defendant in this suit, for the infringement of letters patent, is pending in the Circuit Court for the District of Massachusetts. Prior to November 2d, 1881, it had been verbally agreed between Mr. Roberts, the counsel for the defendant, and Mr. Clark, the counsel for the plaintiff, in the suit in Massachusetts, that the defendant might have testimony on his behalf taken in the city of New York, for use in that suit, before Mr. Thompson, as a special examiner, and Mr. Clark verbally agreed to attend before Mr. Thompson at any time, on telegraphic notice, for the purpose. Such notice was given that the plaintiff, together with the defendant and Mr. Roberts, attended in New York, before Mr.

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Thompson, on November 2d. Mr. Clark was not present on that day. Witnesses were examined on that day on behalf of the defendant, before Mr. Thompson, by Mr. Roberts, as counsel for the defendant, with the acquiescence of the plaintiff, who was present during the examination, and it was agreed between the plaintiff and Mr. Roberts that Mr. Clark should have the right to afterwards cross-examine the said witnesses and enter objections to all questions in the direct testimony, and the examination was adjourned to November 3d. On that day Mr. Clark appeared and cross-examined the said witnesses, and also, in conjunction with Mr. Roberts, signed a stipulation in writing, dated November 2d, and entitled in the Massachusetts suit, stipulating and agreeing that Mr. Thompson might be appointed as special examiner, by the Court in Massachusetts, to take the testimony for the defendant, in the suit, in New York, under the 67th Rule in Equity, as amended. After the adjournment on the 2d of November, and on that day, the defendant was served personally, in the street, in New York, after he had left the building where the examiner's office was, and a few steps therefrom, with a subpoena to appear and answer in this suit, and with a copy of the bill and other papers in this suit and notice of a motion to be made for an injunction herein. The bill in this suit was filed November 2d, and is a bill for the infringement of the same letters patent. The defendant now moves to set aside the service of the subpoena and the other papers, on the ground that the privilege of the defendant was violated.

It is very clear that the motion must be granted. The defendant attended as a party before the examiner. The regularity of the examination was recognized by the attendance of the plaintiff, by the arrangement he then and there made for future cross-examination by Mr. Clark, and by the antedated written stipulation which Mr. Clark signed the next day. The examination was thus made a regular proceeding in the suit in Massachusetts. The defendant had a right to attend upon it in person, whether he was to be himself examined as a witness before Mr. Thompson or not, and he had a

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right to be protected, while attending upon, it from the service of the papers which were served in this suit. He attended in good faith, the examination was pending and unfinished, and he was served during the interval of an adjournment. The privilege violated was a privilege of the Massachusetts Court, and one to be liberally construed, for the due administration of justice. (*Juneau Bank v. McSpedan*, 5 *Bissell*, 64; *Brooks v. Farwell*, 2 *McCrary*, 220; *Bridges v. Sheldon*, 18 *Blatchf. C. C. R.*, 507, 515.)

The only objections urged against the motion are technical ones—that the written stipulation was not signed till after the service was made; that there was no order as to the examination entered in the Massachusetts Court; that no formal written notice of the intended examination was served; that the sitting before the examiner was, therefore, unauthorized; and that the written stipulation cannot have an effect as of a date earlier than November 3d. If these objections were allowed to have force, the plaintiff would only be placed in the position of having, by the prior verbal arrangements made, sanctioned by the subsequent action of himself and his counsel thereunder, decoyed the defendant to visit New York, by deceptive inducements, and thus the case would be brought within the principle laid down in *Union Sugar Refinery v. Mathiesson*, (2 *Clifford*, 304,) and in *Steiger v. Bonn*, (4 *Fed. Rep.*, 17.) The plaintiff and his counsel, by what they said and did, represented to the defendant that the proceeding before Mr. Thompson was regular and orderly and authorized, and induced him to rely on that view. He had a right, as a party to the Massachusetts suit, to attend a regular examination of witnesses in that suit, in New York, and to be protected, while so attending, from the service of the papers in this suit. The plaintiff is estopped from raising the objections as to regularity.

The motion is granted.

E. N. Elliot, for the plaintiff.

Wetmore, Jenner & Thompson, for the defendant.

Brooks v. Bailey.

CHARLES J. BROOKS

vs.

EDWIN C. BAILEY. IN EQUITY.

To a bill in equity brought in the Circuit Court for the District of Vermont, alleging that the plaintiff was a citizen of Massachusetts and the defendant a citizen of Vermont, the defendant pleaded that he was a citizen of New Hampshire; *Held*, that the plea was bad.

The Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470, § 1,) extends the jurisdiction to suits between citizens of different States, without requiring either party to be a citizen of the State where the suit is brought.

(Before WHEELER, J., Vermont, November 28th, 1881.)

WHEELER, J. This is a bill in equity in which the orator sets himself up as of Boston, in the State of Massachusetts, and a citizen of that State, and the defendant as of Stowe, in the State of Vermont, and a citizen of that State. The defendant has pleaded, that, at the time of the bringing of the bill he was, and now is, a citizen of the State of New Hampshire, and that neither he nor the orator then was, or now is, a citizen of the State of Vermont; and this plea has been argued. By the provisions of the Constitution the judicial power of the United States was made to extend to controversies between citizens of different States. (*Art. III, sec. 2.*) By § 11 of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 78,) Congress conferred upon the Circuit Courts jurisdiction of all suits of a civil nature, at common law or in equity, of the required amount, between a citizen of the State where the suit is brought and a citizen of another State. (*Rev. Stat.*, § 629.) At the same time it was provided that no civil suit should be brought therein, against an inhabitant of the United States, by original process, in any other district than that whereof he should be an inhabitant, or wherein he should be found, at the time of serving the writ.

(*Rev. Stat.*, § 739.) These provisions continued in force until the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 470.) The former was the law which conferred jurisdiction in this class of cases; the latter was a limitation upon the place where suits might be brought, for the ease of defendants. Both were operative in determining where the place might be. (*McMicken v. Webb*, 11 *Pet.*, 25.) The Act of March 3d, 1875, extended the jurisdiction to all suits of a civil nature at common law or in equity, of the required amount, in which there should be a controversy between citizens of different States, without limiting it to depend at all upon citizenship of either party in the State where the suit should be brought, but retained the limitation upon the bringing of suits in other Districts than that whereof the defendant should be an inhabitant or in which he should be found. It has been argued that, because this limitation is in substantially the same language in the Act of 1875 that it was in the Act of 1789, it must receive substantially the same construction that it had always borne. This would be correct if it was to be applied to the same jurisdiction otherwise conferred, but it is not. This provision in the Act of 1789 was only to be applied in determining in which District of the two States, between whose citizens jurisdiction of suits was given, the suit must be brought. In the Act of 1875 it is to be applied in determining in which District of all the States, between the citizens of any two of which jurisdiction of suits is given, the suit must be brought. Under the latter Act, this Court, in common with other Circuit Courts, has jurisdiction of all suits, of the required amount, between citizens of different States, among all the States, while under the former it had jurisdiction only of suits between citizens of this State and those of some other of all the States. The suit could be brought only in the District where the defendant resided or was found, under either. That this defendant was found in this District when the process was served is not denied, and, therefore, the right to bring the suit in this District is not denied.

The Narragansett.

The plea is overruled, and the defendant must answer over by the January rule-day.

Eleazar R. Hard, for the plaintiff.

George Wilkins and *Henry Ballard*, for the defendant.

THE NARRAGANSETT.

A schooner and a steamer collided. The schooner's side lights were burning, but not properly, and were not seen from the steamer, though those on her were vigilant. The steamer did all that it was incumbent on her to do, when she discovered the schooner's light. The schooner did not exhibit any lighted torch, although she saw the approach of the steamer: *Held*, that the schooner was wholly in fault.

(Before BLATCHFORD, J., Connecticut, December 2d, 1881.)

THIS was a libel *in rem*, filed in the District Court. After a decree for the claimant, the libellants appealed to this Court.

Samuel L. Warner, for the libellants.

Thomas M. Miller, for the claimant.

BLATCHFORD, J. A consideration of the proofs in this case, as well the additional proofs taken in this Court as those found in the apostles, leads me to the same conclusion arrived at by the District Court, that no fault is shown on the part of the Narragansett, and that the libel must be dismissed.

The District Judge found that the schooner's green and red side lights were properly set, that is, set in their proper places, and properly screened, the green on the starboard side and the red on the port side, and that they were burning. He did not find that they were burning properly. On the contrary,

he finds that the master and the lookout of the steamboat were on the watch for lights, and were careful and vigilant, and were in the exercise of due diligence, and yet did not see any light on the schooner till close upon her; that, if the lights on the schooner had been visible, those persons could have seen them; and that the lights were not capable of being seen. He also finds that there was nothing in the condition of the atmosphere to prevent the steamer from seeing the schooner's lights. I concur in those conclusions. The statute (*Rev. Stat. U. S.*, § 4,233, *Rules 3 and 8*) requires not only that sail-vessels under way shall carry a green light on the starboard side and a red light on the port side, but that those lights shall be "of such a character as to be visible on a dark night, with a clear atmosphere, at a distance of at least two miles." It is very plain that the schooner's lights did not meet such requirement. They may have been burning and visible to those on the schooner's deck. But, for some cause, not at all connected with the vigilance or watchfulness of those on board of the steamboat, the schooner's lights were not seen by them. The District Judge said, that, without undertaking to find affirmatively why the lights were not visible, he found simply that the steamboat was in the exercise of due diligence, and that the lights were not capable of being seen; and that, for that fact, he relied much on the appearance and manner of the master of the steamboat, which impressed him favorably, and that the master was for several hours continuously before the collision in the pilot house, in attendance upon his duty, and that it was his business and duty to look out for lights, and that there was no inducement to be negligent but every motive to be careful. These considerations lead me to a concurrence with the District Judge. The master of the steamboat was using a glass all the time to search for lights. The glass of the schooner's green lantern was broken in the collision. The master of the steamboat found a bit of it and says that he considered it badly smoked up, that it was damp and greasy, and that, if all of the lantern was in that condition, it was not fit to emit light. The

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green light was the one which the steamboat would have seen if the schooner was on the course claimed by the schooner. Kerosene was burned in the schooner's lights. No light from her was visible to the two persons in the pilot house of the steamboat, or to the bow watchman of the steamboat, until the steamboat was close upon the schooner, and then what appeared to be a dim, colorless light on the schooner was seen by those on the steamboat. The light not being seen to be green or red was taken to be a binnacle light in the cabin of a vessel going the same way with the steamboat. The bow watchman of the steamboat says that a kerosene lamp will naturally get blurred on the top; that, while a smoked green lantern would seem green near at hand, it might seem without color far off; and that to a man looking at its smoked part it might seem colorless, while to a man looking upward to it it would seem green. All this may explain why the schooner's lights were not seen, though it is not necessary the steamboat should do so. The libel alleges that the schooner was "duly lighted," that her green and red lights were "brightly burning," that she "had all proper, sufficient and lawful lights set and burning, as aforesaid." The burden is on her to show this, and she has not done so.

The steamboat, on discovering the schooner, did all that it was incumbent on her to do. On the view she had of the light she had a right to think it was on a vessel going the same way. She slowed and ported so as to go by on what she reasonably believed to be the starboard hand of the schooner. Rule 21 in § 4,233 provides that every steam vessel, when approaching another vessel, so as to involve risk of collision, shall slacken her speed, or, if necessary, stop and reverse. She did slacken her speed, and it did not then appear to be necessary to stop or to reverse. Afterwards, as soon as danger of collision appeared from the sudden coming of the sails of the schooner into view from the light thrown on them by the head light of the steamboat, the latter stopped and backed, and backed strong, and her wheel was put hard-a-port. She could do no otherwise and no more.

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There is another point in this case. It is provided by § 4,234 of the Revised Statutes, that every sail vessel, shall, "on the approach of any steam vessel during the night-time, show a lighted torch upon that point or quarter to which such steam vessel shall be approaching." The schooner saw the approach of the steamboat from a long distance and failed to show the lighted torch. This neglect is set up in the answer. There was a torch in the cabin of the schooner, ready for use, and easily accessible. The mate of the schooner, who was at the wheel, did not know that there was a torch on board. The master did. He states that he never saw a torch used. It is quite clear that the torch could have been got out and lighted and used in time to have prevented the collision. A mistaken idea seems to have been entertained by the master and the mate that a lighted torch was to be used only when a steam vessel was approaching from behind. This steamboat was not approaching from behind, if the testimony of those on the schooner is to be believed. But the statute has no such meaning. The lighted torch is to be exhibited to the approaching steam vessel from whatever direction she is coming, and is to be shown on the point or quarter to which she is approaching. It was clearly a fault in the schooner, contributing to the collision, that she did not exhibit a torch light. (*The Eleanora*, 17 *Blatchf. C. C. R.*, 88.) The steamboat had a right to rely on the exhibition of a torch light, if the schooner was in such a position that the steamboat was approaching her, and the absence of the torch light has an important effect in determining that the steamboat was not negligent and observed due caution.

The libel is dismissed, with \$121 25 costs of the District Court, as taxed, and costs to the claimant in this Court.

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**CHRISTOPHER MEYER AND MARY A. EVANS, ADMINIS-
TRATRIX, &C.**

vs.

GOODYEAR'S INDIA RUBBER GLOVE MANUFACTURING COMPANY.

Re-issued letters patent granted to Christopher Meyer and Mary A. Evans, administratrix, &c., November 17th, 1874, for an "improvement in india rubber shoes," the original patent having been granted to Christopher Meyer and John Evans, as inventors, February 21st, 1871, and re-issued to them July 16th, 1872, do not contain new matter, the part of the invention not embraced in the original specification, and included in the re-issue, having been shown in the model originally deposited in the Patent Office.

The re-issue has no patentable novelty, in view of letters patent granted to Elias C. Hyatt and Christopher Meyer, January 17th, 1854: and the same question was decided in *Meyer v. Pritchard*, (12 Blatchf. C. C. R., 101.)

(Before SHIPMAN, J., Connecticut, December 5th, 1881.)

SHIPMAN, J. This is a bill in equity to restrain the alleged infringement of re-issued letters patent, granted to the plaintiffs on November 17th, 1874, for an "improvement in india rubber shoes." The original patent was granted to Christopher Meyer and John Evans, as inventors, on February 21st, 1871, and was re-issued to the same persons on July 16th, 1872. Infringement is not denied.

The invention was brought into existence by the fact that, in 1869 and 1870, "four-holed" india rubber ladies' shoes, or shoes having four slits upon the top of the upper, and made to imitate a lady's sandal with interstices in the upper, were in great demand, and could not be made rapidly enough at the factory of Mr. Meyer. The edges of these slits or holes were turned over by hand and were then cemented. The idea of the inventors was, instead of cutting the uppers from a plain sheet of rubber, and then cementing the ribs upon a plain surface, to cut the uppers from a sheet which, having

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been formed when in a plastic state, between an engraved roller and a plain roller, should be thickened up into cords or ribs at the desired places on its surface. The claim in the patent was for "one or more transverse ribs, in rubber shoes or sandals, formed by thickening the substance itself in the lines or directions thereof while in the sheets, by means of rolling dies, as and for the purpose described." Before the invention, the edges of the mouth of the shoe were strengthened and made to present a finished appearance, by being turned over by hand and cemented. Sometimes, cords or strips of rubber were placed by hand upon the edge, and were cemented. As a part of the invention, but not included in the original specification, claim, or drawings, the inventors ribbed the edge of the mouth of the shoe with a rib formed in the manner which has been described. The first re-issue was obtained for the purpose of including this rib within the patent. The claim was as follows: "As a new article of manufacture, india rubber shoes, with strengthening or other ribs homogeneous with the substance of the body, formed by thickening up the said substance in the forming of the sheet, substantially as specified." The validity of the first re-issue was then tested, in this Circuit, in the case of *Meyer v. Pritchard*, which was tried before Judge Blatchford, (12 *Blatchf. C. C. R.*, 101.) The Court held that there was no patentable novelty in the invention, in view of the patent granted to Elias C. Hyatt and Christopher Meyer, January 17th, 1854. The first and third claims of this patent were as follows: "1st. Producing a shoe sole, or other analogous manufacture, in india rubber, or gutta percha, in one piece, having variety of thickness in its different parts, by the use of rollers, whose surfaces present the reverse of the forms to be produced, at a single operation, substantially as herein described." "3d. We also claim such soleing or analogous manufacture in continuous sheets, at one operation, by rolling, as described." The present re-issue was thereupon granted, in which the claim is limited to the rib around the mouth of the shoe and is in these words: "As a new article of manu-

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facture, india rubber shoes having a strengthening rib around the top or mouth of the shoe, (whether with or without similar ribs or other parts of the shoe,) formed not by turning over the edge or lapping one piece upon another, but thickened up from, and homogeneous with, and forming a part or portion of, the body of the upper, substantially as specified."

Divers defences are set up in the answer; the two which are relied upon are the invalidity of the re-issue, because it is for a different invention from that described in the original patent; and lack of patentable novelty, in view of the Hyatt and Meyer patent of 1854.

It is substantially admitted by the plaintiffs that the invention of the second re-issue was not suggested or indicated in the original patent or drawings, but it is claimed that the invention was shown in the model which was originally deposited in the Patent Office, and that this fact was conclusively found by the Commissioner of Patents when the first re-issue was granted. These positions, both of fact and law, are strenuously denied by the defendant. There are two models in the Patent Office, purporting to be the models belonging to this patent. One merely shows the ornamental buckle or rosette represented in drawing No. 3, and does not contain the invention of the re-issue. The other does not contain the invention in any particular, but is a shoe in which the cords upon the vamp and around the mouth were placed by hand between the lining and the rubber, in accordance with the system described in a rejected application of John Evans, one of the patentees. The Evans and the Meyer and Evans' applications were filed on the same day. The theory of the plaintiffs is, that the two shoes have been misplaced, and that the Meyer and Evans' shoe was, by mistake, placed with the models of the rejected applications, and was destroyed in the fire of 1877. The defendant claims to have proved that the models are the same that were originally deposited by the applicants.

Without recapitulating the testimony upon this question,

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my conclusions are: 1st. The rib around the mouth of the shoe was not indicated in the original drawings, or in the original specification, as a part of the invention, because neither the patentees nor their solicitor had at that time any idea of including this rib in the patent. In view of the file wrapper and contents of the original patent, it is not credible that Mr. Meyer, who was, in 1871, a manufacturer well acquainted with the questions arising in patent litigation, should have directed his solicitor to include the cord around the mouth, or that his solicitor, who had been an assistant examiner in the Patent Office, should have supposed that he was including that part of the invention. The conversations of which they speak undoubtedly took place, but at a later period; and the witnesses are mistaken in the matter of dates. 2d. I find, from the testimony of Olmstead and Crairy, that, before the application for a patent, a new engraved roll was made, upon which a light cord was engraved around the shoe mouth. I further find, that, by means of this roll, a few shoes were made, as an experiment and not for sale. One of these shoes must have been taken to the solicitor. 3d. Either this shoe, or one made upon this roll, was sent to the Patent Office, or no model was sent. The presumption is, that a model was sent, and this presumption is strengthened by the fact of the first re-issue. Notwithstanding the opinion of Mr. Parkinson, I think that this presumption, coupled with the positive evidence in its support, has not been overcome. If a model was sent, it must have been a shoe with a machine made rib around its mouth, because a shoe showing the machine made ribs upon the upper must necessarily have had the machine made ribs upon the mouth. Inasmuch as the part of the invention of the patentees which was not embraced in the original specification, and is now included in the re-issue, was shown in the model, the re-issue is not invalid upon the ground that it contains "new matter."

The next position of the defendant is, that the patent has no patentable novelty, in view of the Hyatt and Meyer patent, and that this precise question was decided by Judge

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Blatchford in the Pritchard case, and is, therefore, now the law of this Circuit. The plaintiffs contend that the decision was upon a patent claiming india rubber shoes, with strengthening *or other* ribs, homogeneous with the surface of the body, &c., while the claim of this re-issue is limited to india rubber shoes having a strengthening rib around the mouth of the shoe, and is for a shoe having a rib formed in the old way, but in a location where, by reason of its location, a new and improved article of manufacture is obtained. It, therefore, becomes important to ascertain the scope of Judge Blatchford's decision. He says, after quoting the specification of the first re-issue: "The invention set forth in this specification, as shown by the description and the claim, is to thicken up the plastic india rubber, in desired places, in the sheet, as the sheet is being formed between two rolls, by means of grooves and ribs on one of the rolls, the other roll being plain, so as to leave the sheet thicker where the india rubber has entered the grooves than it is in the other parts of it, and thus make a sheet which is a flat plane on one side, and has raised ribs or projections on the other side. The application of this idea, developed in the specification, is, to make these ribs or projections on that part of the sheet which is to be used to form the upper part of the shoe—that part which covers the top of the foot, and that part which surrounds the opening through which the foot enters the shoe. The advantage set forth is, that the ribs or projections thus made are of one substance with the rest of the material, and in homogeneous connection with it, and, therefore, better and more cheaply, uniformly and perfectly made than when made by pasting on strips by hand to form the ribs or projections. The patented invention is really complete when the sheet is made by the means described, ready to be made up into a shoe, and to be vulcanized. The process of making the sheet into the shoe and vulcanizing the shoe is no different from the process used to make a sheet into a shoe and vulcanize the shoe when the ribs or projections are formed by pasting strips on the sheet by hand." The head note, which correctly states

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the result to which the Court came, is in the following language: "A sheet made according to the patent to Meyer and Evans is made strictly in accordance with the directions of the earlier patent, without any addition. The sheet of the earlier patent was used to cut therefrom the sole of an india rubber shoe, the sheet and the sole having a variety of thickness in different parts, and being formed in one piece, at a single operation, by the use of rollers, one of which had a surface the reverse of the form to be produced. The sheet of the later patent is used to cut therefrom the upper part of an india rubber shoe, such sheet and such upper part having a variety of thickness in different parts, and being formed in the manner above described. The two manufactures are analogous, the sole, in the one case, and the upper part, in the other, being cut and made from the sheet in the same manner; and the shoe with the upper part so thickened up is not a new article of manufacture, in view of the prior shoe with the sole so thickened up." It is evident, from the tenor of the opinion, that the Court did not dwell upon the fact that the claim was a general one, for ribs wherever situated, whether for ornament or for utility, but examined the alleged invention as it was presented in the specification and in the product of the factory, *i. e.*, ribs upon the part of the upper which covers the top of the foot, and the part which surrounds the mouth of the shoe, and possessing peculiar advantages, which made the shoe a better and stronger and cheaper article than when the ribs were cemented by hand. The Court was of opinion that the new shoe was a double use of the old invention, and virtually decided the point in this case. The differences between the second and the first re-issues are modifications of statement which emphasize the advantages of a rib around the mouth, but do not draw the invention out of the reach of the adverse criticism of Judge Blatchford. The claim limits the invention to one locality, but, in that locality, and with the benefits of the rib to the shoe at that point, patentability was denied in the decision of the present Circuit Judge. Argument against the propriety of holding that the claim of

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the present re-issue was not patentable, by reason of the earlier patent, is argument against the propriety of the decision which was made in the Pritchard case.

The bill is dismissed.

S. D. Law and *Benjamin F. Thurston*, for the plaintiffs.

Frederic H. Betts and *George Harding*, for the defendant.

GEORGE L. CRANDAL

vs.

JOHN WATTERS AND ROBERT LOERCHER. IN EQUITY.

Re-issued letters patent, No. 6,794, granted to Charles H. Davis, March 7th, 1876, for an "improvement in box loops for carriage tops," the original patent, No. 95,004, having been granted to him September 21st, 1869, are valid.

The invention claimed in the re-issue is a box loop made of metal so thin that the loop can be struck up from it in a single piece, and then bent into shape, with lugs projecting from the loop towards the surface to which the loop is to be affixed, so that the loop can be affixed by passing the lugs through the material and clenching them down tight on the other side by bending them at right angles, no rivets or screws being used.

All the said characteristics are found in the original patent, and the case was a proper one for a re-issue.

The claim of the re-issue does not depart from the invention shown in the original.

No article like that of the patent, capable of being taken and used for the purposes for which the patented article can be used, without adaptation and alteration, requiring invention, existed before.

Prior inventions distinguished.

(Before BLATCHFORD, J., Southern District of New York, December 18th, 1881.)

BLATCHFORD, J. This suit is brought on re-issued letters patent, No. 6,974, granted to Charles H. Davis, March 7th, 1876, for an "improvement for box loops for carriage tops," the original patent, No. 95,004, having been granted to him September 21st, 1869. The specification of the re-issue is as follows,

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reading what is outside of brackets and what is inside of brackets, omitting what is in italics: "*Figure 1 is a perspective view of the loop with straps and buckles complete, attached to a piece of leather or section of a carriage top, B. Figure 2 is a perspective view of the loop ready for use. Figure 3 is a plate or cap used on the back or inside of the top B, for securing the loop A. Figure 4 is a cross sectional view of the whole complete. Similar letters of reference indicate corresponding parts.* My invention has for its object [an improvement in] *to improve* the construction of box loops for carriage [tops,] trimmings, [&c.] *and it* [It] consists in forming the loops [in] *from one piece of* metal, either cast or struck up [into form from a single piece of plate or sheet metal,] with a series of [spurs or] lugs [projecting from the] *upon its lower edges or corners next the surface to which they are to be affixed,* which [spurs or lugs] *lugs or spurs* [pass] *are passed* through openings formed in the carriage top [or curtain] and [are clinched down tight upon it, and I introduce] *through openings in* a metal stiffening plate [on the opposite side] *placed upon the under surface of the leather.* [leather, as a stiffening plate, through which the spurs pass before they are clinched, as a further security in the fastening, by which form and construction I securely affix the box loop to the curtain, &c.,] *The lugs are then bent down or clinched upon the metal plate, thereby securely fastening the box loop in place* without the employment of rivets or screws. Box loops, as usually constructed, are made of leather, and either sewed or riveted in [place.] *place, and* [They] are liable to be bent out of shape and torn from [their fastenings;] *the rivets.* [and this] *This method* [mode of construction and application] is [slow and] expensive, requiring the labor of skilled workmen, while, by my improvement, the box [loop can be] *is* easily applied [by any one] and [is] not liable to get out of order. In the accompanying drawings [which form a part of this description, Figure 1 is a perspective view of the loop, either cast or struck up from thin metal, affixed in place with buckles complete. Fig. 2 is a perspective view

of the loop detached. Fig. 3 is the stiffening plate C.] A is a metal loop, either cast or struck up from [thin] *sheet* metal, preferably the *latter*. [latter, which] *When formed of sheet metal the blanks* are cut out by suitable dies, [with] *leaving spurs or lugs*, [lugs or spurs formed at] H H upon [the] two [sides] *opposite edges*. [The loop is then] *They are* bent into *the* form [and stamped or embossed, as in Figs. 1, 2, or otherwise, which completes the manufacture of the loop, which is then ready to be affixed in its place B, Fig. 1. To apply this loop to a carriage top, or elsewhere, the spurs or lugs H H H are thrust through holes or slits made therefor in the leather, and the ends are bent and clinched down upon the other side. Buckles may be affixed to their place on B, as in Fig. 1, in any convenient way, and the loop put over them and affixed to B. As an additional security, plates, C, (see Fig. 3,) are employed on the opposite side of the curtain, to stiffen and support the fastenings or spurs H, which are clinched down on them after passing through openings therein for the purpose.] *shown in Fig. 2, to produce the loop. D is a strap or straps, each end passing around and through the buckle E, and secured, in any proper manner, to the piece B of the carriage top. The piece B is provided with a series of holes upon each side of the strap D, corresponding in number and position to the spurs H upon the loop. The loop is applied to the piece B by passing the spurs through these holes, as shown in the drawing, and through holes X X formed in the metal plate C, laid against the inner surface of the piece B. The lugs are then bent down or clinched upon the surface of this plate, thereby firmly securing the loop in place without the aid of rivets.*" Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, we have the specification of the original patent. The claim of the re-issue is as follows: "The box loop A, formed out of thin plate metal, as described, with the lugs or spurs H projecting therefrom, to affix it to a carriage top, either with or without the plate C, substantially as and for the purposes specified." The claim of the original patent

was this: "The box loop A, when formed as described, with the lugs or spurs H upon its edges, and applied to a carriage top, by passing said lugs through the same, and through the metal plate C, and then bending them down upon the surface of said plate, substantially as described, for the purpose specified."

It is apparent that the article specified in the claim of the re-issue is to be (1) a box loop; (2) made of metal; (3) the metal so thin that the article can, if desired, be struck up from it; (4) the metal of the loop to be a single piece, bent into shape; (5) the lugs to project from the loop towards the surface of the material to which the loop is to be affixed; (6) the loop to be capable of being affixed by passing the lugs through the material and clinching them down tight upon the other side, the clinching being done by bending them at right angles, and no rivets or screws being employed. These characteristics are all found in the specification of the re-issue in connection with its claim. They are all found in the specification of the original patent. The drawings of the two patents are the same. The model filed with the application for the original patent shows all the foregoing characteristics. The claim of the original patent was so framed as to seem to require that the loop should be actually applied to a carriage top, in order to infringe. It also required that the metal plate C should be used in such application. Makers of loops were not makers of carriages, and it was obvious that the invention was really of the loop ready to be affixed, and that the inventor was entitled to have a claim which would reach the maker of the loop. Besides, even if the claim of the original would have extended to the maker of the loop, it might have been questioned whether it would reach him when he made a loop without the plate C; and it was plain that that was only a stiffening or strengthening plate, an adjunct, making the article better, perhaps, but yet not of the essence of the invention. The case was, therefore, one for a re-issue.

It is objected that the specification of the original patent says that the series of lugs is on the lower edges of the loop,

that is, projecting from the lower edges of the long parallel sides of the loop and in the same plane with such sides. The drawings and model show such a construction. The re-issue says that the lugs project from the edges or corners next the surface to which they are to be affixed. The plaintiff's loop has an open bottom, the metal being only on the top and the sides. The defendants make one form of loop with a closed bottom, and with lugs punched out of the bottom at three sides of the lug, and bent down at the fourth side, ready for use, and standing at right angles to the sides of the loop and in the same plane with each other. To maintain non-infringement, and yet enable themselves to appropriate the real invention, they contend that the claim of the re-issue is a departure from the invention shown in the original, (1) in making it necessary only that the lugs should project from the loop, without limiting them to being arranged as in the drawings, on the lower edges of the sides; (2) in making it necessary only that the lugs should be used to affix the loop, without its being necessary to use them by putting them through the carriage top; (3) in making it optional to use the plate C. It is clearly a mere formal alteration, and within the invention, to put on the closed bottom and make the lugs project from it, instead of making them project from the edges of the sides. The closed bottom or fourth side is a useless expenditure of labor and material, so far as the real invention and the employment of it are concerned. The defendants' lugs project in a manner entirely equivalent; and, if the claim of the re-issue had said, as did the claim of the original, that the loop had lugs on its edges, it would have been proper to say that, for all practical purposes, the defendants' lugs were upon the edges, the variation being immaterial. The claim of the re-issue is not capable of the construction that the lugs are to be used without putting them through the carriage top. It was no departure and no new matter to make the use of the plate C optional. To say that the lugs of the patent project from the edges or corners next the surface to which they are to be affixed is just as accurate a

description of them as to say that they are upon the lower edges of the loop. It is from the edges next the surface to which the lugs are to be affixed that the lugs project. There is no statement in the re-issue that the lugs are not to project from the edges, and calling the edges corners does not alter their location. It is plain that the forms of loop shown in "complainant's exhibit 2" and in "complainant's exhibit 3" infringe the claim of the re-issue, and that the re-issue is not open to the objection that it is not warranted by the original patent.

The remaining question is that of novelty. Various old devices are introduced, wherein sheet metal prongs or lugs projecting through a material such as leather or paper, and clinched by bending them, held and secured the metal or other article to which they were attached on the other side of the material. This idea was old, and was embodied and used by Davis. But no article like the plaintiff's, capable of being taken and used for the purposes for which the plaintiff's can be used, without alteration and adaptation, requiring invention, existed before. Almost all inventions, at this day, that become the subjects of patents, are the embodiment and adaptation of mechanical appliances that are old. In that consists the invention. When the thing appears, it is new and useful. No one saw it before, no one produced it before, it supplies a need, it is at once adopted, all in the trade desire to make and use it, yet it is said to have been perfectly obvious, and not to have been patentable. Where an article exists in a given form and applied to a given use, and is taken in substantially the same form and applied to an analogous use, so as to make a case of merely double use, there is no invention. But it is very rarely that a thing of that kind secures a patent.

A patent to Joseph E. Ball, No. 20,246, granted May 18th, 1858, for a mode of attaching the traces of harness for horses to the draught plates or straps, is adduced. Ball's apparatus could never be used as a loop for a carriage top. The metal was not so thin that it could be practically struck up from a

single piece and be bent into shape. The lugs could not be practically clinched by bending them, but were secured as rivets, by a process entirely inapplicable to the use of a loop on a carriage top.

A patent granted to Robert Meyer, No. 61,628, January 20th, 1867, for a buckle fastening, is relied on. That does not show lugs clinched by bending, but shows only pins secured by riveting. For some purposes, in considering questions arising on letters patent, bent lugs and riveted pins may be the equivalents of each other, but in considering the question of the novelty of the plaintiff's loop, riveted pins are not the equivalents of the bent lugs. The Meyer device could not be used in place of the Davis device without adaptation requiring invention.

The defendants also introduce a patent granted to Charles H. Littlefield, No. 67,322, July 30th, 1867, for an improvement in breast-plates for harnesses. It is a piece of metal bent into a loop at one end to hold a buckle, and to allow the tongue of the buckle to pass through a slot made in such bent end, and having wings or projecting pieces turned over so as to overlap a harness strap. This could not be used as a substitute for the plaintiff's loop without invention. It is easy after the desired thing is obtained to see how an old thing could have been adapted or altered.

The Ball, the Meyer, and the Littlefield patents were all of them considered by the Patent Office, in granting the original Davis patent, and the Ball patent was again considered by it in granting the re-issue, as appears by the record.

The defendants also adduce English patent No. 1,204, dated May 13th, 1859, to William S. Thomson, for "improvements in the manufacture of hooped skirts." Their expert, with the Davis device and the Thomson device before him, has cut away parts of the former and claims to have converted it into the latter. It may not be difficult for ingenuity, with both articles in view, and with the problem given to convert the later one into the earlier one, to do so. But, the inventor of the earlier one had only that one and did not produce the

later one. There is nothing in the Thomson device to suggest the Davis box loop. It required adaptation and invention to convert it into the box loop. An exact reproduction, in a model, of figure 8 of the drawings of the Thomson patent shows that there is no identity between it and the Davis' structure.

The French patent to Fransson, No. 25,417, granted November 15th, 1855, for a clinched fastening for gloves, may also be dismissed. It contains several features which are availed of in the Davis loop, yet to pass from it to that required adaptation beyond that existing in a mere double use.

It is not necessary to allude to the numerous other old patents introduced by the defendants. The foregoing remarks apply to all of them, and also to the alleged prior structures respecting which oral testimony is given. Attention is directed by the defendants to an exhibit of theirs marked "Bolt guide and catch," alleged to represent a prior structure. The exhibit is not claimed to be a structure which was actually made before Davis' invention, but only to represent one. It is a bolt guide consisting of a metal plate, with two three-sided metal loops on it, each loop open at its two ends, which open ends are lengthwise of the plate, this plate being intended to be placed on one article, and of another metal plate, with one three-sided metal loop on it, open at its two ends, which open ends are lengthwise of the plate, this plate being intended to be placed on an adjoining article. Each loop has on it, projecting downward from the lower edge of each vertical side of it, a spur or lug, integral with it, and passing through a slit in the metal plate, and bent over and clinched down on the opposite side of the plate. The exhibit in question is introduced by a witness who states that it is "a guide for a sliding bolt and a catch into which the bolt would slide when the article is put in use," and that he has known articles similar to it to have been in public use and on sale in the United States for nine and a half years before January 15th, 1881. This would carry it back to July 15th, 1871. The application for the original Davis patent was filed

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April 22d, 1868. Moreover, the attention of the witness was not directed to the feature of the bending over of the lugs to clinch them, as distinct from riveting them. It does not appear that the metal used prior to Davis' invention in making any such bolt guide and catch was so thin that the article could be or was struck up from a single piece of metal. Another witness states that to his knowledge bolt guides were made on the plan of said exhibit, but larger, nearly twenty years before January, 1881, the loops being fastened to the bottom plate twenty years ago the same as in the exhibit, clinched to the back of the plate. On cross-examination, he says that they were made of heavier metal, some of them. He then testifies: "Cross-Q. 10. Were not the ends of the hasp or staple headed down on the plate by a blow of the hammer, as in riveting, instead of being bent over or clinched, as in defendant's exhibit 'Bolt guide and catch?' A. As a general thing, they were made in that way, riveted with a hammer to form a clinch; they were not riveted to form a head like a boiler rivet, but were bent over like the exhibit." Again, he says that they were mostly made for heavier purposes than the exhibit. The defendants' expert says that the exhibit could be attached to a carriage curtain. The plaintiff, in his testimony as a witness, gives evidence throwing doubt on the view that the lugs in any bolt guide were not headed down by riveting. On the whole evidence it must be held that the prior existence of the bolt guide made of metal so thin that the article could be struck up from a single piece of it, and with lugs clinched by bending and not riveting, is not satisfactorily shown. Besides all this, it is plain that the bolt guide never did and never would suggest Davis' box loop.

There must be a decree for the plaintiff for an account of profits and damages and a perpetual injunction, with costs.

Neri Pine and Charles M. Stone, for the plaintiff.

A. V. Briesen, for the defendants.

ROBERT LOERCHER AND JOHN WATERS

vs.

GEORGE L. CRANDAL. IN EQUITY.

Re-issued letters patent, No. 7,129, granted to Charles Schuessler, May 23d, 1876, for an "improvement in buckle fastenings," the original patent, No. 61,628, having been granted to Robert Meyer, as inventor, January 29th, 1867, are valid, and are infringed by a buckle fastening made in accordance with the description contained in letters patent No. 206,298, granted to George L. Crandal, July 23d, 1878.

The patented device and the infringing device explained.

An agreement by a person not to infringe a patent in the future, in consideration of a release for past infringement, does not authorize a recovery thereafter for such past infringement, in case of future infringement.

(Before BLATCHFORD, J., Northern District of New York, December 13th, 1881.)

BLATCHFORD, J. This suit is brought on re-issued letters patent, No. 7,129, granted to Charles Schuessler, May 23d, 1876, for an "improvement in buckle fastenings," the original patent, No. 61,628, having been granted to Robert Meyer, as inventor, January 29th, 1867, for seventeen years from January 19th, 1867. The specifications of the re-issue and of the original are so variant from each other in language, that it is impossible to follow the one in the other. They are as follows:

RE-ISSUE.

"Figure 1 is a plan view of my improved fastening, showing it applied to the back curtain and back stay of a carriage. Fig. 2 is a longitudinal central section thereof. Fig. 3 is an inverted plan view of the shell or case to

ORIGINAL.

"The nature of my invention consists in the employment of two metallic cases, one of which acts as a covering for the end of the strap which passes into the buckle, and is provided with pins, which pass through the

which the strap is secured. Fig. 4 an inverted plan view of the shell or case to which the buckle is secured. Similar letters of reference indicate corresponding parts in all the figures. This invention consists in the employment, in connection with a strap and buckle, of two hollow cases or shells, to which said strap and buckle are respectively secured. That one of the two cases to which the buckle is secured has a bottom plate, to which the buckle is attached by a joint. In the drawing, the letters A and B represent two pieces of fabric, or pieces of the back stay and back curtain of a carriage, to which my invention is applied. C is the strap, and D the buckle, by which strap and buckle the pieces A and B are to be held together. E is a case or shell, made of sheet metal or other suitable material, in form of an elongated inverted cup, open at one end and at the bottom. This case or shell is provided with downwardly projecting pins, *a*, *b*, which, when they are passed through the fabric or piece A, serve to fasten the case or shell in

leather or straps to which it is fastened, and through two perforated plates, to one of which the buckle is attached by a joint, the other being used as a plate to hold the several parts together, when the ends of the pins are riveted to it; the other case being provided with pins, which pass through the leather and strap to which it is fastened, and through one metallic plate, upon which the ends of the pins are riveted. * * * I construct my buckle fastening of the usual description, such as iron, copper or brass; but sheet-iron or tin-plate, I think, would be the cheapest and best. In said drawings, figure 1 represents a plan view of the fastening, with the strap and buckle in place. It is represented in the position it would occupy if attached to the back curtain and back stay of a carriage. Fig. 2 is a back view of the case that connects the strap and holds it in place. Fig. 3 represents a back view of the case to which the buckle is attached. Fig. 4 is a vertical section through the centre of fig. 1. The same letters in the sev-

place on said fabric. One end of the strap C is inserted in the shell E, and secured thereto by means of the pins *a*, *b*, in the manner clearly shown in the drawing. F is another case or shell, also made of sheet metal or other suitable material, but provided at the bottom with a plate, *d*, which forms part of said case or shell F. At the open end of the case or shell F, the buckle D is attached by a joint to the plate D, as shown. By means of downwardly projecting pins, *e*, *e*, with which the case or shell F is provided, the same is fastened to the fabric or piece B, in line with the case or shell E, as shown, so that the strap C can be readily buckled, and its loose end then confined in the case F, as clearly shown in fig. 2. If desired, the outer end of the case F may also be left open, so that the strap may be passed through, when buckled. The cases or shells E and F may be made of suitable sizes, and stamped in dies of any ornamental shape or form desired, and can be used on all kinds of straps and buckles. In place of the pins hereinabove specified,

eral drawings represent similar parts in each. A and B represent either two straps or a piece of the back stay and back curtain of a carriage. C is the case which fastens and holds the straps E firmly to the piece A by means of the pins F, G, and plate M, as shown in the section fig. 4. D represents the case to which the buckle is attached, and into which the end of the strap E is slipped after being buckled. K is the buckle. H, H, I and J, in fig. 3, are the pins, which fasten it to the piece B by means of plate N, as shown in section in fig. 4, to which the ends of said pins are riveted when it is desired to fasten them in place. R is a plate to which the buckle is jointed. The case C is also riveted in the same way to the plate M, which holds them more firmly in place than by the old and tedious way of sewing; and, at the same time, it is a plain and more pleasing ornament to the carriage. If desired, the end of the case D may be left open, so that the strap may be passed through, when buckled. They may be made of various sizes, from the half inch size up to two

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equivalent fastening means may be provided. I claim as my invention—

1. The case or shell E, made with an open bottom, and provided with the pins *a*, *b*, adapted to pass through the strap and firmly hold it in place, substantially as and for the purpose herein shown and described.

2. The case or shell F, made with the bottom plate *d*, and combined with the buckle D, which is attached to said plate, substantially as specified.

3. The case or shell F, made with the bottom plate *d*, and with the projecting pins *e*, *e*, substantially as herein shown and described.

4. The combination of the case E and strap C with the case F and buckle D, substantially as herein shown and described."

inches, and stamped in dies of any ornamental shape or form desired. They may also be used on straps of any kind as well as for harness or carriage trimmings. I do not claim the case D alone, but what I do claim is—

1. The combination therewith of the pins H, H, I, J, or the equivalent thereof, and the plates R and N, as herein substantially described.

2. The case C, the pins F, G, and plate M, for fastening the end of the strap in place, as described."

The plaintiffs claim that the defendant has infringed claims 2, 3, and 4 of the re-issue. Prior to June 17th, 1878, the defendant made and sold articles like exhibit No. 1. Since that date, he has not made or sold any of them. By and under the agreement of that date he settled and paid for

all those articles. Although, by that agreement, he agreed not to make any buckle loops infringing upon said re-issue, and although that engagement, in conjunction with his contract to pay royalty for the articles before made, formed the consideration for his release from liability for the making and selling of those articles, yet the release was an absolute release *in præsenti*, and, even though he may subsequently have infringed, the release must stand till formally set aside, and operates to exclude from this suit all further accountability for articles like Exhibit No. 1, such release being set up in the answer.

The defendant admits the making and selling, after August 1st, 1878, of articles like Exhibit No. 2. The sale of articles like Exhibit No. 4 is also proved. Neither No. 2 nor No. 4 are covered by the release. The sale of Articles like Exhibit No. 3 since the release is not proved. No. 2 and No. 4 being the only structures involved, the only claims of the re-issue which need be considered are claims 2 and 3.

Claim 2 requires that there shall be a case or shell like the case or shell F; that it shall have a bottom plate like the bottom plate *d*; that such case or shell, having such bottom plate, shall be combined with a buckle like the buckle D; and that such buckle shall be attached to such plate. The projecting pins for attaching the case or shell to a fabric do not appear to be an element in claim 2. The specification describes the case or shell F as hollow, as made of sheet metal or other suitable material, and as provided at the bottom with a plate, *d*, which forms a part of the case or shell. One end of the case or shell is open and the buckle D is attached to the bottom plate at that end by a joint so as to project outwardly. The other end of the case or shell is either open or closed. The case or shell is provided with downwardly projecting pins, which start from the bottom plate and pass through the fabric to which the shell or case is to be attached and serve to attach the shell or case to the fabric. Equivalent fastening means may be used in place of the downwardly

projecting pins. Claim 3 combines the case or shell F, the bottom plate and the pins, omitting the buckle.

No. 2 has a hollow case or shell, like F, made of sheet metal, and provided at the bottom with a plate, which forms a part of the case or shell. One end of the case is open and the other is closed. There is a buckle at the open end, but it is not attached to the bottom plate by a joint. It is attached by a joint to a short piece of flat sheet metal, so as to project outwardly. This short piece, carrying the buckle, is of two thicknesses, the metal being bent to form the joint for the buckle, and is beneath and close up against the lower surface of the bottom plate. In order to secure it to the bottom plate, there is a third flat piece of metal, lying longitudinally underneath, which has at its extreme end farthest from the buckle an integral upwardly projecting pin or fin which enters a hole in the bottom plate, and is intended to be bent over and down and clinched inside the shell against the upper surface of the bottom plate. The other end of such third longitudinal piece has at its extreme end nearest the buckle two integral upwardly projecting pins or fins, lying in line side by side one each side of the centre of its width and extending each from near such centre to the outer edge, each of which enters and passes through a separate hole for it through each of the two thicknesses of the short piece which carries the buckle, (the two holes for each pin or fin being coincident,) and then enters a separate hole for it in the bottom plate, and is intended to be bent over and down and clinched inside the shell against the upper surface of the bottom plate. Thus, when the pins or fins are in place and clinched the buckle is held firmly and the structure becomes a unit.

No. 4 has a hollow case or shell, made of sheet metal and provided at the bottom with a plate, which forms a part of the case or shell. Both ends of the case are open. There is a buckle at each end, not attached to the bottom plate by a joint. A buckle is attached by a joint to each end of a separate longitudinal plate, which is longer than the bottom plate. Each buckle projects outwardly. Such separate plate

is for a distance at each end of it of two thicknesses, the metal being bent to form the joint for the buckle, and is beneath and close up against the lower surface of the bottom plate. In order to secure it to the bottom plate, there is a third flat piece of metal, lying longitudinally underneath, and somewhat shorter in length than either such separate plate or the bottom plate, which has at each extreme end of it two integral upwardly projecting pins or fins, lying in line side by side one on each side of the centre of its width, and extending each to the outer edge, each of which enters and passes through a separate hole for it through each of the two thicknesses of such separate plate which carries the two buckles, (the two holes for each pin or fin being coincident,) and then enters a separate hole for it in the bottom plate and is intended to be bent over and down and clinched inside the shell against the upper surface of the bottom plate, there thus being four of such pins or fins. So, when the pins or fins are in place and clinched the buckles are held firmly and the structure becomes a unit.

It is manifest that there is involved in claims 2 and 3 of the re-issued patent, the idea of a hollow case, with a top, two longitudinal side plates and a bottom plate, all forming a unit and a case, the case having such bottom plate being, in claim 2, combined with a buckle attached to the bottom plate, and having, in claim 3, the downwardly projecting pins. The buckle is secured to the case, and it is so secured by being attached to the bottom plate. The strength of the structure, as a whole, composed of top, sides and bottom plate united in one, is availed of to hold firmly the buckle, through the attachment of the buckle to the bottom plate. The combination, in claim 2, of the case of which the bottom plate forms a part with the buckle, is effected by attaching or jointing the buckle directly to the end of the bottom plate. A pull on the buckle cannot result in displacing anything, if the buckle does not break, without displacing the structure as a whole. In claim 3, the case of which the bottom plate forms a part has the downwardly projecting pins,

and, when, by means of them, the structure is fastened to a fabric, no pull on the pins against the structure can displace any part of it without displacing the whole of it. In both claims, the fact that the bottom plate forms an integral part of the case is a leading feature.

In the light of the foregoing suggestions, an examination of No. 2 and No. 4 shows a hollow case, with a top, two longitudinal side plates and a bottom plate, all forming a unit and a case. The case having such bottom plate is combined with a buckle. The buckle has, for all practical purposes, the same relation to the bottom plate as if it were attached to it. The combination of the case with the buckle is effected by means of the plate carrying the buckle end of the lower flat piece of metal, and the pins or fins on the latter. The plate which carries the buckle, being an additional separate plate, must be fastened in some way to the bottom plate of the case. The severance makes the reunion necessary, and promotes no useful result. It is a mere mechanical change, within the scope of the principle of the Meyer structure. When the parts are put together, and the pins or fins are clinched, the case or shell made with the bottom plate is combined with the buckle, and the buckle is as much attached to the plate, for all the practical purposes of the structure, as is the buckle in the Meyer structure. The strength of the case, as a whole, composed of top, sides and bottom plate united in one, is availed of to hold firmly the buckle, through such combination of the case with the buckle. A pull on the buckle cannot resist in displacing anything, if the buckle does not break, without displacing the structure as a whole. When the pins or fins are clinched, the case of which the bottom plate forms a part is provided with downwardly projecting pins, which start from the bottom plate, and, after passing through the buckle plate, pass through the fabric to which the shell or case is to be attached, and serve to attach the shell or case to the fabric. The fact that the pins are integral with a longitudinal piece of metal on the other side of the fabric, makes no difference. They are the projecting

pins of Meyer, in that, when clinched, they project from the bottom plate towards and through the fabric, and fasten the combined case and buckle to the fabric. When the structure is fastened to a fabric no pull on the pins against the structure can displace any part of it without displacing the whole of it. The same results follow as in the Meyer structure, from the fact that the bottom plate forms an integral part of the case.

The defendant has a patent, granted to him July 23d, 1878, No. 206,298, under which he claims the right to make No. 2 and No. 4. They are described in that patent. That patent claims (1) the third flat piece of metal, with its integral pins or fins, in combination with the separate buckle plate having holes in it corresponding with the pins or fins, for the purposes of securing the buckle in proper relation to the case; (2) the combination with the third flat piece of metal, having its integral pins or fins, of the separate buckle plate and the case with its bottom plate, both of the latter having holes in them coincident with said pins or fins, when secured to a curtain by means of such interior clinching of the pins or fins. It may be that these claims may be sustainable for their specialties, notwithstanding prior structures. But still No. 2 and No. 4 embrace points of construction which are the equivalents of the points of construction claimed in claims 2 and 3 of re-issue No. 7,129. Beyond that, what is patented by No. 206,298, is only an improvement, still involving the principle of what is claimed in said claims 2 and 3. On the question of infringement, features of construction may well be and are often equivalents of prior patented features, because involving their construction and mode of operation, though going further and containing their own patentable features, and for that very reason, when the question of the novelty and patentability of such further features comes up, the prior existence of such prior patented features does not make them the equivalents of the further features so subsequently patented, in such sense as to anticipate the latter. An illustration of this is found in the case

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of *Crandal v. Watters*, (*ante*, p. 97,) a suit brought on the Davis patent, decided herewith.

The validity of the re-issued patent is attacked. The drawings of the original and the re-issue are structurally the same, although the lettering is changed and figures 2, 3 and 4 are differently numbered in the two. Criticism is made on the facts that the original speaks of "metallic" cases, and the re-issue of "hollow" cases; that the original speaks only of metallic materials while the re-issue speaks of "sheet metal or other suitable material;" that, in the original, the pins are said to be riveted to the lower plate N, after they have passed through the curtain and through the plate N, so as to fasten the buckle plate R to the curtain, and claim one of the original is for the combination of the case and the pins, or their equivalent, and the plates R and N, while in the re-issue the plate N is not lettered in the drawings and is not mentioned in the text or in the claims, and the statement in the re-issue is, that the case is provided with downwardly projecting pins, which, when they are passed through the fabric, serve to fasten the case in place on the fabric. Assuming that Meyer was the first to make a case with a bottom plate forming part of it, combined with a buckle attached and jointed to said plate, and furnished with pins capable of attaching the structure as a whole to a curtain, it is immaterial whether the plate N is used or not, or whether the pins are clinched on that plate or on the curtain, or whether the pins are of such large dimensions that they have to be clinched by hammering their ends, or of such small dimensions that they can be clinched by bending them over even with the fingers, so long as the pins project downward from the bottom plate of the case and go through the fabric and are clinched on the other side of it. This re-issue No. 7,129, was before Judge Wallace, in this Court, in the case of *Schuessler v. Davis*, (13 *Off. Gaz.*, 1,011.) He there says: "The description, as well as the drawings and model accompanying the original patent, clearly point out the invention claimed in the re-issue. The improvement consists in a compact device embodying a loop,

bottom plate and buckle, to be attached to a strap by rivets or an equivalent fastening. In my view, the valuable feature of the improvement does not consist in the method by which the case is fastened to the strap, but in the case itself, as forming a loop and buckle combined, and its adaptability to being fastened by various methods to the strap. In the original patent, the claim did not cover the combination of the buckle with the case, or, speaking more accurately, with the bottom plate of the shell of the case, but was limited to a combination of the pins or rivets with the case. It was the object and the proper office of the re-issue to correct this omission, so as to protect the patentee to the full extent of his invention." The defendant's structure in that case was not the same as the defendant's structure in this case, but consisted of a metallic case with fins or lugs integral with it, and projecting down from it, and of a plate underneath, with a buckle jointed to each end of it and projecting beyond the end of the case, the fins passing through slits in the plate and then through the curtain, and being clinched by bending them over on the other face of the curtain. Such a structure was held to infringe claim two of the re-issue. I do not think the re-issue is open to objection so far as any question affecting the defendant's structures No. 2 and No. 4 is concerned.

On the question of novelty, several prior patents are set up in the answer. Only one of them is introduced, No. 49,309, to Cyrus W. Saladee, August 8th, 1865. In that there are two modifications. In one the buckle is not connected to the plate. In the other the connection between the buckle and the plate is rigid and without a joint. In the Meyer structure the buckle is attached to the plate by a joint.

Five other prior patents were introduced by the defendant. None of them are set up in the answer. They are as follows: No. 26,013, to Lucius C. Chase, November 8th, 1859; No. 39,217, to Frank Douglas, July 14th, 1863; No. 44,554, to George Purple, October 4th, 1864; No. 47,574, to

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Cyrus W. Saladee, May 2d, 1865; and No. 47,765, to Ebenezer Brown, May 16th, 1865. In Chase, the buckle frame is rigidly secured, and not jointed. In Douglas, the buckle frame is not connected with the loop by the bottom plate. In Purple, the buckle frame, carrying the tongue, is not jointed, but the tongue has a rigid fastening. In Saladee of May, 1865, the Meyer structure is not found, nor is it found in Brown. Besides the features above mentioned as to Chase, Douglas and Purple, the structures in them would not suggest the structure of Meyer.

As to the parol testimony, in regard to prior structures, by Moore, and Davis, and the defendant, it must be held that, in view of the construction given to claims 2 and 3 of re-issue No. 7,129, and of what the invention of Meyer has been defined to be, nothing is shown making out a satisfactory anticipation of said claims.

I think the suit is properly maintainable in the names of the plaintiffs, as surviving members of the firm composed of themselves and Schuessler, and that a decree should be entered for the plaintiffs as to claims 2 and 3, for an account and a perpetual injunction, with costs.

A. V. Briesen, for the plaintiffs.

Neri Pine and *C. M. Stone*, for the defendant.

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JOHN WATTERS AND ROBERT LOERCHER, SURVIVORS OF THEMSELVES AND CHARLES SCHUESSLER, AS COPARTNERS UNDER THE NAME OF THE METAL STAMPING COMPANY

vs.

GEORGE L. CRANDAL. IN EQUITY.

Re-issued letters patent, No. 8,829, granted to Robert Loercher, July 29th, 1879, for an "improvement in harness buckles," the original patent, No. 47,574, having been granted to Cyrus W. Saladee, as inventor, May 2d, 1865, are not infringed by a buckle constructed in accordance with the description contained in letters patent No. 296,298, granted to George L. Crandal, July 23d, 1878.

Claim 4 of the said re-issue must be so limited, in view of the patent granted to Frank Douglas, July 14th, 1868, that the defendant's buckle does not fall within it.

(Before BLATCHFORD, J., Northern District of New York, December 18th, 1881.)

BLATCHFORD, J. This suit is brought on re-issued letters patent No. 8,829, granted to Robert Loercher, July 29th, 1879, for an "improvement in harness buckles," the original patent, No. 47,574, having been granted to Cyrus W. Saladee, as inventor, May 2d, 1865. The specification of the re-issue, including what is inside of brackets and what is outside of brackets, omitting what is in italics, is as follows: "Figure 1 is a plan [view, and] *view*. Figure 2 is a section, [of my improved buckle for harness, &c.] *the red lines showing the strap to which the buckle is secured. I call my improved buckle a 'snap-buckle,' for it is self-acting, and lacks the ordinary 'long-tongue,'* My invention is more particularly applicable to the plate and rivet buckle described in my application 'A,' and consists in pivoting the buckle [to the projecting end of a metallic plate carrying a loop, in combination with fastening pins; also, in a peculiar construction of buckle, as hereinafter more fully described.] *in a groove in*

the tongue, (or part that resembles the common tongue,) so that a spring shall make the front end of the tongue snap under the front bar of the buckle, which is provided with a short stud which passes through the strap to be held, and takes in a corresponding hole in the tongue. In the drawings, A is the metallic buckle plate, provided with rivets, *a*, by which it is secured to the upper surface of the strap. B is the metallic loop for confining the loose end of the [other strap,] *strap*. [which loop is rigid on the plate A.] *The plate A, rivets a and loop B are similar to the plate, rivets and loop described in my application 'A.'* *E is the tongue and is the* [The] front end *or continuation* of [the] plate A. [A] *It is provided with a grooved recess e in its under side about one inch from the end, and in which the back bar of the buckle is pivoted.* G is the buckle, its back bar, *o*, being provided with a short lever, *x*, and turning in the groove, *e*. The under side of the front bar of the buckle is provided with a short stud, *i*, which takes into a corresponding indentation, *v*, in the upper side of the [plate A,] *tongue E*. I is a flat steel spring, the front end of which is secured by a rivet to the front end of [plate A,] *tongue E*, the rear end of said spring pressing [against the] *down up* lever *x* of the back bar of the buckle, so as to keep it in the groove *e*, and at the same time force the front ends of the [plate A, which is] *tongue* [shaped,] and [the] buckle together, so as to make the stud *i* take into the hole *v*. If preferred, the stud *i* may be put upon the tongue [or plate A] instead of upon the buckle, and may take into a corresponding hole in the front bar of the buckle. In using my improved [buckle,] '*snap-buckle*,' the strap to be held is placed between the front bar of the buckle and the tongue, and drawn as tightly as desired, the spring forcing the front bar down upon the strap, so that the stud shall take into each hole of the strap as it arrives. The front side of stud *i* should be rounded off somewhat, so as to allow the strap to slip over it when being tightened. There is a peculiar advantage possessed by this buckle. It is not necessary to slacken the strap in order to unbuckle it, as is the case

with other buckles. I have only to lift up the front bar of the buckle about an eighth of an inch, in order to lift the stud *i* out of the hole in the strap, which thus frees the strap. The importance of this advantage is self evident." Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, gives the specification of the original patent. The claims of the re-issue are as follows: "1. The buckle G, in combination with the plate A, having the tongue-extension, all substantially as shown and described. 2. The buckle frame pivoted to the tongue-extension portion of plate A, all substantially as set forth. 3. The buckle frame G, provided with stud *i*, in combination with the buckle tongue A, having an indentation for the reception of said stud, substantially as specified. 4. The plate A, provided with the loop and with fastening pins, in combination with the buckle frame, which is pivoted to said plate, substantially as set forth." The claims of the original patent were these: "1. Constructing a buckle so as to be unbuckled without slackening the strap, in the manner described. 2. The buckle G, in combination with the tongue E. 3. Pivoting the buckle to the tongue in the manner described. 4. Forming the tongue E, as a continuation of plate A, in the manner described. 5. The stud *i*, or its equivalent, operating as described, in combination with the indentation *v*."

Only claim 4 of the re-issue is alleged to have been infringed. The infringing structures are complainants' Exhibit No. 3 and defendant's Exhibit No. 4. The former is constructed in accordance with the description contained in letters patent No. 206,298, granted to the defendant, July 23d, 1878. It has a hollow case or shell, made of sheet metal, and provided at the bottom with a plate, which forms a part of the case or shell. Both ends of the case are open. There is a buckle at each end attached by a joint to a short piece of flat sheet metal, so as to project outwardly. Each of these two short pieces is of two thicknesses, the metal being bent to form the joint for the buckle, and is beneath and close up

against the lower surface of the bottom plate. In order to secure each short piece to the bottom plate there is a fourth flat piece of metal, lying longitudinally underneath, and somewhat shorter in length than the bottom plate, which has at each extreme length of it two integral upwardly projecting pins or fins lying in line, side by side, one on each side of the centre of its width, and extending each to the outer edge, each of which enters and passes through a separate hole for it through each of the two thicknesses of the short piece which carries the buckle (the two holes for each pin or fin being coincident,) and then enters a separate hole for it in the bottom plate, and is intended to be bent over and down, and clinched inside the shell against the upper surface of the bottom plate, there thus being four of such pins or fins, two for each short buckle piece. There is in the bottom plate, for each pin or fin, another hole, so placed that when the pin or fin is bent over, its end may go through such hole and so leave a smoother clinch inside the shell. When the pins or fins are in place and clinched, the buckles are held firmly and the structure becomes a unit. Defendant's Exhibit No. 4 differs from complainants' Exhibit No. 3 only in two respects. There is in it, instead of the two buckle plates, a continuous plate of a single thickness, carrying a buckle at each end of it, the metal at each end being bent into two thicknesses, and there are no extra holes in the bottom plate to receive the ends of the pins or fins after they are clinched. In all other respects the two structures are alike.

The structure of the Saladee device is such that the pivoting of the buckle in the groove is effected by pivoting in the groove the back bar of the buckle, the back bar having on it a short lever, and the rear end of the spring pressing against the lever so as to keep the back bar snugly in the groove, and prevents its escaping therefrom while it turns in it. This method of pivoting the buckle to the tongue is made a peculiar feature in the original patent, and is specially covered by the 3d claim of that patent. But for the action of the spring on the lever of the back bar of the buckle,

there would be no pivoting of the back bar in the groove and no pivoting of the buckle to the tongue. Take away the spring and the whole structure would be inoperative, for, not only would such pivoting disappear, but the stud would not take into its hole. Nothing different results from the language of the re-issue. The structure is not and cannot be altered. The meaning of the language of claim 4 of the re-issue, in saying that the combination is "with the buckle frame, which is pivoted to said plate, substantially as set forth," is, that the buckle frame is pivoted to the plate by means of the spring, or what is, in law and in fact, a mechanical equivalent for the spring. In view of the patent granted to Frank Douglas, July 14th, 1863, the pivoting of the buckle in the defendant's structures cannot be regarded as being effected by the same means or equivalent means as in the Saladee structure. In Douglas, there are a plate, a loop on the plate, fastening pins on the plate, and a buckle frame which is pivoted to the plate. In combination, all the features are found in Douglas which are found in Saladee. Not that the Douglas structure anticipates claim 4 of the Saladee re-issue, properly construed. But it limits its construction, so that the defendant's structures do not fall within it. The pivoting in the Douglas structure is effected by having the leather strap confine the bar in the groove. It is true that it requires the metal and the leather combined together to make the pivoting in Douglas, and that, in the Saladee structure and the defendant's structures, there is pivoting by the metal alone without the leather, but this is of no importance in principle. No one of the three structures is of any use except as applied to articles of leather. Moreover, the Saladee structure is a buckle for harness solely, and it cannot be converted into the defendant's structures without destroying its peculiar arrangement of pivoting.

The bill must be dismissed, with costs.

A. V. Briesen, for the plaintiffs.

G. W. Hey and *C. H. Duell*, for the defendant.

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GEORGE H. HOLMES AND FRANK L. HUNGERFORD

vs.

THE PLAINVILLE MANUFACTURING COMPANY. IN EQUITY.

THE SAME

vs.

THE DUNHAM HOSIERY COMPANY. IN EQUITY.

Re-issued letters patent granted to George H. Holmes, June 25th, 1878, for an improvement in take-ups for looms, the original patent having been granted August 10th, 1869, are not infringed by the use in knitting machines of the take-up rollers described in letters patent granted to Ira Tompkins and Albert Tompkins, May 16th, 1876.

The original patent did not indicate or suggest that the invention could be arranged so as to be an adjunct to a knitting machine. The inventors of the Tompkins device altered the Holmes device and adapted it to a knitting machine. Then the Holmes patent was re-issued so as to cover machines for knitting as well as machines for weaving. Therefore, the re-issue is bad, unless the loom of the re-issue is construed to be the loom of the original patent.

(Before SHIPMAN, J., Connecticut, December 16th, 1881.)

SHIPMAN, J. These two cases are each founded upon re-issued letters patent to George H. Holmes, dated June 25th, 1878, for an improvement in "take-ups" for looms. The original patent was granted August 10th, 1869. The plaintiffs are the owners of the patent. The defences are the invalidity of the re-issue because it contains "new matter," and non-infringement, if the patent is construed by the Court to be restricted to the invention as originally claimed.

The original patent was for an improved "take-up" in looms for weaving cloth. A "take-up" is a device for taking up or rolling the completed fabric upon an intermittingly

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moving roller or cloth beam. The improvement consisted in the arrangement of mechanism for regulating the tension of the cloth. The patented mechanism is described as follows: A ratchet wheel is so connected with the cloth beam that a movement of the wheel necessitates a revolution of the beam. This revolution imparts tension to the fabric. Mounted on the axis of this wheel, there is an oscillating pawl carrier upon which is pivoted a pawl which engages with the teeth of the ratchet wheel. Motion is imparted to the pawl and its carrier by means of a rod, one end of which is secured to the pawl carrier; the other end rests loosely in a sliding collar. Motion is imparted to the collar by the crank which turns the "lay," or "the wooden frame beam which forces up the weft." The intermediate mechanism between the crank and the collar is the leg of the lay and a pitman. "Upon the rod and surrounding it there is a spiral spring, one end of which bears against the reciprocating sliding collar and the other end of which bears against an adjustable collar on the rod, which collar is termed a 'stop nut,' in the patent. This collar or stop nut can be adjusted longitudinally on the rod, so as to compress the spring more or less and increase or diminish its tension, as may be desired." The operation of the mechanism is thus described in the specification of the re-issue: "It is obvious, that, when a reciprocating motion is given to the sliding collar *m*, the degree of compression of the spring, and the consequent extent of motion of the pawl and the ratchet wheel, will depend upon the resistance or tension of the fabric. Thus, if the cloth is slack, the spring will be but slightly (if at all) affected by the movement of the sliding collar *m*, the strength of the spring being sufficient to move the pawl and revolve the ratchet wheel and take up the fabric, in which case the collar *m* will move with the rod *L*, and not slide on it; but, when there is sufficient tension on the cloth to overcome the power of the spring, the collar will slide on the rod and expend its blow or pressure in compressing the spring, and will not throw the pawl or move the ratchet." In the language of the plaintiffs' expert, "the

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collar reciprocates positively over a given distance, while the movement of the rod, the pawl carrier, the ratchet wheel, and the cloth beam, will vary from time to time, according to the tension of the fabric and the resistance which is offered thereby to the motion of the beam which takes up the fabric." The original claim was in these words: "The slotted lever J, pawl *k*, ratchet wheel I, gear wheel G, the rod L, spring O, nut *p*, and arm *m*, the 'lay' B, and cloth beam F, of the loom, when arranged, with reference to each other, substantially as herein shown and described, for the purpose specified."

On May 16th, 1876, letters patent were granted to Ira Tompkins and Albert Tompkins, for improved take-up rollers for knitting machines, and thereafter the plaintiffs' re-issue was granted. The re-issue was designed to extend the patent to machines for knitting as well as for weaving. The claims are as follows: "1. In a take-up device for looms, the combination of the ratchet wheel I, through which motion is imparted to the beam which takes up the fabric, the oscillating pawl-carrier J, provided with the pawl *k*, the rod L, spring O, stop-nut *p*, and reciprocating sliding collar *m*, and operating mechanism, whereby the positive reciprocating motion imparted to the sliding collar is made to turn the ratchet wheel a greater or less distance, according to the tension of the fabric, substantially as described. 2. In a take-up device for looms, the combination of the stop-nut *p*, the rod L, spring O, sliding collar *m*, the crank M, and suitable intermediate mechanism, substantially as described, whereby the rotary motion of the crank is transformed into the compensatory reciprocating motion of the rod L, for the purpose set forth."

A knitting machine has nothing in common with a loom for weaving, except that each has a roller upon which the completed fabric is rolled, and a take-up. The office of the take-up, in each machine, is to regulate the tension of the cloth. In a loom, it is necessary that the warp should be kept taut between the yarn beam and the cloth beam. A knitting

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machine produces a fabric made by a succession of loops, and, as the necessities of the manufacture do not require that the yarn or threads should be kept tightly drawn, a smaller expenditure of force is necessary than in a loom take-up. The defendants' machines are rotary, the take-up rollers and the frame which holds the take-up revolve with the machines, and power is communicated to the crank gearing, which actuates the take-up mechanism, by the revolution of the frame upon its spindle. The take-up mechanism proper of the Holmes and the Tompkins devices are the same; the differences are in the mechanism by which power is communicated. The crank of the Tompkins device "directly actuates the take-up machinery, instead of actuating the lay of the loom to move the take-up mechanism."

The plaintiffs' case is founded upon the position that the Holmes invention was not a take-up for weaving looms only, but was a take-up device for any looms which require a take-up, and that the original patent, by the introduction of the "lay" of a loom, as one element of the combination, unduly limited the invention. The plaintiffs also insist, that, while the word "loom," as defined in the dictionaries, or when used technically, does not include a knitting machine, yet, as used in the shops and in the Patent Office, it does include such machine, but that this is immaterial, for, whoever uses the loom take-up, and employs the same combination, in a knitting machine, to take up the fabric, is an infringer, and that the crank rod of the defendants' device, by which power is communicated to the pawl lever, is the obvious mechanical equivalent of the lay and pitman of the Holmes device.

In my opinion, the case turns upon the question—what was the invention which was disclosed, either clearly or faintly, in the original patent? It is true, that the actual invention of Holmes could have been applied to knitting machines, and, if the patentee had known the extent of his invention, he could properly have made a broader claim, which would have been valid; but the point is, whether it does not appear from the patent, that the invention which was the subject of the ap-

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plication was one applicable only to the weaving of cloth, and, therefore, whether a broad re-issue is not faulty, in that it contains an invention which was neither suggested nor applied for in the original application, but which is such an addition to the invention, as originally claimed, as to be properly the subject of a new patent. Starting with the fact that whatever may be either the commercial or technical meaning of the word "loom," the meaning of "loom for weaving cloth" is very obvious, and with the additional fact that a knitting machine is a structure of altogether different character from a weaving loom, except that each machine produces cloth and needs a take-up, did the original patent indicate, suggest, or hint that the invention was anything but an adjunct to looms for weaving? The original application was strictly confined to such machines, and for a manifest reason. In cloth weaving, whenever a thread of filling is passed through the threads of warp, the lay is thrown forward and beats the thread of filling against the edge of the newly woven cloth. The old take-ups made are of the constantly recurring forward motion of the lay to turn the cloth beam and to keep the yarn taut, for, in a loom take-up, the movement of the lay is the natural source of motion for the take-up mechanism. The inventor wanted to improve the existing devices so that a better device, or an improved result, could be had by the use of the same motive power. He was directing his attention solely to take-ups in looms, and not to take-ups in other and different pieces of mechanism, and his patent expressed plainly the subject of his thought and the result of his labor. That the invention could be applied to other machines was a discovery made after the date of the patent.

The original patent was open to objection, because it might be claimed that the patentee had included, in the combination, the "lay" as a lay, and not as a means of transmitting power, and, therefore, if the crank should be applied to any other lever than the woof-beater, there would not be an infringement. This mistake was apparent on the face of

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the specification, and justifies a re-issue, but that the invention was improperly restricted, by limiting it to looms for weaving, was not thus apparent. Neither the specification taken alone, nor as construed by the state of the art in regard to the subject of the original patent, revealed that the invention was broader than the patent. That came to light after the state of the art on both looms and knitting machines had been shown. I am of opinion that the loom of the re-issue is the loom for weaving cloth of the original patent.

The inventors of the device which is used by the defendants apparently adapted the Holmes take-up to the needs of a knitting machine, but not without alteration. They did not simply apply the old method to the new one without change. The new machine has no lay, and does not require the intervention of a lever between the crank and the pawl carrier. A loom take-up must work with power to keep the fabric taut. A knitting machine desires that the fabric shall not be strained by over tension, and, therefore, demands only the exercise of gentle force in the take-up mechanism. All that is required is that motion should be communicated from the crank directly to the pawl carrier. In view of the different character and needs of the two machines, motion is not transmitted, in these two devices, by the same or equivalent means.

The bill is dismissed.

Charles E. Mitchell, for the plaintiffs.

Esek Cowen, for the defendants.

The United States v. Phelps.

THE UNITED STATES, PLAINTIFFS IN ERROR

vs.

FRANK PHELPS AND HOWARD PHELPS, DEFENDANTS IN ERROR.

Under §§ 2,927 and 2,928 of the Revised Statutes, there can be an appraisement for an abatement of duties, on account of damage to goods sustained during the voyage of importation, after the goods have been entered at the Custom House and the estimated amount of duties thereon have been paid.*

(Before BLATCHFORD, J., Southern District of New York, November 18th, 1879.)

BLATCHFORD, J. This is a writ of error to the District Court. The following facts appear by the bill of exceptions: The defendants in error, (who were the defendants below and will be called the defendants,) on the 7th of August, 1876, imported into the port of New York from a foreign port, 3,825 boxes of lemons. The value of said lemons in the foreign market, when and where they were purchased, was 74,521, $\frac{1}{16}$ francs, equal to \$14,383. The duties thereupon, at the rate of 20 *per centum ad valorem*, amounted to \$2,876 60, on which sum the plaintiff gave a credit of \$2,013 60, the amount admitted by the complaint to have been paid, claiming to recover the balance, \$863, as duties. The defendants, in like manner, imported, on the 15th of August, 1876, 2,930 boxes of lemons, of the foreign value, when shipped, of 49,861 $\frac{1}{16}$ francs, equal to \$9,623. The duties thereon, at the rate of 20 *per centum ad valorem*, were \$1,924 60, on which sum the plaintiffs gave a credit of \$1,636, the amount admitted by the complaint to have been paid, claiming to recover the balance, \$288 60, as duties. After

* This case was not reported in its regular order, but, as the decision was affirmed by the Supreme Court, and the opinion of that Court, in 107 U. S., refers to the opinion of this Court, it has been thought proper to publish the latter in this volume.

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the plaintiffs had proved the foregoing facts, the defendants offered to prove that they made entry at the custom house in New York of the first above mentioned importation of lemons at the full invoice price on the 7th of August, 1876, and then paid to the plaintiffs \$2,876 60, as the estimated amount of duty on said importation, if in sound condition, and afterwards, and on the 14th of August, 1876, applied for an allowance for damage to the same on the voyage of importation; that, thereafter, an examination and appraisement of the damage were made, and thereupon an allowance was made for said damage; that the amount of said damage allowance was \$4,315; that the duties thereon, at 20 *per cent.*, amounted to \$863; that, in accordance therewith, the said entry was liquidated on the 3d of October, 1876; and that, on the 14th of October, 1876, the plaintiffs refunded and paid to the defendants the sum of \$863. To this evidence the counsel for the plaintiffs objected, on the ground that the damage allowance should have been applied for, and the damage ascertained, before the entry of the goods; that, as the application was not made, nor the amount of damage ascertained, until after the entry, the proceedings therefor were irregular and without warrant of law; and that the defendants could acquire no benefit or advantage from any allowance made in pursuance thereof. The Court overruled the objection and admitted the evidence, and to such ruling and admission, the plaintiffs' counsel excepted.

As to the importation of August 15th, 1876, the defendants offered to prove that an entry was made of the goods at their full invoice price on that day, and the sum of \$1,924 60 was paid to the plaintiffs as the estimated amount of duty on said importation, if in sound condition; that an application for damage allowance was made August 22d, 1876; that an examination and appraisement were thereupon made, and an allowance for damage was thereupon made to the amount of \$1,443, on which the duties amounted to \$288 60; that the entry was liquidated on the 29th of September, 1876; and that, on the 11th of October, 1876, the plaintiffs refunded and

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paid to the defendants the said sum of \$288 60. To this evidence the counsel for the plaintiffs objected on the same ground as before. The Court overruled the objection and admitted the evidence, and to such ruling and admission the plaintiffs' counsel excepted.

The defendants then rested. The counsel for the plaintiffs thereupon requested the Court to charge the jury, that, as the goods had been entered at the full invoice prices in the first instance, and the application for allowance, the examination and the appraisement were not made, nor the damage ascertained, nor the damage allowance made, until after the entries of the goods, the damage allowance was unwarranted by law, and the jury could not give the defendants any abatement of duties on account of such damage allowance. The Court refused so to charge and the counsel for the plaintiffs excepted to such refusal. The jury rendered a verdict for the defendants.

It is presented as a question for decision, whether there can be an appraisement for an abatement of duties, on account of damage to goods sustained during the voyage of importation, after the goods have been entered at the custom house and the estimated amount of duties thereon has been paid.

Section 2,927 of the Revised Statutes provides as follows: "In respect to articles that have been damaged during the voyage, whether subject to a duty *ad valorem*, or chargeable with a specific duty, either by number, weight or measure, the appraisers shall ascertain and certify to what rate or percentage the merchandise is damaged, and the rate of percentage of damage so ascertained and certified shall be deducted from the original amount subject to a duty *ad valorem*, or from the actual or original number, weight or measure on which specific duties would have been computed. No allowance, however, for the damage on any merchandise that has been entered, and on which the duties have been paid or secured to be paid, and for which a permit has been granted to the owner or consignee thereof, and which may, on examining the same, prove to be damaged, shall be made, unless

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proof to ascertain said damage shall be lodged in the custom house of the port where such merchandise has been landed, within ten days after the landing of such merchandise." This is a re-enactment of like provisions in § 52 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 666.)

Section 2,928 of the Revised Statutes provides as follows: "Before any merchandise which shall be taken from any wreck shall be admitted to an entry, the same shall be appraised; and the same proceedings shall be ordered and executed in all cases where a reduction of duties shall be claimed on account of damage which any merchandise shall have sustained in the course of the voyage; and in all cases where the owner, importer, consignee or agent shall be dissatisfied with such appraisement, he shall be entitled to the privileges of appeal, as provided for in this Title." This section is taken from section 21 of the Act of March 1st, 1823, (3 *U. S. Stat. at Large*, 736,) which section 21 was in these words: "Before any goods, wares, or merchandise which may be taken from any wreck shall be admitted to an entry, the same shall be appraised in the manner prescribed in the sixteenth section of this Act, and the same proceedings shall be ordered and executed in all cases where a reduction of duties shall be claimed on account of damage which any goods, wares, or merchandise shall have sustained in the course of the voyage; and in all cases where the owner, importer, consignee or agent shall be dissatisfied with such appraisement, he shall be entitled to the privileges provided in the eighteenth section of this Act." The words "in the manner prescribed in the sixteenth section of this Act," found in said section 21, are not reproduced in section 2,928 of the Revised Statutes. The manner prescribed in the sixteenth section of the Act of March 1st, 1823, (3 *U. S. Stat. at Large*, 735,) is by appraisers to be appointed in a manner designated in that section. By the 52d section of the Act of 1799, it was provided that, in the case of goods which had received damage during the voyage, the appraisement to ascertain such damage should be made by two merchant appraisers, one to be appointed by the collector,

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and the other by the importer. By the 15th section of the Act of April 20th, 1818, (3 *U. S. Stat. at Large*, 437,) it was provided as follows: "Before any goods, wares or merchandise which may be taken from any wreck shall be admitted to entry, the same shall be appraised in the manner prescribed by the ninth section of this Act; and the same proceedings shall also be had where a reduction of duties shall be claimed on account of damage which any goods, wares or merchandise imported into the United States shall have sustained in the course of the voyage." The 9th section of that Act provided for the appointment by the President and Senate, in each one of six designated ports, of two appraisers, who, with a merchant appraiser, to be chosen by the importer, were to make appraisements in such six ports, and in other ports appraisements were to be made by two merchant appraisers to be selected by the collector, and one merchant appraiser to be chosen by the importer. This act of 1818 was to continue in force for two years. By the Act of April 18th, 1820, it was continued in force till March 4th, 1823, (3 *U. S. Stat. at Large*, 563.) Then came the Act of March 1st, 1823, before referred to. The 16th section of that Act provides for the appointment, by the President and Senate, in each one of seven designated ports, of two appraisers, who were to make appraisements in such seven ports, and in other ports appraisements were to be made by two merchant appraisers to be appointed by the collector.

A change was made by the Act of 1818, and continued by the Acts of 1820 and 1823, in the mode of appointing appraisers who were to appraise in the case of damaged goods. By the Act of 1799, there were to be two appraisers, one appointed by the collector and the other by the importer. By the Act of 1818 there were to be in certain ports two standing appraisers appointed by the United States, and one appraiser selected in each case by the importer, and in other ports two appraisers selected in each case by the collector, and one appraiser selected in each case by the importer. This was continued by the Act of 1820. By the Act of 1823 there

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were to be in certain ports two standing appraisers appointed by the United States, and in other ports two appraisers appointed in each case by the collector. The change made by the Act of 1818 from the Act of 1799, in the mode of selecting the appraisers, was a marked and a material one, as it gave to the United States the selection of two appraisers, and to the importer the selection of one, instead of giving to the United States the selection of one, and to the importer the selection of one. Hence, when the 15th section of the Act of 1818 said that "the same proceedings shall also be had," on a claim to a reduction of duties on account of damage, the reference would seem to have been to an appraisement "in the manner prescribed" by the ninth section of that Act, without any prescription that it should be either before or after the entry of the goods. The appraisement is a proceeding. By the 52d section of the Act of 1799, appraisement to ascertain damage was to be made by appraisers appointed in a manner prescribed by that section. By the 15th and 9th sections of the Act of 1818, such appraisement was to be made by appraisers appointed in a different manner. The requirement of the 15th section of the Act of 1818, that goods taken from a wreck shall not be entered until they have been appraised, is clear and explicit. Prior to that Act goods taken from a wreck could have been entered as other imported goods, before appraisement, and were within the provisions of law as to goods damaged during the voyage. Reasons can very well be suggested why a change was made in regard to wrecked goods, coming into the country in an irregular way, and not by the discharge of them at a landing wharf, directly out of the vessel which brought them, such change requiring them to be appraised before entry. But no satisfactory reasons can be assigned for a like change in regard to damaged goods landed in the regular way, and it ought to appear very clearly from the language of the statute, that a change was intended in regard to such goods. The system prescribed by the Act of 1799, and continued in force, in regard to the landing of goods regularly imported, was that

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they should first be entered and the duties on them be paid or secured, and then a permit be obtained for their landing, and severe penalties were imposed for landing goods without a permit. (*Act of March 2d, 1799, §§ 49, 50, 1 U. S. Stat. at Large, 664, 665.*) It is impossible for an importer to ascertain, until he sees his goods, after they have been landed in pursuance of a permit following an entry, whether they have been damaged or not. Hence, the 52d section of the Act of 1799 clearly provides for the entry, the payment of duties, the permit, and the landing, in the above order, and then for the allowance for damage. It ought to require explicit language to make a change in this order of proceeding. It was very proper to require that proof of damage should be lodged within ten days after the landing. But, to require appraisement before entry or landing, in the case of goods regularly imported, would be to prescribe a system impossible of practical execution. These views apply to the provisions of the 21st section of the Act of 1823. The natural meaning of the words of that section, which provide that "the same proceedings shall be ordered and executed in all cases where a reduction of duties shall be claimed on account of damage which any goods, wares or merchandise shall have sustained in the course of the voyage," is the same as the natural meaning of the words in the 15th section of the Act of 1818, which provide that "the same proceedings shall also be had where a reduction of duties shall be claimed on account of damage which any goods, wares or merchandise imported into the United States shall have sustained in the course of the voyage," and that is, that the appraisement proceedings shall be conducted in the manner before prescribed in the Acts respectively, and not that goods regularly imported and bonded, and not "taken from any wreck," shall be appraised before entry.

In the case of *Shelton v. Austin*, (1 *Clifford*, 388,) affirmed by the Supreme Court, as *Shelton v. The Collector*, (5 *Wallace*, 113,) the 52d section of the Act of 1799 had not been complied with, in that proof to ascertain the damage

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had not been lodged within the ten days prescribed by that section. The goods were not taken from a wreck, but they were entered before they were appraised. Mr. Justice Clifford, in the Circuit Court, held that they must pay duties on their sound value, as entered, because, under the 21st section of the Act of 1823, they were required to be appraised before entry, in order to warrant an allowance for damage on the voyage. In the Supreme Court no counsel appeared for the plaintiff in error. The Court held that there could be no allowance for damage under the Act of 1799, because proof had not been lodged within the ten days after landing; and that there could be none under the Act of 1823, because there had been an entry before appraisal. The first ground was an adequate one for the affirmance of the judgment, and the United States alone were represented on the argument. In the present case the record shows that the requirement as to the ten days was complied with.

By section 5,595 of the Revised Statutes, those statutes are declared to embrace the statutes of the United States, general and permanent in their nature, in force on the 1st of December, 1873. It follows that the provisions of the Revised Statutes are to be construed as the enactments in force on the 1st of December, 1873, would have been construed. Sections 2,927 and 2,928 of the Revised Statutes are both of them enacted as having been in force on the 1st of December, 1873. The regulations of the Treasury Department in regard to claims for damage allowance, in force and acted on since the Revised Statutes were enacted, clearly recognize the practice and the propriety of entering goods, and then claiming a damage allowance on them, and proceeding to an appraisement. Such was the practice in the present case, acted on by the collector, even to the paying back of the deposited duties on the amount of the damage.

It is contended for the United States, that, under the 21st section of the Act of 1823, goods damaged in the course of the voyage, though not taken from a wreck, must be appraised before entry, in order to warrant an allowance for

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damage; and that as, in this case, the entry was made before appraisal, no allowance for damage was lawful. The District Court took a different view. The practice of the Treasury Department and of the collector has evidently been contrary to what is now contended for by the United States, notwithstanding the decision of the Supreme Court in *Shelton v. The Collector*. This practice, it is fair to assume, has obtained because the Treasury Department did not regard that decision as disposing of the question finally. It is important that the question should be speedily decided by the Supreme Court, both in the interest of the Government and of importers; and, in view of all the facts of the case, I think the most proper disposition of it is, to affirm the judgment of the Court below, and thus enable the United States to obtain speedily a reconsideration of the question by the Supreme Court, instead of sending the case back for a new trial in the District Court, with a long delay before it can reach the Supreme Court.

The judgment is affirmed.

C. P. L. Butler, Jr., (Assistant District Attorney,) for the plaintiffs in error.

Charles M. DaCosta, for the defendants in error.

THE UNITED STATES

vs.

DOMINICK MALONE AND PETER A. MALONE.

An indictment, under § 3,266 of the Revised Statutes, charged, in one count, the unlawful use of a still, for the purpose of distilling spirits, on premises where ale was made, and, in another count, substantially a like offence. The defendant was found guilty on one count, and not on the other, and was sentenced to be imprisoned and fined. At a subsequent term he moved to va-

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cate the judgment, on the ground that the same offence was charged in the two counts, and that the verdict on the first count was made void by that on the second; *Held*, that the motion must be denied, because,

- (1.) Under the Rules of the Court the motion was too late;
 - (2.) The term at which the judgment was entered having expired, the Court had no power to vacate it;
 - (3.) The question raised was adjudicated by the passing of sentence;
 - (4.) The offences charged in the two counts were two different offences.
- Knowledge is not made, by § 3,266, an ingredient in the offence, and, therefore, it need not be averred in the indictment.

(Before BLATCHFORD, BENEDICT and BROWN, JJ., Southern District of New York, December 20th, 1881.)

BENEDICT, J. The defendants were jointly indicted, and tried together at the March term, 1881. The indictment contained three counts, framed under § 3,266 of the Revised Statutes. The first count charged, in substance, that the defendants, on the 5th day of May, A. D., 1879, unlawfully did use a still for the purpose of distilling spirits, on premises where ale was manufactured, to wit, on the premises number 513 West 52d street, in the city of New York.

The second count charged, in substance, that the defendants unlawfully and knowingly did use, and did aid and assist in using, a still for the purpose of distilling spirits, on the premises number 513 West 52d street, on which said premises, fermented liquor, to wit, ale, was manufactured and produced.

The third count charged, in substance, that the defendants unlawfully and knowingly did use a boiler for the purpose of distilling spirits on premises where ale was produced, that is to say, on the premises number 513 West 52d street, in the city of New York.

The verdict of the jury upon the first count was not guilty as to Peter A. Malone, and guilty as to Dominick Malone. On the second and third counts the verdict was not guilty as to both the defendants. Thereupon, Peter A. Malone was discharged, and afterwards, and at the May term, on motion of the District Attorney, Dominick Malone was sentenced to be imprisoned for a period of 16 months, and to pay a fine of

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\$1,000. Now, at the October term of the Court, application is made in behalf of the prisoner to vacate the judgment and commitment. This application is based on the proposition that the offence charged in the first count of the indictment is the same offence charged in the second count, and that the acquittal on the second count must prevail and makes void the verdict upon the first count. To this there are several answers.

First. The objection, if valid, comes too late. By the Rules of this Court, when a conviction is had, sentence is deferred to the next term of the Court for the purpose of affording opportunity to move meanwhile in arrest of judgment or for a new trial, and the Rules prescribe that notice of such a motion must be filed within three days after the conviction, and the minutes of the trial, as settled by the Judge who tried the case, be filed before the first day of such subsequent term.

In this case the prisoner was sentenced at the term subsequent to the conviction, in the absence of any motion for a new trial, or in arrest of the judgment, in pursuance of the Rules, and he cannot now, at this late day, after judgment, and when his term of imprisonment has partly expired, upon a motion like the present, urge an objection which, if valid and taken in the manner prescribed by the Rules, would have arrested the judgment. By omitting to comply with the Rules, the prisoner must be deemed to have waived the right to raise in this Court any question proper to be raised in the manner required by the Rules.

Second. The judgment sought to be vacated was rendered at the May term of this Court, and this application is made at the October term thereafter. The term at which the judgment was entered having expired, no power remains in the Court to vacate the judgment. (*The Bank v. Labitut*, 1 *Woods*, 11; *Bank of United States v. Moss*, 6 *How.*, 31.)

Third. The question now presented in regard to the effect of the verdict rendered upon the second count was necessarily involved in the question of sentence, and, when the prisoner was sentenced, it was necessarily adjudged by the

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Court that the verdict upon the second count did not make void the verdict on the first count. That determination cannot now be brought in review by an application like the present, made after final judgment.

It is said, however, that the judgment is void, because there is no conviction, the defendant having been acquitted on the second count. But, how can the judgment be held void, when the Court had jurisdiction of the person and of the subject-matter, and the record shows a valid indictment, a verdict of guilty upon one of its counts, and a sentence such as the law permits for the offence charged in such count? If there was error, as, manifestly, there was not, in the determination made at the trial in regard to the effect of the verdict of acquittal upon the second count, such error would not make void the sentence pronounced upon the verdict of guilty which the record shows to have been rendered on the first count.

Moreover, the contention in behalf of the prisoner, that error was committed at the trial in construing the verdict to be a verdict of guilty, rests upon the assumption that the offence charged in the second count is the same offence charged in the first count. The assumption is without foundation.

It is possible for a person to commit two similar crimes on the same day, and to be indicted and punished therefor; and two crimes are committed when two different stills are used at different times on the same day, on premises where ale is manufactured. It is not to be denied that two such crimes may be charged in one indictment, in different counts, nor that in such case each separate count of the indictment, in judgment of law, charges a separate and distinct offence. Each count in an indictment is, in fact and theory, a separate indictment. Different counts are allowable only on the presumption that they are different offences, and every count so imports on the face of the record. (*Heard on Crim. Pleading*, 235, 236. See, also, *Rev. Stat.*, § 1,024.) Accordingly, this record shows the prisoner charged, in two separate counts, with having used two different stills at different times, on the day and at the place described; and there is no room to con-

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tend that, because the jury convicted the prisoner on one count, and acquitted him as to the other, they found him guilty and likewise not guilty of the same offence.

It has been said, by way of argument, we suppose, for the record discloses no such thing, that at the trial evidence as to only one offence was given. If such be the fact, we fail to see how the conclusion follows that the prisoner was improperly adjudged to have been convicted of one offence. The evidence having proved the use by the prisoner of one still, and no more, on the day and at the place described, what was there for the jury to do but to render the verdict they did, namely, guilty of using one still and not guilty of using another? On such an indictment and upon such evidence, the verdict must necessarily be, guilty on one count and not guilty on the other. Plainly enough, therefore, the verdict in this case amounts to a conviction on the first count of the indictment, and no error was committed when it was so held at the time of passing sentence.

In addition to the point already considered, we find upon the brief a second point, not pressed at the argument, that the first count of the indictment charges no offence, because it omits to aver knowledge. It appears, from what has already been said in regard to the first point, that an objection like this cannot be considered upon the present application. But, the point, if open for consideration, could not prevail, for the reason that knowledge is not made by the statute to be an ingredient in the offence. When a statute prohibits generally and makes no reference to intention, an averment of knowledge is unnecessary. (*United States v. Smith*, 2 *Mason*, 143, 150; 1 *Stark. Crim. Pl.*, 182, 183.) Here the statute prohibits the use of a still for the purpose of distilling. This indictment charges an act such as is described in the statute, done for the purposes specified in the statute, and, consequently, charges the offence created by the statute.

Sutherland Tenney, (*Assistant District Attorney*), for the United States.

Roger M. Sherman, for the defendant.

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GEORGE A. FLAGG AND OTHERS

vs.

THE MANHATTAN RAILWAY COMPANY, THE METROPOLITAN
ELEVATED RAILWAY COMPANY, AND THE NEW YORK
ELEVATED RAILROAD COMPANY. IN EQUITY.

The history given of the leases of May 20th, 1879, made by the Metropolitan Company and the New York Company to the Manhattan Company, and of the "tripartite agreement" of that date between the three companies, and of the litigation respecting said leases and said agreement, and of the agreements of October 22d, 1881, between the three companies, modifying the said leases and the said "tripartite agreement."

The agreements of October 22d, 1881, do not impair any vested rights of the stockholders of the Metropolitan Company.

There was no contract between the Manhattan Company and the individual stockholders of the Metropolitan Company, or between the latter company and its stockholders, that they should have a dividend of 10 *per cent. per annum* on their stock.

The directors of a corporation have a general power to make and modify its contracts, and its stockholders cannot control that power, nor was it necessary to the validity of the agreements of October 22d, 1881, that they should have been approved by any one or more stockholders.

The Act of April 28d, 1839, (*Laws of New York, 1839, chap. 218, p. 195.*) authorized the making of the said leases and agreements.

The new agreements were made in good faith and with a fair exercise of the judgment and discretion of the directors of the Metropolitan Company.

(Before BLATCHFORD, J., Southern District of New York, December 21st, 1881.)

BLATCHFORD, J. This suit is brought by three persons as individuals and two persons as copartners, who claim to be owners of shares of the capital stock of the Metropolitan Elevated Railway Company, 155, 10, 150 and 75 in number, of the par value of \$100 each, there being 65,000 shares in all. The three companies defendants are railroad corporations, organized under the laws of the State of New York, and will be called the Manhattan, the Metropolitan and the New York.

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The first company had no lines of railway. The second and third had elevated railways in the city of New York. On the 20th of May, 1879, the three companies entered into a written agreement, known as the "tripartite" agreement. It recites that the agreement is made "for the purpose of avoiding the danger of crossing elevated railway tracks upon the same level, and otherwise securing to the people of New York the advantages of safer and more rapid transit through the action of one directing body." It provides for the execution of the leases hereinafter mentioned, and contains other provisions which it is not important at this point to notice. On the same day, the Metropolitan and the Manhattan executed an agreement of lease in writing. It recites that the Metropolitan is authorized to construct and operate a line of elevated railway in the city of New York, a portion of which, specifying it, is completed and in operation by it, and is engaged in constructing other parts; that the New York is the owner of and engaged in operating certain lines of elevated railway in said city, over routes heretofore established by law for it, "which railways and routes at various places unite with the railways and routes" of the Metropolitan "and cross and connect and unite therewith at the same level;" that "the development of the business of passenger traffic on elevated railways in said city has made it necessary for each of said companies to run trains in such manner, and with such speed and frequency, that the crossing of the trains of one company over and upon the tracks of the other company, and the running of the trains of both companies upon the portions of track and route jointly owned or used by them, is deemed impracticable except at the risk of inconvenience and delay to the public and danger to human life;" that, "after protracted efforts to devise plans for operating all said lines so as to afford to the public perfect fullness of accommodation and safety, it is the opinion of both companies, that such management cannot be assured while the trains of the two companies are run under the control of differing managing officers, or otherwise than by placing the lines of both com-

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panies under one sole control, with power to change from time to time the termini of routes, to regulate and limit the passage of trains from the tracks of one company upon the tracks of the other at the connecting and crossing points, and to do such other things and make such other changes, from time to time, in the entire management of traffic upon the lines of both railways, as experience may show to be necessary or desirable ;" that the Manhattan "is by law authorized to construct and operate elevated railroads in the city of New York, whether owned or leased by it, and is willing and desirous to accept," and the Metropolitan and the New York "have agreed to execute and deliver to it, leases of all their respective railways and properties, as described in this instrument, and in a similar instrument of even date herewith, to be executed by the New York," "as lessor to the Manhattan," "upon all and singular the terms, agreements and conditions herein and therein mentioned and set forth ;" that the Metropolitan "has heretofore executed to the Central Trust Company of New York its first mortgage, bearing date July 10, 1878," "securing the bonds therein provided for, the total amount thereof now issued and agreed to be issued being" \$8,500,000 of principal ; that the Metropolitan "may be hereafter required" by the Manhattan "to issue further amounts of the said bonds secured by the said mortgage in excess of said" \$8,500,000, "for the purpose of constructing and equipping extensions of the line of the Metropolitan," "payment of all which bonds, principal and interest, is to be assumed by the Manhattan ;" and that the Metropolitan "has issued and agreed to issue its capital stock, to the amount, at its par value," of \$6,500,000, upon which stock the Manhattan "has agreed to guarantee the payment of a dividend of ten *per cent. per annum*, as hereinafter provided." Then, by the agreement, the Metropolitan, "in consideration of the rents, covenants and agreements hereinafter mentioned, reserved and contained, on the part of the Manhattan," "to be paid, kept and performed," leases to the Manhattan "all and singular the railroad or rail-

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way, now owned, operated or constructed by it in the city of New York, as above described, and all and singular the unfinished portions thereof now under construction, together with all its franchises, rights and privileges relating thereto, or to the construction and operation of its entire railway as authorized, subject to the said mortgage and to the terms and conditions under which said franchises are held by the company, with all and singular the right, title, estate and interest which the Metropolitan Company has in any real estate in the city of New York heretofore acquired by it, or which it may hereafter acquire under contracts already made therefor, being all and singular the entire property and estate of said Metropolitan Company, except such of its franchises, rights and privileges as are or may be necessary to preserve its corporate existence or organization, and its interest in the covenants and conditions of this indenture." The lease is for 999 years from November 1st, 1875, or so long as the Manhattan "shall continue to exist as a corporation and be capable of exercising all the functions herein stipulated on its behalf," the Manhattan paying to the Metropolitan the yearly rent of \$10,000, payable semi-annually on the 1st days of January and July, the first payment of \$5,000 to be made July 1st, 1879, "and keeping and performing all and singular the covenants and agreements hereinafter set forth to be by the Manhattan" "kept and performed." The Manhattan assumes and agrees to pay, as they respectively become due, the principal and interest of the said recited first mortgage bonds of the Metropolitan, and keep it harmless from all claims against it arising from all or any of said bonds. Then follows this article: "Article Second. The Manhattan Company guarantees to the Metropolitan Company an annual dividend of ten *per cent.* on the capital stock of the Metropolitan Company, to the amount of six millions five hundred thousand dollars; that is to say, the Manhattan Company will, each and every year during the term hereby granted, beginning with the first day of October, eighteen hundred and seventy-nine, pay to the Metropolitan Company six hundred

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and fifty thousand dollars, free of all taxes, in equal quarterly payments of one hundred and sixty-two thousand five hundred dollars each, on the first days of January, April, July, and October in each year, the first of such payments to be made on the first day of January, eighteen hundred and eighty; and the Manhattan Company will, from time to time, execute in proper form a guaranty to the above effect, printed or engraved upon the certificates of stock of the Metropolitan Company, and, as such stock certificates are surrendered for cancellation and re-issue, will, from time to time, at the request of the holder, renew such guaranty upon all re-issued certificates." It is then provided that the portions of the railway of the Metropolitan which were completed on the 31st of January, 1879, shall be deemed to have been operated from the close of business hours on that day by the Manhattan, and all such operation from and after that time shall be for the account of the Manhattan; that the Manhattan shall run the railways, and keep them in repair and working order and supplied with rolling stock and equipment; that, "in addition to the rental herein above provided," it shall pay all taxes, assessments, duties, imposts, dues and charges which shall become payable by the Metropolitan or be imposed on the leased property or its business, earnings or income; that the Manhattan will save harmless the Metropolitan against all expenses of operating the railways, and all claims and suits for injuries to persons and property, or for causing the death of any person, or for any other thing in the operation or management of the leased property, or for any breach of contract by the Manhattan in carrying on the business, and will defend all suits and claims brought against the Metropolitan in respect of any matter arising out of the management or operation of said railways since January 31st, 1879; and that, in case the Manhattan shall at any time fail to pay in full said cash rental "or the guaranteed dividend aforesaid, as the same shall become payable, or fail or omit to keep and perform the covenants and agreements herein contained, or any of them, and continue in default in respect to the performance of such

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covenant or agreement or payments for the period of ninety days," the Metropolitan may enter on the leased railways and premises and thenceforth hold, possess and enjoy them as of its former estate, and, upon such entry, the interest of the Manhattan therein shall cease. The Manhattan then agrees with the Metropolitan that it will execute, acknowledge and deliver "any and all instruments for the more effectually assuring unto the Metropolitan" "the payment of the cash rental and dividends hereinbefore reserved or agreed to be paid." On the same 20th of May, 1879, an agreement of lease in writing was executed by the Manhattan and the New York, in like terms, in all respects, *mutatis mutandis*, with the one between the Manhattan and the Metropolitan.

Under these agreements of lease the Manhattan proceeded to operate the railways of the other two companies. On the 2d of July, 1881, The People of the State of New York brought a suit, in the Supreme Court of New York, against the Manhattan, the complaint in which sets forth the fact of said leases and the operation of the roads under them by the Manhattan; that by their terms it agreed to pay outstanding obligations of the other two companies, amounting to very large sums, and, under them, is now liable for the payment of bonds of said companies, amounting in the aggregate to about \$21,000,000, and the interest thereupon, and for the payment of all taxes on said roads, and to pay to said companies certain additional fixed charges created by said leases, and which aggregate more than \$1,300,000 per annum; that the Manhattan is, and for a long time has been, operating said railroads at a great loss, which loss, for the year ending September 30th, 1880, was, according to its estimates, about \$500,000; that the continued operation of said road by it will result in further loss to it; that it owes, and for a long time past has owed, a sum exceeding \$900,000 dollars for taxes unpaid, a large part of which has been due for more than one year; that it has no assets with which to meet its existing indebtedness and the requirements of said leases, except the receipts which accrue to it, from time to time, from said roads,

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which fall short of its annually accruing obligations to the amount of at least \$1,000,000 per annum; and that, on or about April 25th, 1881, it addressed a communication in writing to the mayor, comptroller and corporation counsel of the city of New York, whereby it declared itself to be unable to defray its obligations, especially its indebtedness for taxes, and, in substance, declared itself insolvent, and showed it had been so for more than a year. The complaint prayed a dissolution of the incorporation of the Manhattan and a forfeiture of its corporate rights, privileges and franchises, and the appointment of a receiver of its property, and of a temporary receiver. On the 12th of July, 1881, the Manhattan answered the complaint, denying its insolvency, admitting that, during the year ending September 30th, 1880, the said roads were operated by it at a loss, and that, on or about the 25th of April, 1881, it addressed a communication to the mayor, comptroller and corporation counsel of the city of New York, and denying the other material allegations of the complaint. On the 13th of July, 1881, the Supreme Court, by Mr. Justice Westbrook, after a hearing of both parties, appointed John F. Dillon and Amos L. Hopkins to be temporary receivers of the Manhattan. On the 23d of July, 1881, the New York presented to the Supreme Court a petition in said suit, praying that the Manhattan and the receivers be directed to deliver over to the New York its railways and other property. The petition alleges that the Manhattan owes the New York, for gross rental, dividend rental and interest on mortgage bonds, \$465,000, and has not paid the taxes assessed on the New York for 1879 and 1880; that the New York owes no debts except its first mortgage bonds to the amount of \$8,500,000, and claims for damages and taxes, which the Manhattan is bound to pay, and has a considerable cash surplus in hand; that the Metropolitan owes first mortgage bonds to the amount of \$10,818,000, and second mortgage bonds to the amount of \$2,000,000; that the net earnings of the railways of the New York for the last two years have been more than enough to pay the interest on its bonds and dividends of at

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least 10 *per cent.* to its shareholders, but the net earnings of the railways of the Metropolitan have been barely enough to pay the interest on its bonds; that the dividend rental paid to the Metropolitan for the six months prior to July, 1881, has been paid out of the earnings of the New York; that the indebtedness of the Manhattan to the New York is increasing every day, and the railways of the New York and the Metropolitan are now run at the expense and risk of the New York; that the structures and rolling stock of the New York and the Metropolitan have not been kept up to the standard required by the tripartite agreement and the leases, and the falling off in this respect has been greater on the New York railways than on the Metropolitan; that the Manhattan has kept up the structures and rolling stock of the Metropolitan better than it has kept up those of the New York; that a considerable number of the engines of the New York have been sold by the Manhattan, which has neither replaced the same nor paid the proceeds to the New York; and that the New York, if it got back its railways in their present condition, would have to pay a large sum to replace its rolling stock and structures in the state in which the Manhattan took them. This petition was brought to a hearing before Mr. Justice Westbrook on the 14th of September. No decision on it being made, the New York, on the 30th of September, presented a supplemental petition, praying the same relief, and setting forth that since the default of the Manhattan in not paying to the New York the various sums of money which were due on July 2d, ninety days have elapsed, the last day of the ninety being September 29th; that none of said moneys have been paid except \$50,000, paid before the former petition was brought; that on the 29th of September the New York demanded of the Manhattan and of its receivers payment of said sums, but they were not paid; that, by reason thereof, a forfeiture of said leasehold estate has accrued to the New York; and that it is entitled to the possession thereof. This supplemental petition was brought before the Court on the 3d of October, and, after hearing the plaintiffs in the suit

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and the receivers and the New York, the Metropolitan and the Manhattan, an order was made giving leave to the Manhattan and the Metropolitan to answer on or before October 5th, and directing that the supplemental petition be considered as part of the original petition. On the 8th of October, 1881, the receivers put in an answer to the petition of the New York, and the Manhattan put in an answer to it similar to the answer of the receivers. The answer sets up that, on or about August 31st, 1881, one Watson brought a suit, in this Court, by leave of the said Supreme Court, in behalf of himself and all other stockholders of the Manhattan, against the New York and the Metropolitan and the receivers, by filing a bill of complaint and serving process on the defendants, the same being what is known as a stockholder's suit, and, in substance and effect, a suit by the Manhattan against the New York and the Metropolitan, to have judicially determined whether the New York and also the Metropolitan are not indebted to the Manhattan each in the sum of \$6,500,000, the bill alleging an indebtedness of the New York to the Manhattan of \$6,500,000, and seeking to enforce such liability, and praying an accounting of the operations of the lease from the New York, and that the New York be decreed to pay to the Manhattan or to the receivers such sum as may be found due; that the legal rights and equities of the New York and the Manhattan are necessarily involved in said suit, and the Supreme Court ought to leave the rights of the parties to be determined therein on issues regularly made and tried on proof; that the Supreme Court should not, as a Court of equity, enforce the forfeiture asked, but leave the New York, by ejectment or other remedy at law, to recover possession of the property; that there are \$13,000,000 of Manhattan stock outstanding in the hands of numerous and scattered holders; that the effect of granting an order of forfeiture will be to destroy the value of such stock, beyond repair; that on the last day of September an injunction order was in force, granted by Mr. Justice Westbrook in said suit, restraining the Manhattan and its officers from interfering in

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any way in the business of the Manhattan ; that the three companies are, and were on the 30th of September, by an injunction issued in a suit in this Court, each of them enjoined from paying any taxes imposed on the capital stock and personal property of any one of them, by the city of New York, for the year 1880 ; that the New York, in a suit brought by it, in July, 1881, against the Manhattan and the Metropolitan, obtained an injunction order restraining the Manhattan from parting with any moneys then in the possession or under the control of the Manhattan, which had been or might be received by it from traffic on any of the railways of the New York, except as required strictly for the operation of the railways of the New York leased to the Manhattan, which injunction was in force on the last day of September ; that the Manhattan is not in default for not paying taxes assessed on the New York for the years 1879 and 1880 ; that, as to the remainder of the taxes assessed on the New York, the Manhattan, because the taxes were excessive, unequal and illegal, determined, with the concurrent consent of the New York and the Metropolitan, that payment of them should be refused, and proceedings be taken to review such unlawful taxation, and such proceedings were taken and are pending, in the name and at the request of the New York, to contest the legality of said taxes and the obligation of the Manhattan to pay them ; that the alleged default of the Manhattan in not paying the taxes assessed upon the New York in the years 1879 and 1880 was in accordance with the express instructions of the New York to that effect, and the action of the Manhattan in relation thereto was essential to the protection of the rights of the companies parties to the tripartite agreement, and of the stockholders of each of said companies ; and that, on or about the 1st of October, 1881, the New York and the Metropolitan demanded of the receivers the payment of rent alleged to be due to them respectively from the Manhattan under said leases.

Mr. Justice Westbrook rendered a decision on the petition of the New York, at a date stated in the bill in this suit to

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have been on or about the 14th of October, 1881. The decision refers to the fact that in the tripartite agreement the Manhattan agrees to issue and deliver to the New York and the Metropolitan its two bonds, each for \$6,500,000, payable on demand, one to a trustee for the stockholders of the New York, and the other to a trustee for the stockholders of the Metropolitan, with authority to the trustees respectively to use the same, if they see fit, in payment for the stock of the Manhattan at par; and that the said bonds were executed and exchanged for stock in the Manhattan, so that the New York and the Metropolitan, or their stockholders, became the owners of the entire capital stock of the Manhattan, then amounting to \$13,000,000. Mr. Justice Westbrook held that the mere appointment of the receivers did not terminate the lease, nor did the insolvency of the Manhattan, if it were insolvent; that the Court had no power to settle the questions involved summarily, or otherwise than in an action regularly instituted by the New York to recover the property; that the failure to pay the taxes did not forfeit the lease, because the New York had approved the non-payment, and because there was a proper question as to the lawfulness of the taxes not paid; and that the testimony as to a breach of the lease by not keeping the road of the New York in repair, was conflicting. As to the default for 90 days in paying rent, the judge remarked, that the New York had obtained the said injunction against the Manhattan, and could not enforce a forfeiture arising from the non-payment of money, when it had itself enjoined the Manhattan from using the principal part of its revenue for any such purpose. The Judge then proceeds to say; "Waiving, however, this point, there is another of great importance, also made by said answers of the Manhattan Company and the receivers, which will now be stated. It will be remembered that the capital stock of the Manhattan Company is \$13,000,000. This entire stock was transferred and given to the New York Company and the Metropolitan Company, in professed payment of the leases made to the Manhattan Company, \$6,500,000 to each. It is true this was not directly

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done, for the form was the execution of two bonds by the Manhattan Company, of \$6,500,000 each, the one to a trustee for the benefit of the New York Company, and the other to a trustee for the benefit of the Metropolitan, which bonds were exchangeable for the stock of the Manhattan Company at par, and such exchange was immediately made. The directors of the Manhattan Company were persons who were directors of the other two companies. By the terms of the lease the Manhattan Company was to pay the bonded debt of the other companies, with the interest, and also an annual dividend of *ten per cent.* on the capital stock of the lessor companies, in quarter yearly payments. The plain effect of this transaction is manifest. The lessor companies, being the owners of the stock of the lessee company, and their directors being its directors, the individuals owning the stock of the former really agreed with themselves to pay themselves a large and liberal rental for the use by themselves of their own property. This was the real transaction; but, as individuals were concealed under the cloak of corporations, the apparent transaction, which alone the general public would be apt to see, was a leasing from two independent corporate bodies to a third equally independent. Such leasing, however, was at a rental which, if the estimates of the earning capacity of the leased roads, submitted upon this motion by the petitioner, to prove the bankruptcy of the tenant company, are accurate, it was impossible for such company to pay. The individuals who had thus extracted the life from the lessee company, by the provisions for the payment to themselves of liberal dividends, and the absorption of its entire stock, proceeded to divide, and did divide, such stock among themselves, and then disposed of it to the general public, thus shifting the burden of paying rent from themselves to others, and actually receiving from such strangers to the original transaction, large sums for the privilege of assuming burdens they could not discharge, and which could only result in the restoration to them of the property leased, and the absolute loss by the buyers of Manhattan stock of their whole purchase price. To recover payment for

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this stock from the two lessor companies, an action is now pending in the United States Circuit Court for the Southern District of New York, brought by John C. Watson, a stockholder of the Manhattan Company, to which suit, by permission of this Court, the receivers appointed in this action are parties. The existence of this action, and the grave question which it presents, are urged, both by the Manhattan Company and the receivers, as reasons why, in advance of the determination thereof, this Court should not surrender the property it holds by its receivers. It would, perhaps, be improper to express an opinion upon the merits of this action, further than to say that it presents reasonable grounds for judicial inquiry. As a rule, stock purchased of a corporation must be paid for either in cash or its equivalent; and, if not so paid for, the money which it represents can be recovered. The answer of the petitioning company is, of course, that the stock was paid for by the lease which it gave. Whether, however, this was a *bona fide* exchange of a substantial thing, which the law can treat and regard as a payment for the stock transferred, or the contrary, is the point which that suit presents. Leaving out of view the very grave question of the power of the lessor companies to lease its roads, and of the lessee company to accept them—which is not considered, because not presented nor argued, but which leases, if illegal because *ultra vires*, would leave the stock of the Manhattan Company entirely unpaid for—is it not most apparent that the innocent holders and purchasers of stock of the Manhattan Company have grave questions to submit to the Court, both as against the lessor companies, and also their stockholders, who placed the Manhattan stock upon the market to their great injury? It is enough for present purposes, without passing directly upon the merits of the Watson suit, to say that that which is unjust is unlawful, and for every unlawful act done to another to his injury the law affords a remedy. Whether any of the apparently bald facts which have been mentioned can be explained so as to give them a different color, is a question for the trial. As they appear upon this motion to me, it is plain that

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they should not be ignored, and the property asked for surrendered upon the ground of the non-payment of obligations incurred by the lease, when, perhaps, a trial of the action pending may determine that the Manhattan Company is not a debtor to, but a creditor of, the petitioner." After thus reaching a conclusion, on the merits, adverse to the relief sought, the Judge held, that, as the application was one addressed to the discretion of the Court, and as it involved grave and difficult questions of law and fact, it ought to be disposed of by an action and not by a motion. He added: "To the general objection of deciding such grave questions as this application involves so summarily, is added one growing out of the tripartite agreement hereinbefore detailed. A sort of quasi-partnership was thereby formed between the three contracting parties. The Metropolitan Company joins its objections to those of the Manhattan Company, and protests against the granting of the petition, and claims the right to be heard by a formal suit upon the issues which have been presented. Their request is reasonable, and the relief asked for must be denied upon the ground of discretion also, without prejudice, however, to the right of petitioner to bring an action against the receivers, leave to do which will be granted." The portions of the tripartite agreement thus referred to as forming a sort of quasi-partnership are, a provision providing for building certain parts of the railway structures at the joint expense of the New York and the Metropolitan, and a provision (Article 14) that whenever, in any fiscal year, the Manhattan shall elect to declare a dividend of more than ten *per cent.* on its capital stock, the Manhattan shall pay to the New York and the Metropolitan a sum sufficient to enable them to pay as large a dividend in excess of ten *per cent.*, on the stock of the New York and the Metropolitan, as shall be declared on the stock of the Manhattan, in connection with the other provisions of that agreement.

Such was the condition of the litigation between or affecting the three companies, so far as it is material to refer to it, when, on the 22d of October, 1881, the agreement in writ-

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ing was made between them, out of which the present suit arises. It sets forth, as part of it, copies of the tripartite agreement and of the two leases. It then recites that possession of the railways and property leased was delivered to the Manhattan and it continued in the possession and operation thereof until July 14th, 1881, when possession thereof was delivered to said receivers, who are still in possession thereof, operating them; that "it has been found impracticable to carry out the various terms and conditions imposed by said agreement and leases on the Manhattan;" that the interests of each of the parties, as well as the interest of the public, still require that the lines of railway shall continue to be operated under a single management; and that the parties, "for the purpose of settling all the matters and differences between them, and for continuing the operation of said properties and railways by a single management," have agreed to modify the said agreement and leases as hereinafter set forth. It then provides as follows: (1.) The Manhattan shall continue to possess and operate the properties and railways for the period and on the terms agreed in the leases, except as "herein" modified or changed, such possession to commence as soon as the properties can be obtained from the receivers. (2.) The Manhattan, from moneys received by it on acquiring possession of the properties, and all moneys thereafter acquired by it from the operation of them, after the payment of operating expenses and of all lawful taxes and assessments against either of the parties or its property, and before paying the sums mentioned in clause 3, shall pay 1. To the New York, all sums of money due and owing to it under the terms of the lease from it, on the 1st of July, 1881. 2. To the Metropolitan, in the same manner, and out of said moneys, the interest due on its bonds, as provided in the lease from it, from the 1st of January, 1881. (3.) After making the payments provided for by clause 2, all moneys received by the Manhattan from the operation of the properties shall be used by the Manhattan 1. For the payment of operating expenses and maintenance of structures and equipment. 2. For the

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payment of all taxes and assessments lawfully imposed upon either of the parties, or its properties, or the income therefrom. 3. For the payment of the interest on the bonds of the New York and the Metropolitan. 4. For the payment to each of them of the rental of \$10,000 per annum, as set forth in the leases. 5. The Manhattan shall pay to the New York annually, during the continuance of the leases, a sum of money equal to 6 *per cent. per annum* on the amount of the present capital stock, to wit, \$6,500,000, of the New York, in equal quarterly payments of \$97,500, on the first days of January, April, July and October, the first to be made January 1st, 1882. 6. The Manhattan shall pay to the Metropolitan annually, during the continuance of the leases, a sum of money equal to 6 *per cent. per annum* on the amount of the capital stock of the Metropolitan, in equal quarterly payments, on the first days of January, April, July and October, the first to be made January 1st, 1882. 7. The several payments enumerated in the foregoing 6 subdivisions of clause 3 shall be made, and shall have preference over one another, in the order so enumerated, and all moneys received by the Manhattan from the operation of the properties, after making said payments, shall be the property of the Manhattan, and shall be retained by it for its own use and benefit, subject to the covenants "herein" contained, and to the unmodified covenants of the leases. 8. The sums provided to be paid by subdivisions 5 and 6 of clause 3 shall only be payable out of the moneys received by the Manhattan from the operation of the properties prior to the dates respectively at which said payments by the terms of the agreement become due. (4.) The provisions of the tripartite agreement and the leases are modified so as to conform to "the provisions of this agreement," and the New York and the Metropolitan release the Manhattan from all agreements to pay to the New York and the Metropolitan, or either of them, "the sum or sums of money as is particularly provided in" Article 14 of the tripartite agreement, and Article 2 of the leases. There is, also, a clause whereby each of the parties releases the others, and

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each of them, "of and from all and all manner of action and actions, cause and causes of action, suits, debts, dues, sums of money, claims and demands whatever, whether in law or in equity, against either of the other parties hereto, except such as are embraced in and created by the terms of said agreement and leases, as modified, and the terms and provisions of this agreement." By a supplemental agreement of the same date, executed by the three parties, it was further agreed, that the Manhattan will pay to the New York all sums due and owing to it under its lease to the Manhattan, up to and including October 1st, 1881, and that the Manhattan will pay to the New York the sum of 6 per cent. on its present capital stock, "in the manner and at the times stated in the foregoing agreement, and the payment thereof shall be cumulative, notwithstanding any provision in the eighth subdivision of the third clause thereof."

The bill in this suit is brought by the plaintiffs in their own behalf, and in behalf of all others, shareholders in the Metropolitan, similarly situated with the plaintiffs, who may come in and contribute to the expenses of the action and consent to be bound by the decree herein. It alleges, that, immediately after the execution of the tripartite agreement and the leases, and the delivery of its road to the Manhattan, the Metropolitan, in order to secure to its shareholders the benefit of Article 2 of the lease, and in order to enhance the value of the shares of said stock, caused to be printed on the stock certificates of the Metropolitan the following memorandum: "The Manhattan Railway Company, for value received, has agreed to pay to the Metropolitan Elevated Railway Company an amount equal to ten *per cent. per annum* on the capital stock of the latter company, that is to say, on six and one-half millions of dollars, payable quarterly, commencing January 1st, 1880;" that the capital stock of the Metropolitan then was, and still is, \$6,500,000, divided into 65,000 shares of the par value of \$100 each; that all the certificates of said shares issued by the company after the execution and delivery of the tripartite agreement and leases, were issued with said

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memorandum printed thereon; that the said shares were largely dealt in in the city of New York, and were bought and sold as the stock upon which an annual dividend of 10 *per cent.* was granted by the Manhattan, and as, upon the sale and transfer, from time to time, of shares of said stock, certificates were surrendered for cancellation and re-issue, the Metropolitan issued new certificates containing the same memorandum, and no shares were dealt in, after January, 1880, which did not contain said memorandum; that, during the year 1880, the Manhattan paid to the Metropolitan quarterly, and the holders of shares of the Metropolitan received, the said dividends "so guaranteed," and said dividends were also paid in January and April, 1881, but thereafter the Manhattan made default in the payment of the dividend due July 1st, 1881, and has hitherto continued in default; and that each of the plaintiffs purchased his stock as stock upon which a dividend of ten *per cent.* was guaranteed by the Manhattan, and with knowledge of the general provisions of the tripartite agreement and the leases, and the certificates issued to the plaintiffs by the Metropolitan have each of them on it the said memorandum. The bill recites the appointment of the receivers, and alleges that, on or about the 25th of October, 1881, by order of the Court, the property was surrendered by the receivers to the Manhattan, and the receivership was vacated. It sets forth the fact of the application of the New York for the restoration of its property and of its denial, and the making of the agreement of October 22d. It alleges that the suit brought on behalf of The People was not ended until about November 17th; that there has been no material change in the alleged insolvent condition of the Manhattan which made the receivership proper, other than such as may result from the execution of the agreement of October 22d; that, during the receivership, negotiations were entered upon between some of the officers of the three companies, looking to a modification of the terms of the tripartite agreement and the leases; and that, during the pendency of said negotiations, it was given out, and the plaintiffs expected, that the terms of any arrange-

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ment which should be concurred in by the officers negotiating on behalf of the several companies would be submitted to the shareholders for approval, but the plaintiffs have never been consulted in respect to said proposed agreement, and have never consented thereto, and have only been able to ascertain the terms of the same with considerable difficulty. The bill further alleges, that, by the agreement of October 22d the officers of the Metropolitan have undertaken to subordinate the rights and the position of the Metropolitan to the New York, especially by releasing all claims to the dividends accruing July 1st and October 1st, amounting to \$325,000, whereas the same amount due to the New York is to be paid, and, in reference to future dividends, by waiving altogether the guaranty of the Manhattan, and making the dividends payable to the Metropolitan payable only after the dividends to the New York shall have been first paid, and out of any surplus earnings that may be left; that, by the supplemental agreement of the same date, the rights and position of the Metropolitan were further subordinated to the New York, in that the dividends agreed to be paid to the New York were to be cumulative, while those due to the Metropolitan could never be paid out of any earnings, however large, received after the date of the accruing of the dividend; that the officers of the Metropolitan who have actively labored to consummate said arrangement have betrayed its true interests, and the rights and interests of its shareholders, influenced thereto by corrupt motives and by personal interests hostile to their position and duties as its directors; that, at an election of directors held in July, 1881, Russell Sage and Jay Gould became, for the first time, directors of the Metropolitan; that the Manhattan, being shortly thereafter, and on or about July 13th, placed in the hands of receivers, its shares became very much depressed in value, and in August following sold as low as \$16 per share; that thereupon said Gould, being a director of the Metropolitan, began purchasing shares in the Manhattan, and, on October 8th, had standing in his own name, on the books of the Manhattan, 20,000 shares; that 1,000 shares then stood

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in the name of his son George J. Gould, 1,100 shares in the name of W. E. Connor, and 12,400 shares in the name of W. E. Connor & Co., who have heretofore acted as the brokers of said Gould in the purchase and sale of stocks, and in which firm said Gould is a partner; that said 14,500 shares belong to, or are held in the interest of, said Gould; that, when said agreement was made, he had invested in the stock of the Manhattan over \$500,000; that said Sage, a director and the president of the Metropolitan, is largely interested in the stock of the Manhattan, though his name appears on its stock register as the holder of only 100 shares; that said Gould is, in his own name, the largest holder of stock in the Manhattan, substantially all of which he has acquired since he became a director of the Metropolitan; that he, together with said Sage, took an active and the principal part in the negotiations which led to the agreement of October 22d; that the negotiations on the part of the New York were conducted by its president, Cyrus W. Field; that, though he holds, as appears by the stock register of the Manhattan, only 100 shares of its stock, he has become largely interested in the Manhattan, and began to purchase shares of it as soon as it seemed probable said agreement would be executed, and in view of its being carried into effect; that said Sage, who, as president of the Metropolitan, executed said agreements of October 22d, and said Gould, who actively influenced their execution, were, from their fiduciary position, disqualified from executing the same without the consent of the shareholders of the company they represented; and that the same were executed corruptly, for the personal ends of the signers of the same. The bill further alleges, that the Metropolitan, on or about November 1st, 1879, executed a mortgage on its line and property, second and subordinate to the mortgage referred to in the tripartite agreement, for the purpose of raising funds to complete and improve the unfinished lines, as provided in said agreement, such second mortgage being made to secure \$4,600,000 of bonds; that only \$2,000,000 thereof had been issued and negotiated at the time of said receivership; that now the Metropolitan

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has proposed to issue, the residue of the bonds provided for in said second mortgage, and to deliver them for negotiation to the Manhattan, and allow it to exercise and use the proceeds of the bonds. It also alleges that the Metropolitan, being now in the control of the directors who concurred in the execution of the modified agreement, is shaping its action so as to compel dissentient shareholders to acquiesce in the terms of said agreement, it having stamped as cancelled the guaranty printed on its stock certificates, and, upon a transfer of any certificate containing the guaranty, refusing to issue to the transferee a similar certificate, or any other than a certificate with the guaranty cancelled; that, in aid of this scheme, they, immediately after the execution of said agreement, closed the transfer books of the company; and that the acts and doings of the company, under the management of its present directors, are in hostility to the true interests of the shareholders, and planned in order, through the operation of the market and the customs of the Stock Exchange, to deprive dissentient shareholders of their just and equitable rights. The prayer of the bill is (1) for a decree that the two agreements dated October 22d are null and void and inoperative as against the plaintiffs: (2) that the Manhattan be perpetually enjoined from performing the same, so far as they change, or undertake to change, the terms of the tripartite agreement and the leases; (3) that the Metropolitan be enjoined, until the further order of the Court, from delivering any of its money or property to the Manhattan, or from issuing to it any of its mortgage bonds for negotiation, or from allowing it to receive the proceeds of any such bonds, or from changing the form of the stock certificates of the Metropolitan, in respect to the matters printed thereon, or doing any other acts which, in respect to the dealings in said shares, or the terms of the certificates, or their registration, shall modify, impair or embarrass any holders of the certificates having the said memorandum printed thereon; (4) that the Manhattan be enjoined from paying or transferring to the New York any moneys or choses in action under the agreement of October 22d, and from performing any part

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of the agreements of that date, so far as they change, or undertake to change, the terms of the tripartite agreement and the leases.

The bill is not signed or verified by any of the plaintiffs. It is signed by the plaintiffs' solicitors, and the affidavit of one of them is appended to it, to the effect that he has read the bill, that the facts therein stated are true to the best of his knowledge and belief, that the ownership by the plaintiffs of the shares of stock, as alleged, has been stated by them in petitions signed for the purpose of being admitted to the benefit of the suit of Gillett against the same defendants, and that the reason why such verification is not made by the plaintiffs is their absence from the State. Those petitions are not brought before this Court.

The two agreements of October 22d are signed by the New York by said Field, as president; by the Metropolitan by said Sage, as president; and by the Manhattan by R. M. Gallaway, as president.

The plaintiffs now move for a preliminary injunction to the purport prayed in the bill. The motion is supported and opposed by affidavits. The facts hereinbefore set forth are free from dispute. The bill is brought by the plaintiffs in their own behalf, and in behalf of all others, shareholders in the Metropolitan, similarly situated with the plaintiffs, who may come in and contribute to the expenses of this suit and consent to be bound by the decree herein. A holder of 50 shares of the stock, bought in February, 1881, makes oath that he bought them with a knowledge of, and in reliance on, the guarantee of the Manhattan, and knowing that he had an interest in the earnings of the Manhattan after the payment of the guarantee to the leased lines and dividends on the Manhattan stock. A holder of 148 shares of the stock bought in 1880, makes oath that the inducement to him to purchase it was the said guarantee and the positions of equality of the New York and the Metropolitan; and that the action of the directors of the Metropolitan, in reducing the dividend on said stock, was without his consent and is a great damage to

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him, and is illegal and void. These affidavits may be regarded, perhaps, as supplying the defect in the verification of the bill.

1. The principal ground urged in support of the motion is, that the agreements of October 22d impair vested rights of the stockholders of the Metropolitan; that each stockholder has for himself such vested rights; and that those rights cannot be impaired as to him without his consent. It is urged, that, after the Metropolitan lease was executed, there was no property left to it upon which anything in the nature of a dividend-paying stock could be based, except the revenue to be derived from the terms of the lease; that the value of the capital stock consisted wholly in such revenue; that the \$162,500 to be paid quarterly to the Metropolitan was the only profit which investors in the stock could hope to realize from their investment; that the stock is stock of a special character, entitled to an agreed portion of a rental to be paid by the Manhattan; that the agreement of the Manhattan is truly expressed in the memorandum on the certificates; that, by the whole transaction, the Metropolitan agrees to distribute such portion of the rental, as a dividend, among its stockholders; that the Metropolitan, therefore, cannot surrender the guaranty of the Manhattan; that such guaranty must be regarded as a promise to the Metropolitan for the benefit of its stockholders; and that they are entitled to prevent the Metropolitan from diverting the fund or impairing the contract out of which the right to it comes.

It is undoubtedly true that the object of the provisions of the lease in regard to the ten *per cent.* per annum on \$6,500,000, to be paid by the Manhattan to the Metropolitan, was to enable the stockholders of the Metropolitan to have, if possible, during the continuance of the lease, a quarterly dividend of 2½ *per cent.* on their stock. But I fail to see any contract to that effect between the Manhattan and the individual stockholders of the Metropolitan, or between such stockholders and the Metropolitan. The language of Article 2 of the lease is, that the Manhattan guarantees to the Metropolitan

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an annual dividend of 10 *per cent.* on the capital stock of the Metropolitan to the amount of \$6,500,000, "that is to say." The guaranty is to the Metropolitan, not to its stockholders severally. The Article then goes on to interpret the guaranty, and to show what it is, and at what times payments under it are to be made. It says, "that is to say," the Manhattan will, each and every year during the term, beginning with October 1st, 1879, pay to the Metropolitan \$650,000, free of all taxes, in equal quarterly payments of \$162,500 each, on the first days of January, April, July, and October, in each year, the first to be made January 1st, 1880. There is no agreement either by the Manhattan or by the Metropolitan that these sums shall be paid to the stockholders of the Metropolitan. Then there is the further provision that the Manhattan will, from time to time, execute in proper form a guaranty "to the above effect," printed or engraved on the certificates of stock of the Metropolitan, and, as such stock certificates are surrendered for cancellation and re-issue, will, from time to time, at the request of the holder, "renew such guaranty" upon all re-issued certificates. This was never done. The Manhattan never executed anything on the certificates. The Metropolitan issued the certificates with an unexecuted memorandum, which does not contain the word "guaranty," and contains no contract or agreement or guaranty of any kind, but only a statement that the Manhattan "has agreed to pay to the Metropolitan" an amount equal to 10 *per cent.* per annum on the capital stock of the Metropolitan, that is to say, on \$6,500,000, payable quarterly, commencing January 1st, 1880. This was the interpretation put at the time on the agreement of the Manhattan, by the Metropolitan, and accepted by each stockholder of the Metropolitan when he took his certificate. If any stockholder was entitled, on request to the Manhattan, to a guaranty of any kind executed by it on his certificate of stock, he waived his right to it. But, if he had asked for and received it, it would have been "a guaranty to the above effect," being a repetition of the agreement to make the quarterly payments to the Metropolitan, that is, an

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agreement to do what the memorandum states that the Manhattan had agreed to do. This would not have been any more of a contract between the Manhattan and the stockholder, or between the Metropolitan and the stockholder, than now exists.

2. The case, therefore, is not one of any vested right in the stockholders of the Metropolitan to the ten *per cent.* payments, but it depends on the general power of the directors of a corporation to make and modify its contracts. That power is well established in this State. (*Hoyt v. Thompson's Est.*, 19 *N. Y.*, 207, 216.) Nor can the stockholders control that power. (*McCullough v. Moss*, 5 *Denio*, 566, 575.) No statute or authority is referred to which makes it necessary to the validity of the agreements of October 22d that they should have been approved by any one or more stockholders.

3. The leases and the tripartite agreement and the agreements of October 22d were made under the authority of the Act of April 23d, 1839, (*Laws of New York*, 1839, chap. 218, p. 195,) which provides, that "it shall be lawful hereafter for any railroad corporation to contract with any other railroad corporation for the use of their respective roads, and thereafter to use the same in such manner as may be prescribed in such contract." There is nothing to impeach the validity of that statute. The instruments referred to are contracts by the Manhattan and the other two companies for the use by the former of the roads of the latter, on terms satisfactory to each of the latter, as determined by the votes of their Boards of Directors.

4. It is urged that the question should be considered as if the Metropolitan, on the failure of the Manhattan to fulfil its covenants in the lease, had re-entered, and, as if the question were as to a new lease with terms such as now obtain in the lease as modified. In this view the new lease is objected to as *ultra vires*, because it appropriates the revenues of the Metropolitan, as a part of the general funds of the Manhattan, to pay preferred dividends to the New York. The contention is, that the Manhattan is to receive all the earnings of the

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lines of the Metropolitan, and, after paying expenses, taxes, interest, &c., is to pay, first, a dividend of 6 *per cent.* on the stock of the New York; and that, as the earnings of the Metropolitan are not to be kept separate, no such arrangement can be made without the consent of the stockholders of the Metropolitan. The question is not one of power, but of good faith. If, in good faith, the discretion and judgment of the directors of the Metropolitan were fairly exercised, under the circumstances in which the affairs of the corporation were at the time, in view of all its embarrassments, and of the condition of the Manhattan, and of the litigations existing and threatened, and of the claims made against the Metropolitan and its stockholders, by the Manhattan and the stockholders of the Manhattan, and of the relative conditions of the two properties, and of the past and probable prospective earnings of the roads of the New York and the Metropolitan, no Court will undertake to interfere with the exercise of such discretion and judgment, even though, on the same facts, it might have arrived or may arrive at a different conclusion, and even though the stockholders of the Metropolitan might have arrived at a different conclusion. In this view the remarks cited from the decision of Judge Westbrook become of great importance. His views in regard to the claim of the Manhattan for the \$13,000,000 were calculated to have great weight, and it is shown they did have great weight, in regard to some of the terms of a new arrangement. The Manhattan had made two defaults in paying the dividend rentals, it had been put into the hands of receivers, it was alleged to be insolvent, and it was asserting the claims for the \$13,000,000. It was perfectly clear that the interests of the public demanded that the two elevated roads should be under one management, and the interests of the public were the interests of the two lessor companies. The state of things was such that the common manager must be the Manhattan. Therefore, its obligations to the other two companies must be modified, because they were too onerous to be fulfilled. The only question was as to the new obligations. The evidence satisfac-

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torily shows that the roads of the Metropolitan were not earning enough net money, over expenses, repairs and taxes, to pay the interest on its mortgage bonds, and that the New York was earning at least six *per cent.* net, and enough more to make reasonable the preferences given to it over the Metropolitan in the new arrangement. By that arrangement the claims of the Manhattan for the \$13,000,000 are released. But, whatever conclusion a judicial tribunal would come to now, on proofs, as to whether the new arrangement was a wise and proper one for the Metropolitan to make, it is sufficient to say, that, on the evidence now presented as to what was before the directors of the Metropolitan, and as to their action, they had a right to think, in good faith, that they were doing what was most judicious for their stockholders, and they did what they did in good faith.

5. It is contended that a fictitious necessity was created, and that the stockholders of the Manhattan would have come forward to extricate it from its difficulties. I see no evidence of this. The directors of the Metropolitan had this question before them, necessarily, and passed upon it, and acted in view of it.

6. It is alleged, in the bill, that Messrs. Sage and Gould, while acting as directors of the Metropolitan to make the new arrangement on its behalf, were large holders of the stock of the Manhattan company, and that Mr. Field was at the time a large shareholder in the Manhattan. The directors of the Metropolitan who voted to approve the agreement of October 22d, were Messrs. Sage, Gould, Connor, Sloan, Dillon, Navarro, Stout, Dodge and Porter. Mr. Garrison was absent. Mr. Kneeland voted in the negative. Leaving out Messrs. Sage, Gould and Connor, 6 of the 10 present voted in favor of the agreement. As to the supplemental agreement, there were 10 directors present, Mr. Sloan being absent. Mr. Stout did not vote. Of the 9 voting, Messrs. Sage, Gould, Dillon, Navarro, Connor, Dodge, Porter and Garrison voted to approve the supplemental agreement, and Mr. Kneeland voted in the negative. Leaving out Messrs. Sage, Gould

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and Connor, 5 of the 9 voting voted to approve the supplemental agreement. There were 11 directors in all. Nothing is alleged in impeachment of the positions of Messrs. Sloan, Dillon, Navarro, Garrison, Stout, Dodge or Porter. Therefore, whatever may be shown as to the positions of Messrs. Gould, Sage and Connor, the legal aspect of the transaction is not affected.

Mr. Gould was elected a director of the Metropolitan on July 9th, 1881. He states that at the time of making the settlement of October 22d, he had an interest of 2,500 shares in the Metropolitan, and of 5,000 shares in the New York, his cash investment for the two being \$710,354 21, while his actual cash investment in the Manhattan was \$599,031 25.

Mr. Sage states that at the time of the agreements of October 22d, he held about 1,200 shares of stock in the Metropolitan. He was appointed president of the Metropolitan in July, 1881. He says that at that time he had about 800 shares of Manhattan stock, but within a few days thereafter "was short" of Manhattan stock, and from that time until after the agreement of October 22d bought no stock of the Manhattan nor became interested in any, except for the purpose of fulfilling previous contracts; and that his pecuniary interest, if he "had any, during all that period, was to raise the price of Metropolitan stock and depress the price of Manhattan stock."

Mr. Field states that he sold out all his Manhattan stock, except 13 shares, in November, 1879, and sold those in March, 1880; and that he "never bought or became interested again in Manhattan stock until October, 1881," after he "became convinced that a compromise would be made." But he sustained no fiduciary relation to the stockholders of the Metropolitan.

7. The concurrent testimony is that the Manhattan is now entirely solvent, made so, it is true, by the new arrangement, but still solvent. It is out of the hands of the receivers. The tripartite agreement and the leases, except as modified, are in force, and are in force as modified. The mortgage

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bonds the issuing of which is sought to be restrained are to be issued, it appears, under the tripartite agreement and the leases, and pursuant to resolutions passed before the agreement of October 22d, and their proceeds are to be used in perfecting the structure and equipment of the Metropolitan, and in securing the safety of those who travel on the road.

The motion for an injunction is denied.

The bill in the Gillett suit is verified by the plaintiff therein. The motion for an injunction in that suit is denied and the restraining order is vacated.

S. P. Nash, for the plaintiff.

D. D. Field, for the defendants.

THE WESTERN ELECTRIC MANUFACTURING COMPANY

vs.

THE ANSONIA BRASS AND COPPER COMPANY. IN EQUITY.

The two re-issued letters patent, Nos. 6,954 and 6,955, granted February 29th, 1876, to the Western Electric Manufacturing Company, as assignee of Joseph Olmsted, each for an "improvement in insulating telegraph wires," being re-issues, in two divisions, (one for the process and the other for the product,) of a patent granted to said Olmsted July 23rd, 1872, are void for want of novelty.

The patented invention consisted in filling the pores of the covering of the wire with paraffine or wax and then compressing it and forcing the paraffine or wax into the pores, and was anticipated by a prior process of compressing bitumen into the pores of the covering of wire.

(Before SHIPMAN, J., Connecticut, December 21st, 1881.)

SHIPMAN, J. This is a bill in equity, founded upon the alleged infringement of two re-issued letters patent, granted

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to the plaintiffs, as assignee of Joseph Olmsted, each for an "improvement in insulating telegraphic wires," and dated February 29th, 1876, and respectively numbered 6,954 and 6,955, and being re-issues, in two divisions, (one for the process and the other for the product,) of a patent granted to said Olmsted on July 23d, 1872. The specifications of each re-issue are the same, and accurately describe the patented improvement upon the method which was then commonly used for insulating office wire. The entire descriptive part of the two specifications is in these words: "The method of insulating now in use consists in braiding over the wire a fibrous covering, after which it is dipped in wax, for the purpose of filling and closing its pores, and, after a subsequent scraping, to remove the surplus wax, it is ready for use. This method is, however, objectionable, inasmuch as it leaves the covering in a very rough and soft condition, and fails to secure perfect insulation. In my improved method, after the wire has received its coating, I dip it in paraffine or wax, after which, instead of scraping off the surplus coating, I pass the whole through a suitable machine, which compresses the covering, and forces the paraffine or wax into the pores, and secures perfect insulation. By so compressing the covering, the paraffine or wax is forced into the pores, and the surface becomes and appears polished. Wire insulated in this manner is entirely impervious to the atmosphere, of greater durability, and less cumbersome than any heretofore made." The claim of the process patent is for "the method of insulating telegraph wire, by first filling the pores of the covering, and subsequently compressing this covering, and thereby polishing its surface, substantially as described." The claim of the patent for the product is for "an insulated telegraph wire, the covering of which has its pores filled and its surface polished, substantially as described." The defect in the article coated with uncompressed paraffine was a leakage of electricity, which was probably owing to the shrinkage of the paraffine in the interstices of the fibrous covering while the melted paraffine was cooling. The paraffine, which was

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compressed while in a plastic state, was thereby forced into the interstices of the fibres, and the defect was obviated.

The defendants make and sell telegraph wire, which they say, in their answer, is "covered by braiding over the wire a fibrous covering, after which it is dipped in a preparation, for the purpose of filling and closing the pores; after which the same is sand-papered and rubbed and passes through revolving dies, for the purpose of scraping off the surplus material and consolidating and smoothening the surface of said remaining covering." They further admit that both paraffine and wax are component parts of the material which is used for insulating their wire.

I shall spend no time upon the question of infringement, which, I think, was clearly shown. The utility of the plaintiff's article was also proved.

The important question in the case is in regard to the patentability of the improvement, which consisted in compressing the plastic paraffine, by suitable machinery, after the fibrous covering and the paraffine had been applied. The mechanism for compressing was so well known that a description was unnecessary. The invention consisted in the discovery that compression of the plastic paraffine into the pores of the fibrous covering, by any well-known mechanical appliances, would be advantageous. It did not consist in the discovery that covering with paraffine or wax would be desirable, for, wire covered with braided fibrous covering and dipped in wax was in common use, but the invention simply related to the substitution, in place of a mere scraping off of the rough clots of wax, of a pressing operation, for forcing the insulating material into more intimate contact with the fibrous material; and, so far as the product is concerned, the invention related to a wire insulated and polished upon its surface, by means of compression of the waxed covering, as distinguished from the insulation and surface which was the result of non-compression of the same covering.

Dundonald's British patent of 1851, No. 13,698, declares that he employed "bituminous material to cover, and thus in-

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sulate, the conducting wires of electric telegraphs which are intended to be placed underground." He further says: "The incasement of this wire with bitumen may also be effected by covering it with a filamentous material, which has been previously saturated with melted bitumen, and then passing the wire so covered through a heated die or orifice, so as to melt or soften the bitumen upon the filamentous material, and press the whole of this coating against the wire, in such a way as to cause it to form one compact continuous covering of the wire, and thus insure its insulation." The same general process of compression is found in Baudouin's British patent, No. 933, of 1857, for electric conductors. The specification says: "The wire is passed through a bath of hot bitumen, and has the superfluous matter removed by passing through suitable dies or parts, to scrape and smooth its surface, and render it of uniform thickness. The first and second ribbons," (which are strips of material to be wound on the wire,) "are also passed through bituminous or other suitable matter, to render them more impervious to electricity. The coated and lapped wire is passed through suitable dies, to remove superfluous matter, to smooth down the lapping of the ribbons, and to compress and cause their proper adhesion." It thus appears, that the process of compression had been used, for some years before the date of Olmsted's patent, in the manufacture of electric telegraph wire previously covered with cloth, and then coated with bitumen or fatty substances, and, having been so used, there is no longer patentability in compressing the paraffine covering of a wire coated with fibrous material. The patented process "was simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent law." (*Brown v. Piper*, 91 U. S., 37.) The patentee took the process of Donald and of Baudouin, which they had applied to bitumen, and applied it to the wax covering which was in common use and had been found to be superior, for certain classes of wire,

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to any insulated covering which had been previously used or suggested. The old process was applied to the new use without substantial alteration or change. The process patent not stating a patentable invention, the product patent is in no better condition.

The bill is dismissed.

William W. Baldwin and *George P. Barton*, for the plaintiff.

William B. Wooster, for the defendant.

THE NEW YORK AND BALTIMORE COFFEE POLISHING COMPANY

vs.

THE NEW YORK COFFEE POLISHING COMPANY, LIMITED.
IN EQUITY.

A bill in equity will lie, under § 866 of the Revised Statutes, to obtain a direction that the testimony of a witness be taken *in perpetuam rei memoriam*, where the plaintiff alleges that he is using a process to the use of which the defendant claims an exclusive right under a patent, that the patent is void for want of novelty, that, in case the defendant sues the plaintiff for infringement of said patent, the plaintiff relies, for his defence, on the testimony of the witness, that the witness had made public use, in the United States, of the said process, for upwards of 12 years before said patent was issued, that said witness is upwards of 90 years of age, that the defendant does not sue the plaintiff for infringement, and that the plaintiff cannot bring his rights to a judicial determination.

(Before BENEDIOT, J., Eastern District of New York, December 27th, 1881.)

BENEDIOT, J. This case comes before the Court upon a demurrer to the bill. The bill is filed to obtain at the hands of this Court a direction that the testimony of a witness named William Newell may be taken *in perpetuam rei memoriam*. The provision of statute under which the bill is

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filed is found in § 866 of the Revised Statutes, where it is provided, that "any Circuit Court, upon application to it as a Court of Equity, may, according to the usages of Chancery, direct depositions to be taken *in perpetuum rei memoriam*, if they relate to any matters that may be cognizable in any Court of the United States." The allegations of the bill which are material on the present occasion are these—that the complainant has been and still is using, in the city of New York, a certain process, to the use of which the defendant claims the exclusive right under letters patent of the United States; that such letters patent are void for want of novelty; that, in case suit shall be brought by the defendant against the plaintiff, for infringement of the said patent, the plaintiff relies, for its defence, upon the testimony of William Newell; that said Newell had himself made public use, in the United States, of the said process, for upwards of twelve years before the said patent was issued; that said Newell is upwards of 90 years of age; that the defendant has neglected, and still neglects, to bring a suit against the plaintiff for its infringement of said patent; and that the plaintiff is unable to bring its rights to a judicial determination.

In support of the demurrer to this bill it is first contended that the proceeding is vain, because the deposition, if taken, will never be admissible in evidence in the suit which the complainants fear. This position is supposed to be sustained by the provision in § 867 of the Revised Statutes, that "any Court of the United States may, in its discretion, admit in evidence, in any cause before it, any deposition taken *in perpetuum rei memoriam*, which would be admissible in a Court of the State wherein such cause is pending, according to the laws thereof." But the effect of the provision last quoted is misunderstood by the defendant. The provision is intended to permit the Courts of the United States to admit in evidence testimony perpetuated according to the laws of the State, and in no wise relates to testimony perpetuated by direction of a Circuit Court of the United States, in pursuance of the statute of the United States under which this bill is

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filed. Testimony so perpetuated is admissible in evidence in accordance with the usages and practice of Courts of the United States, and by virtue of § 866, but not by virtue of § 867. The object of the bill is, therefore, legitimate, and the proceeding not vain.

The next ground taken in support of the demurrer is, that the bill does not show a necessity for perpetuating the testimony of the witness in order to preserve the plaintiff's rights, inasmuch as, upon the facts stated in the bill, it would be the duty of the Attorney General, upon the application of the plaintiff, to institute a proceeding, in the name of the United States, to annul the defendant's patent, in which proceeding the testimony of the witness Newell could be taken with like benefit to the plaintiff as if taken by direction of this Court, in this proceeding, or in a suit brought by the defendant against the plaintiff.

It may be admitted that, in cases of this description, the rule is not to sustain the bill if it be possible that the matter can, by the party who files the bill, be made the subject of immediate judicial investigation, (*Angell v. Angell*, 1 *Simons & Stuart*, 89;) but no opportunity to have such a judicial determination appears open to the plaintiff in this case.

Clearly, the proceeding by the Attorney General, supposed by the defendant to be possible, is not such an opportunity to bring the matter to a judicial determination as the rule requires. If it be assumed that the Attorney General has power to institute a proceeding in the name of the United States, to annul the defendant's patent for want of novelty—as to which see *Attorney General v. Rumford Chemical Works* (9 *Off. Gaz.*, 1062)—still it rests with the Attorney General, or the United States Attorney, and not with the plaintiff, to say whether such a proceeding shall be instituted, and, if so, where, and, when instituted, whether the testimony of the witness Newell shall form part of the testimony in such proceeding. The plaintiff is without power to compel the institution of such a proceeding, and it cannot be known that such a proceeding will ever be instituted.

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It is said that the presumption is that a public officer will do his duty, but such presumption does not warrant the conclusion that the Attorney General, or the United States Attorney, will, as of course, institute a proceeding to annul the defendant's patent, upon the plaintiff's application and assertion that the patent is void for want of novelty. There is no absolute duty imposed upon the Attorney General or any United States Attorney, either by the common law or by any statute, to institute a proceeding to annul a patent issued for an invention, when applied to by any party asserting its invalidity for want of novelty.

Besides, the right which the plaintiff asserts in this bill is the right to have the validity of the defendant's patent adjudicated upon a consideration of the testimony of the witness Newell, in regard to the fact asserted by the bill to be within the knowledge of that witness, and, if the plaintiff's application to the Attorney General for a proceeding to annul the defendant's patent would create a duty on the part of the Attorney General to institute such a proceeding, no duty to call Newell as a witness would arise. Such a proceeding would be wholly within the control of the Attorney General (*Mowry v. Whitney*, 14 Wall., 441;) and the most that can be said is, that it is possible that the plaintiff's right to the testimony of the witness could be preserved by a proceeding taken in the name of the United States, assuming, but not deciding, that the power to institute such a proceeding exists. Such a possibility affords no reason for refusing to entertain the bill under consideration.

There must be judgment for the plaintiff upon the demurrer, with leave to answer on payment of costs.

Richards & Heald, for the plaintiff.

Goodrich, Deady & Platt, for the defendant.

WILLIAM C. BARKER vs. JAMES D. SHOOTS. IN EQUITY.

Re-issued letters patent, No. 6,531, granted to William C. Barker, July 6th, 1875, for an "improvement in buckets for chain-pumps." are valid.

A contrary decision as to the validity of the patent arrived at from that reached in *Barker v. Stowe*, (15 *Blatchf. C. C. R.*, 49.)

The claims of said re-issue are infringed by buckets for chain-pumps constructed according to the description contained in letters patent No. 158,534, granted January 5th, 1875, to James D. Shoots.

(Before BLATCHFORD, J., Northern District of New York, January 4th, 1882.)

BLATCHFORD, J. This suit is brought on re-issued letters patent, No. 6,531, granted to the plaintiff, July 6th, 1875, for an "improvement in buckets for chain-pumps," the original letters patent having been issued to the plaintiff June 20th, 1871, and having been re-issued to him, May 19th, 1874. It is the same patent which was passed upon by this Court in *Barker v. Stowe*, (15 *Blatchf. C. C. R.*, 49.) The specification is set forth in the report of that case. The defendant in that case, Deloraine F. Stowe, had made and sold buckets for chain-pumps described in letters patent granted to him February 23d, 1875, for an "improvement in buckets for chain-pumps." It was held that he had infringed claims 1 and 2 of No. 6,531; but the bill was dismissed on the ground that both of those claims were anticipated by pump-buckets constructed by one Orin O. Witherell prior to the plaintiff's invention.

In respect to claim 1, Witherell, on his examination as a witness in that suit, introduced an Exhibit, A, as representing a form of bucket which he made and sold for 5 months, in the year 1866. It was said of that Exhibit, in the decision in that suit: "It has a thin india rubber disc placed loosely above a metal disc, and the edge of the rubber disc forms a flange, which extends downwards and embraces part of the depth of the metal disc. The rubber disc has a hole in the centre, through which a metal eye, fastened to the upper part of the metal disc, passes. He testifies, that the settling down

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of the chain, when the pumping was stopped, allowed the water above to escape through the hole in the centre of the rubber disc. * * * Witherell testifies that he put the buckets, like Exhibit A, particularly into worn pump-tubes, which had only the metal plate buckets; that, between April and August, 1866, he put buckets like Exhibit A into between 50 and 100 wells, mostly in the southeastern part of New Hampshire; that he saw one of such pumps in successful operation with them, as late as 1869; that he never used less than three of such buckets for a well, and seldom more of them; that he never knew any of them to freeze; that the back motion of the chain, after pumping was stopped, was sufficient, even when a ratchet was used, to open a central space between the rubber and the metal plate, the rubber adhering to the sides of the pump-tube, and allowing the water to escape down through the centre; that he used the buckets like Exhibit A for the purpose of fitting closely in the tube, so as to cause suction; and that he generally succeeded in establishing a suction, unless the tube was too much worn or defective. There is no testimony in contradiction of this, or throwing doubt upon the truth of the facts testified to by Witherell, or showing that buckets like Exhibit A would not operate as he testifies. Exhibit A shows an elastic bucket for a chain-pump, adapted to fit and work in the bore of a pump-tube, to raise water by suction, and provided with a suitable orifice or outlet through which the water remaining in the pump-tube, above the bucket, can escape down to the source of supply. * * * It appears to have been a successful, practical, working apparatus. If it was an elastic suction-bucket, with a drip, it is of no consequence whether Witherell devised it primarily with a view to the drip, or not. Nor is it of any consequence that the hole for the link served also as a drip-hole. If it allowed the water to escape, it would do so as effectually as the extra passage in the plaintiff's bucket. It may be, perhaps, that the plaintiff is entitled to some claim in respect to a drip-orifice in an elastic suction-bucket, but, in view of the Witherell Exhibit A, the first claim of the plaintiff's patent is too broad and is invalid."

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In respect to claim 2, Witherell introduced, in that case, another form of bucket made by him, Exhibit B. It was said of that Exhibit, in the decision in that suit: "He testifies that he made and sold buckets like Exhibit B, after he made them like Exhibit A, and from the fall of 1866 until the fall of 1873. Exhibit B has a rubber disc compressed between two metal plates by a screw and a nut. By lubricating with oil the iron washer on the lower face of the disc, the lower part of the disc was caused to expand more than the upper part, so as to give to the lower part a bearing edge, with the part above it receding from it inwards. Exhibit B shows such construction. He says that he never used less than three of Exhibit B for a set, and seldom more; that his practice was to have the bucket fit as closely as possible, and not have the pump work too hard; that the object of the bevelled edge was to have the rubber slide easily over any roughness in the tube; that the bucket operated both by lifting and suction; that, when the bucket fitted closely, it resisted the downward run of the chain; that he set them close enough, by expansion, to draw the water up readily, and yet leave room for the water to pass back on the inside of the tube; that the water in the tube, with Exhibit B, never froze, when the bucket was properly adjusted; that he made a considerable number with the bearing edge like Exhibit B; and that he used that form in tubes that were too large to be filled by expanding the disc equally from both of its faces. This Exhibit B is a solid elastic bucket, having an elastic-bearing edge, and its upper portion convex from said edge, whereby the bucket will readily yield to any irregularities in the pump-tube, and admit of its being easily drawn up, while, at the same time, it will resist moving downward. It answers exactly the second claim of the plaintiff's patent. A provision for the escape of the water is no part of the second claim, and the elastic-bearing edge is no part of the first claim. Although Exhibit A has no elastic-bearing edge it anticipates the first claim; and although Exhibit B has no water escape, it anticipates the second claim."

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The answer in the present case denies infringement and sets up that the buckets for chain-pumps which the defendant has made, used and sold are secured to him by letters patent granted to him, No. 158,534, dated January 5th, 1875. It also sets up want of novelty and alleges various anticipations. One of them is that of Witherell. It also alleges that the re-issue sued on contain matters of substance not embraced in the original patent.

In the Stowe case it was alleged that matter was found in the re-issue which was not in the original patent of 1871, but the Court said: "The drawings are identical, and there is nothing either in the specification or the claims of the re-issue which is not justified by what is found in the description or drawings of the original patent." Nothing is shown to change this view, and the original patent is not put in evidence in this suit.

The structure presented by the plaintiff as the infringement is known as "Lovell Exhibit 1." The same structure is represented by "Defendant's Exhibit 1." It has no drip-notch. It is constructed in accordance with the description in No. 158,534. It consists of a ringed bolt or eye bolt, which passes through an upper metal plate, the extension beyond such plate having a male screw-thread cut on it, and passing through an india rubber disc and into a female screw-thread cut in another and lower metal plate, to which a loop or eye or ring is affixed. The two parts are centred when screwed together. Each of the two plates is convex on its inner face, towards the rubber disc, and the disc is slightly concave on each of its opposite upper and lower faces. The disc can be expanded circumferentially in an outward direction, by screwing up the lower plate. The disc is solid. The lower part of its circumference, for a distance of perhaps an eighth of an inch upwards from the lower edge, is bevelled outwards very slightly, and then its outer face slopes upward and inward at an angle of some 50° to 60°, with its base to its upper concave face, such slope being, in superficial upward length, about half an inch. The claim of No. 158,534 is to a combination of all the parts making up the structure.

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Claims 1 and 2 of No. 6,531, are those which are alleged to have been infringed. They are as follows: "1. An elastic bucket for chain-pumps, adapted to fit and work in the bore of a pump-tube, to raise the water by suction, provided with a suitable orifice or outlet through which the water remaining in the pump-tube above the bucket is allowed to escape down to the source of supply, substantially as and for the purpose set forth. 2. A solid elastic bucket, having an elastic-bearing edge, and its upper portion convex or contracted from said edge, whereby the bucket will readily yield to any irregularities in the pump-tube, and admit of its being easily drawn up, while at the same time it will resist moving downwards, substantially as and for the purpose specified."

On the question of infringement the defendant testifies that his bucket raises water "by lifting and not by suction particularly;" that it works on the same principle as the old metallic bucket; that he always makes his buckets "to fit loosely in the tube;" that a $1\frac{1}{2}$ inch bucket of his can be expanded, by compressing the rubber between the plates, so as to fit a $1\frac{7}{8}$ inch tubing; and that, after pumping, with his bucket, the water runs back down the tube to the source of supply through the space around the bucket, because that fits loosely in the tubing and is smaller than the bore. It is contended for the defendant, that his bucket is not a solid elastic bucket, within the meaning of No. 6,531; that it does not assume the shape of a cone; and that it will operate equally well with either surface upward. The evidence is entirely satisfactory that the defendant's bucket infringes claim 2 of No. 6,531. It is a solid elastic bucket, and has an elastic-bearing edge, and has its upper portion convex or contracted from said edge, and thereby the bucket will readily yield to any irregularities in the pump-tube, and it can be easily drawn up while at the same time it will resist moving downward. The specification and claim of No. 158,534 show that the bucket is intended for use with the smaller surface of the rubber disc uppermost. The witness Riker shows that this is so. It also appears that the defendant's buckets sent out

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by him to be put in were put in so as to fit tightly in the tube and draw water by suction, and were put in with the smaller end of the rubber disc uppermost, and had drip-notches cut in them when set. If they fit tight and draw water by suction, the drip notch is a necessity, if there is danger of freezing. It must, therefore, be held that infringement of claim 1 also is shown.

The evidence of Witherell is not produced in this suit. In regard to Witherell's testimony in the former suit against Stowe, respecting structures anticipating claim 1 of No. 6,531, it was said in the decision in that suit, that there was in that suit no testimony contradicting Witherell, or throwing doubt on the truth of the facts testified to by him, or showing that a bucket like Exhibit A in that suit would not operate as Witherell testified it would. In the present suit, five witnesses have been examined on the part of the defendant, namely Waite, Bostwick, Smith, Wardwell and Reed, to show want of novelty in claims 1 and 2. The answer does not set up prior knowledge or use by any of them. But it is doubtful whether the record contains any objection on that ground to the testimony of any of them. Their evidence will, therefore, be considered.

The most that the evidence shows is the use, not in new pump-tubes, but in worn pump-tubes, of a flat, thin cylindrical disc of rubber, slipped over the loop of the chain and lying flat on the metal button, to compensate for the wear which had taken place in the tube by the rubbing of the metal button. The rubber discs were not used in a new cylindrical bore but only in bores which had become of oval or irregular shape, and which were worn more irregularly for a distance at the top and the bottom of their length than at the middle thereof. These discs were not the elastic bucket of claim 1 of No. 6,531, fitting so as to operate by suction. The cylindrical rubber disc could not fit any bore that was not cylindrical and could not operate by suction in a bore that was not cylindrical. It was as much of a lifting button as the metal button, and it could not operate by suction in the non-cylin-

dricul bore any more than the non-fitting metal button could in a bore either cylindrical or non-cylindrical. Of course, if these rubber discs did not fit the bore they did not have the drip-notch of claim 1 of the plaintiff. The evidence in the present case as to the prior structures is very different from that in the former case against Stowe. It now appears clearly that, in a wooden pump-tube, originally cylindrical, but worn by the use of cylindrical metal buttons on a chain, a cylindrical rubber disc will not operate by suction, and the water will escape back around the edge of the disc, because the wear is not uniformly annular, and if the rubber disc be cut non-cylindrical, but oval, to suit an oval wear, it will, in going up and down, cross the oval and become jammed.

The thin flat discs referred to are not the solid elastic bucket, with an elastic-bearing edge, and its upper portion convex or contracted from said edge, required by claim 2 of No. 6,531. Defendant's Exhibit No. 8 is the only approach towards such a structure, but it was used only experimentally.

The patent No. 19,173, granted to Marvin, January 19th, 1858, on the invention of Horton, does not show what is found in claims 1 and 2 of No. 6,531, and in the defendant's bucket. It has only leather and not india rubber or other similarly elastic material. This patent was not mentioned in the answer, and its introduction in evidence was objected to on that ground.

It is stated in the defendant's brief that the Witherell Exhibits in the former case against Stowe are, by stipulation, made evidence in this case. I find no such stipulation. The only stipulation I find in the record, on the subject, is one that the certified copies of United States letters patent made exhibits and filed in the former case against Stowe be used for this case. Moreover, plaintiff's exhibit 13 was offered in evidence by the plaintiff as a rubber disc of Witherell, (and it appears to be like what is above described to be Exhibit A of Witherell in the former case against Stowe), and its introduction was objected to by the defendant on the ground that at the stage of the case at which it was offered it was not rebut-

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ting evidence. This objection was valid. The defendant then went on to give notice that he would produce and read at the hearing the evidence of Witherell taken in the former suit against Stowe, and the exhibits. To this the plaintiff entered an objection, on the ground that the matter was irrelevant and could not, under any circumstances, form any part of the record in this suit. This objection was valid. Moreover, the said evidence of Witherell has not been produced by either party; and so Exhibit No. 13 has no place in this case, as evidence of a prior structure.

It is proper to say that, on objections taken by the defendant and appearing on the record, and insisted on him at the hearing, I have rejected the following parts of the testimony for the plaintiff: the question at page 12, folio 17, "Q. Has not," &c., and the answer; Exhibit 10 of plaintiff; Exhibit 11 of plaintiff; and the evidence as to the contents of a license from the plaintiff to the defendant and one Colwell.

There must be the usual decree for the plaintiff.

George E. Buckley, for the plaintiff.

Walter L. Dailey, for the defendant.

WILLIAM C. BARKER

vs.

DELORAINE F. STOWE. IN EQUITY.

B. sued S., in this Court, in equity, for the infringement of a patent. On an issue as to novelty the Court decided in favor of S., and held that the bill must be dismissed. Afterwards B. sued S. again, in this Court, in equity, for the infringement of the same patent. S., in his answer, set up, as an estoppel, the former suit. No decree had in fact been entered in it. Proofs were taken in the second suit, in which it was assumed by both parties that there had

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been a decree in the first suit. At the hearing of the second suit B. objected that there had been no decree in the first suit. The Court, on the motion of S., then signed and entered a decree in the first suit, and allowed it to be put in evidence on the part of S., in the second suit, and held that it was a bar to the second suit.

(Before BLATCHFORD, J., Northern District of New York, January 4th, 1882.)

BLATCHFORD, J. This suit is brought on the same re-issued letters patent, No. 6,531, involved in *Barker v. Shoots*, (*ante*, p. 178,) decided herewith. The defendant in this suit is the same person who was defendant in the suit of *Barker v. Stowe*, (15 *Blatchf. C. C. R.*, 49,) brought on the same patent. By stipulation the testimony in the suit against Shoots and in this suit was taken simultaneously, and it is all of it entitled in both cases, and it is stipulated that the evidence in one case "shall be good for both." The decision in the case against Shoots disposes of all questions in this case except that of infringement and a question as to the former suit against Stowe.

The answer sets up that the defendant's buckets are secured to him by letters patent granted to him, No. 160,125, dated February 23d, 1875. The defendant's bucket in the present case, "Lovell Exhibit No. 2," is precisely like the one described in the decision in the former suit against him as the one alleged there to infringe. It is clearly an infringement of claims 1 and 2 of No. 6,531.

The answer sets up that in 1876 the plaintiff filed a bill in this Court setting up the same matters and cause of action as are contained in this bill; that the defendant appeared, on process, and answered the bill, setting up the same matters previously set up in this answer; that a replication was put in; that evidence was thereafter taken in said suit; that the cause was heard on the merits, on pleadings and proofs, at the June Term, 1878; that, in July, 1878, the Court made a decision, determining that the said patent, No. 6,531, was void for want of novelty and that the bill be dismissed, with costs; that the defendant refers to said bill, answer, replication, decision, decree and judgment record in said former

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suit; that said Court had jurisdiction of said cause, the parties thereto and the subject-matter thereof; that said judgment and decree are valid and remain in force; that the right of the plaintiff to the relief sought in that cause was duly passed upon and adjudicated; and that the plaintiff is estopped by said former judgment and decree from asserting the same in this cause. This answer was verified March 27th, 1880. The record of the defendant's testimony, under date of November 24th, 1880, contains an entry that the defendant offers in evidence a certified copy of a decree in said suit against him, and also the opinion of the Court in said suit, marked defendant's Exhibit 5; and that the plaintiff objected to the same as immaterial, and because the proofs on which the decision and opinion were based were not introduced. The same record, under date of February 19th, 1881, states that it is agreed between the respective attorneys "that all documentary evidence heretofore offered in evidence, that is properly certified to, shall be admitted in evidence without objection." The record of the plaintiff's testimony, under date of March 22d, 1881, contains an entry that the defendant's counsel gives notice that he will read and produce on the hearing of this case the judgment roll, decision and decree in the said former suit against the defendant, and also the evidence of Orin O. Witherell, taken in said suit, filed with the clerk, and also all of the exhibits used on said trial; and that the plaintiff's counsel objected for the reasons before stated under date of November 24th, 1880, and because the matter is irrelevant. This cause was brought to a hearing at the June Term, 1881. It then appeared that nothing had been produced and marked defendant's Exhibit 5, and that no decree had ever been signed or entered in the former suit. The present suit was begun in November, 1879. The bill does not refer to the former suit. It alleges infringement in the past generally. When it was filed there had been no decree entered in the former suit. The proof of infringement made in this case is of an infringement on October 6th, 1879. The plaintiff, in giving testimony as a witness in this case, on the 11th of June, 1880, testifies

that he heretofore brought a suit in this Court against this defendant, and that the case was dismissed on the evidence of O. O. Witherell. This evidence, when given, was duly objected to by the defendant's counsel, on the ground that the fact must be proved by the record, and that the decision in the case could not be proved by parol, accompanied by the statement that the defendant's counsel offers to produce the decision, and followed by the statement that the counsel for the plaintiff will produce "the original of said records on which said bill was dismissed." Nothing of that kind was done by either party.

This case, though argued orally at the June Term, 1881, awaited the submission of printed briefs by the respective counsel. The plaintiff's brief was submitted to the defendant's counsel in July, 1881. It took the ground that no decree had ever been entered in the former suit; that there was no judgment or decree therein against the plaintiff when he commenced this suit, and none since; that no part of the record in the former suit had been put in evidence, nor had a copy of the decision rendered in the former suit been produced in this suit; that the defendant must, therefore, be regarded as having abandoned the matter; and that, in the absence of a decree and a judgment, the former suit could be no bar. Thereupon the defendant gave notice to the plaintiff of an application to the Court to sign and enter a decree in the former suit. The decision in the former suit, as found in 15 *Blatchf. C. C. R.*, 49, was filed in the clerk's office July 11th, 1878. The said application was made on an affidavit made by the defendant's solicitor in that suit, the same person who is the defendant's solicitor and counsel in this suit, setting forth that he was not familiar with the practice in such a case; that, after such decision had been filed, he supposed, and was so informed by Mr. Wright, an experienced practitioner in this Court that the clerk would enter the final decree on the filing of the decision and entering the order dismissing the bill, and that the costs could be taxed at any time and inserted in the judgment; that he supposed the decree had been entered when

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this suit was brought; that, on the 3d of August, after receiving the plaintiff's brief, he went to the clerk's office at Utica, and learned that no formal final decree had been entered; and that he then prepared a decree to be signed. The said application was made and was opposed by the plaintiff. The Judge who decided the former case granted the application and signed a decree. It sets forth that the cause was heard on the pleadings and proofs at the June Term, 1878; that the decision of the Court was made and filed July 11th, 1878, "whereby it was decided that the claim in the re-issued letters patent No. 6,531, granted to the plaintiff, had been anticipated, and that the bill of complaint herein be dismissed, with costs;" and it then orders, adjudges, and decrees "that the bill of complaint be and the same is hereby dismissed, and that said defendant recover from the plaintiff the costs of this action, when taxed and adjusted by the clerk of this Court, and that defendant have execution therefor." This decree was entered and enrolled August 27th, 1881, the roll consisting of the bill, answer, replication and decree. Meantime, the defendant's counsel had submitted his printed brief in this case, asking in it that a decision in this case be withheld until the decree in the former suit could be perfected and become a part of the evidence in this case. The plaintiff's brief in reply was put in, and suggested that the defendant had stated that he should not get a copy of the record in the former suit to file as an exhibit, because he had spent as much money as he was going to spend in the matter. A certified copy of the enrolled decree was sent to me, but I informed the defendant's solicitor that he must apply, on notice to the plaintiff, for leave to have it considered as evidence. The decision of the case was delayed to allow such application to be made. It was made at the October Term, 1881, on notice, and was opposed by the plaintiff. The form of it was a motion for an order opening the case, and for leave to put in in this suit the certified copy of the judgment record and decree in the former suit. The costs had been taxed at \$202 35. The defendant, in an affidavit for the motion, denied that he ever stated that

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he would not incur the expense of procuring a copy of the decree in the former suit, and that he believed, until informed to the contrary by his attorney, that the decree had been in fact entered, and would be a bar to this suit, and that he was at all times willing to incur the expense of entering the same and procuring a certified copy of it as evidence in this cause. The motion was also based on the said affidavit of the defendant's solicitor, used on the motion to have the decree signed. Many affidavits on both sides have, since the October Term, been furnished to me, directed to the question as to whether the defendant had said that he would spend no more money in defending the suit, leaving the common defence to be carried on by the defendant in the Shoots case, and as to whether he had intentionally refrained from having the decree in the former suit entered. It seems strange that the decree was not entered. Yet, the answer of the defendant, sworn to by him in March, 1880, and signed by his solicitor, not only speaks of a decision in the former case dismissing the bill therein, but refers to the decree and judgment record therein as having been made, and as existing, and as being an estoppel in this suit. In view of this the plaintiff went on to take proofs in this suit; and, in the plaintiff's opening proofs, in June, 1880, the former suit was mentioned by him, as a witness, as a suit which had been dismissed, and his counsel then and there gave notice on the record that he would produce the original of the records on which the bill in that suit had been dismissed. Afterwards, when, in the defendant's proofs, the entry was made that a certified copy of a decree in the former suit, and of the opinion of the Judge therein, marked defendant's Exhibit 5, was offered in evidence by the defendant, (though no such papers were then produced or marked,) the plaintiff did not object to the making of the entry because nothing was produced, and did not allege that there was no decree, but objected because the proofs were not offered upon which the decision had been based. Afterwards, when, in the plaintiff's proofs, the defendant gave notice that he would read and produce on the hearing the judgment roll,

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decision and decree in the former suit, the plaintiff objected on various grounds, but did not state that there was no such decree. It seems, therefore, entirely reasonable that the case should be opened so far as to allow the certified copy of the enrolled decree in the former suit to be put in evidence by the defendant, and become a part of the proofs herein. The plaintiff's counsel suggests that there was no decree against the plaintiff in the former suit, when this suit was brought, and that the decision filed amounted to nothing. In *Silsby v. Foote*, (20 *Howard*, 290, 295,) the Supreme Court held that the pronouncing of a decision by a Circuit Court, and its entry in the minutes, where the judgment or decree is a simple one, "such as an affirmance or reversal and the like," constitutes a decree from which an appeal may be taken to that Court. Here, the decision in the former suit was a dismissal of the bill. The decree signed in the former suit states that that was the decision, and that it was made and filed July 11th, 1878.

The decree in the former suit must be regarded as having the date of July 11th, 1878; and the question is, as to whether it is a bar to this suit. It is properly set up in the answer. The suit was between the same parties, and founded on infringement of the same patent. The bill in the former suit asks for profits and damages from the date of the re-issue, and for treble damages, and for a perpetual injunction. The bill in the present suit makes the same allegations and asks the same relief. The issue of the inability of the plaintiff to recover in the suit because the invention claimed had been anticipated, was tendered by the answer in the former suit, and was found in favor of the defendant, as appears by the decree. That issue cannot be again tried between the parties. If, in the former suit, that issue had been found in favor of the plaintiff, it could not have been again tried in this suit; and in this suit nothing would have been open but the question of infringement, if the bucket claimed to infringe were different from the infringing bucket in the former suit. Within the principles laid down in *Cromwell v.*

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County of Sac, (4 *Otto*, 351,) and applied by this Court in *Smith v. Town of Ontario*, (18 *Blatchf. C. C. R.*, 454,) it must be held that this suit is barred by the decree in the former suit.

A decree will be entered granting the defendant's motion and dismissing the bill, with costs.

George E. Buckley, for the plaintiff.

Walter L. Dailey, for the defendant.

THE NEW HAVEN STEAM MILL COMPANY

vs.

THE SECURITY INSURANCE COMPANY.

A valued marine policy of insurance insured a vessel for one year. In the printed part of the policy there was a warranty by the assured not to use certain specified ports and places, and certain waters, and, among them, the West India Islands during certain months, and ports and places in Texas, except Galveston, and foreign ports and places in the Gulf of Mexico and any of the West India salt islands, and not to load more than her registered tonnage with heavy cargo or grain on any one passage. On the margin of the face of the policy, written at a right angle to the printed lines, were these words: "To be employed in the Coasting Trade, on the United States Atlantic Coast," in one line. Underneath that line, and in one line parallel with it, were these written words: "Permitted to carry Grain and heavy cargoes, over tonnage on coastwise voyages, and to use Gulf Ports not west of New Orleans." The vessel was wrecked by running on shore at a place west of New Orleans, while on a voyage from Maine to a port in the Gulf of Mexico west of New Orleans: *Held*,

- (1.) That the use of Gulf ports in the United States not west of New Orleans was not forbidden by the printed clauses, and the use of them was not allowed by the written words, "the Coasting Trade, on the United States Atlantic Coast;"
- (2.) That the policy permitted the employment of the vessel in the coasting trade on the United States Atlantic Coast proper, excluding the Gulf, but with the added permission, that she might use ports in the Gulf not west of

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New Orleans, and might enter the Gulf for the purpose of proceeding to such ports, with a view to use them;

(3.) That the loss was not covered by the policy.

(Before BLATCHFORD, J., Connecticut, January 6th, 1882.)

BLATCHFORD, J. This is a libel in Admiralty, filed in the District Court, to recover \$3,000, the sum insured by a valued marine policy of insurance issued by the respondent to the libellant, insuring the schooner Tannhauser, for one year from January 28th, 1880. The policy is a printed form, filled up with writing and containing additional written clauses. It contains the following clauses wholly in print: "Warranted by the assured not to use ports on the Continent of Europe north of Hamburg, nor the Mediterranean east of the Ionian Islands, during the period insured; nor ports on the Continent of Europe north of Antwerp, between 1st November and 1st March; nor ports in the British North American Provinces, except between the 15th day of May and 15th day of August; also warranted not to use the West India Islands during the months of August and September; also warranted not to use ports and places in Texas, except Galveston, nor foreign ports and places in the Gulf of Mexico, nor places on or over Ocracoke Bar; nor any of the West India Salt Islands; nor ports or places on the West Coast of America north of Benicia, nor to use the Min River, nor Torres Straits, during the period insured." "Also warranted not to load more than her registered tonnage with lead, marble, coal, slate, copper ore, salt, stone, bricks, grain or iron, either or all, on any one passage." On the margin of the face of the policy, written at a right angle to the printed lines, are these words: "To be employed in the Coasting Trade, on the United States Atlantic Coast," in one line. Underneath that line, and in one line parallel with it, are these written words: "Permitted to carry Grain and heavy cargoes, over tonnage on coastwise voyages, and to use Gulf Ports not west of New Orleans." The libel claims for a total loss of the vessel by the perils of the seas while on a coastwise voyage within the

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policy. The answer denies that the voyage was within the policy, and avers that at the time of the loss the vessel was not on a voyage within the terms of the policy, but was by the voluntary act of her master and owners on a voyage to a port in the Gulf of Mexico west of New Orleans, to wit, the port of Morgan City, State of Louisiana, and not upon any voyage protected by the terms of the policy, and at the time of her destruction was upon that part of her voyage to Morgan City which was west of the port of New Orleans, and so known to her master, and she stranded on the shore of the Gulf of Mexico, west of the port of New Orleans, because her master mistook, in taking his course to the port of Morgan City, the light on Timbalier Island for the Ship Shoal Light, both of which lights were west of the port of New Orleans. The proof in the case consists entirely of the following written stipulation, entitled in the suit, and signed by the proctors for the respective parties, while the suit was pending in the District Court, and of the documents referred to in the stipulation: "We hereby mutually stipulate and agree that the following are the facts applicable to the issues presented by the pleadings in the above entitled cause, and consent that this stipulation and the statement of facts forming part thereof shall be entered and filed as the finding of the Court as to the facts in said cause. On the fourth of February, A. D. 1880, the Security Insurance Company, acting within the scope of its corporate capacity, executed and delivered to the New Haven Steam Saw Mill Company, the valued policy of insurance for \$3,000 upon said Saw Mill Company's interest in the schooner Tannhauser, a copy of which policy is annexed to the libel in said cause, and marked Exhibit A, and said policy is itself referred to and made part of this agreement and finding, a verbatim copy of which is appended and marked A. On the eleventh of June, 1880, the said schooner Tannhauser, while on a voyage from the port of Rockland, in the State of Maine, to Morgan City, known on the United States' coast survey map of 1870 as Brashear, in the State of Louisiana, went ashore, and was wrecked, on a

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reef in the Gulf of Mexico, west of the port of New Orleans, and was totally destroyed by the perils of the seas. That the statement set forth in the proofs of loss filed with said Insurance Company, and being the marine protest of the master and crew of said vessel, are true so far as any issue in this cause is concerned, and said protest and the statement therein contained are hereby made part and parcel of this stipulation and finding, and annexed hereto, marked Exhibit B. It is hereby mutually agreed that maps or charts may be referred to for the purpose of defining and determining the location of the spot where said vessel was lost, and of any place or locality referred to in said policy or proof of loss. That proper proofs of loss were filed with the Insurance Company in due season, and that the libellant is entitled to recover upon said policy the amount insured thereby, (less the note of \$301, given for the premium on said policy,) with interest from the

day of unless the law is so that upon the facts set forth in this finding, said libellant is not entitled to recover, in which case judgment is to be entered for said respondent." The protest states that the vessel left Rockland on May 17th, with a cargo of ice, bound for the port of Morgan City, Louisiana; that, for two days before June 11th, they had not been able to take an observation, on account of cloudy and hazy weather; that, during the evening of the 11th, they sighted a light which they took for Ship Shoal Light, and kept on their course accordingly, but at 10.30 o'clock P.M. the vessel suddenly took the ground; that they immediately let go an anchor, but the vessel soon began to leak, and the ice to melt from contact with the Gulf water, and in a short time she had filled and rolled over, so that pumping was useless; that the next day they discovered that the light they saw the evening before was not Ship Shoal Light but the light on Timbalier Island, and that the vessel was ashore on a reef about two miles from Vine Island, and about fifteen miles from Timbalier Island; and that the vessel is a total loss.

The District Court dismissed the libel. It appears from the decision of that Court, that the libellant there contended

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that "the coasting trade on the United States' Atlantic Coast" meant trade from Maine to Texas; that the written permission to use ports in the Gulf of Mexico not west of New Orleans, meant, in view of the printed restriction against using foreign ports in that Gulf, a permission to use foreign ports in that Gulf not west of New Orleans; that, if the vessel was prohibited from using any Gulf ports west of New Orleans, she was not using any such port at the time of the disaster; and that an intent to use a prohibited port did not avoid the policy. The Court held that the meaning of the two written clauses in the policy was that the vessel was to be employed on the United States' Atlantic Coast, which was the coast of the Atlantic Ocean and not the coast of the Gulf of Mexico, but that, if necessity or occasion required, she was to be permitted to go into the Gulf of Mexico and use the ports not west of New Orleans, but not that her coasting trade was to be thereby extended through the Gulf; and that, when she was engaged in transporting a cargo from Maine to Morgan City, she was not in the Atlantic coasting trade but upon a voyage outside of the terms of the contract. The view of the Court was, that if the coasting trade was to be through the Gulf, the permission to use ports in the Gulf was unnecessary; that if the coasting trade upon the United States' Atlantic Coast necessarily implied voyages through the Gulf, a permit to use any Gulf ports not west of New Orleans was unnecessary, as those United States' Gulf ports had not been excluded in the printed part of the policy; that the fact that the vessel was to be a coaster on the United States' Atlantic Coast, coupled with a permit to use certain ports in the Gulf, indicated that without the permit the vessel could not go into the Gulf; and that the permit apparently enlarged the previous limitation, especially as domestic ports not west of New Orleans had never been excluded.

The case for the libellant is argued in this Court upon grounds apparently not urged in the Court below. There are in the printed clauses of the policy many warranties, above cited, by the assured, not to use (1) certain ports and places;

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(2) certain waters. There are also printed warranties, above cited, by it, against loading more than the registered tonnage of the vessel with heavy cargoes, including grain. The printed form is a blank for a purely time policy, under which the vessel would have a right to go anywhere except as prohibited by the warranties not to use the ports, places and waters specified as forbidden. Then, on the margin, are the two written lines, which control. The first line relates to voyages. It purports to specify voyages. It is enabling and permissive. It declares that the vessel "is to be employed in the coasting trade on the United States' Atlantic Coast." It is an affirmative statement of voyages. It means that the vessel is to be employed in those voyages only. Both parties so declare. This, in connection with the time clause, one year, makes the policy a mixed policy, specifying both time and voyages. Then follows the second written line. It is a permission. It begins with the word "Permitted." That word qualifies the entire line. Naturally, we should expect to find in such permission something permitted which was not permitted by the preceding printed and written clauses, whether something merely not before permitted or something before actually prohibited. Accordingly, the first thing permitted is a permission "to carry grain and heavy cargoes, over tonnage on coastwise voyages." This had before been prohibited in the clause above cited from the printed clauses. Then follows, in the same sentence, under the word "Permitted" and after a comma, the words "and to use Gulf Ports not west of New Orleans." The word "and" is a copulative. It makes of the second branch of the sentence a permission, and that branch is to be read as if the "permitted" were inserted between "and" and "to." The use of Gulf ports in the United States not west of New Orleans had not been prohibited by the printed clauses. But then came in the first written line declaring affirmatively what the voyages shall be. As the use of Gulf ports in the United States not west of New Orleans was not forbidden by the printed clauses, the special permission, in the second written line, to use them, was wholly useless, if the use

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of them was allowed by the words in the first written line, "the coasting trade on the United States' Atlantic Coast." These last words must be construed as not including voyages to Gulf ports not west of New Orleans, in order to make the two sentences symmetrical.

For the purpose of supporting the view that "the coasting trade on the United States' Atlantic Coast" includes coasting trade in the Gulf up to the line of Mexico, and that the vessel was on a voyage in such trade, the advocate for the libellant contends, in this Court, that the words "and to use Gulf Ports not west of New Orleans" are to be read as if they were "and not to use Gulf Ports west of New Orleans," so as to make of it a warranty not to use ports west of New Orleans, and a warranty not broken, because no such port was used, while the voyage was a lawful one because in a permitted coasting trade. This is ingenious but not sound. "Permitted not to use" is not a form of expression that any person of intelligence would use. There are two permissions in the sentence. One is to carry something; the other is to use something. The right to carry the thing so permitted was prohibited but for the permission. The right to use the thing so permitted was not within the coasting trade allowed, but for the permission. Both of the written lines, in regard to voyages, refer to the subject-matter of the insurance. If the vessel, when lost, was not employed in the coasting trade on the United States' Atlantic Coast, and was not availing herself of the permission to use a Gulf port not west of New Orleans, the risk was not covered by the policy.

The voyage clauses must be held to mean that the vessel was to be employed in the coasting trade on the United States' Atlantic Coast proper, excluding the Gulf, but with the added permission, that she might use ports in the Gulf not west of New Orleans, and might enter the Gulf for the purpose of proceeding to such ports, with a view to use them. A voyage in the Gulf west of New Orleans, with a view to proceed to and to use a United States' Gulf port west of New Orleans, and a loss west of New Orleans, on such voyage,

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was not a risk within the permitted voyages of the policy. There was no way, under the policy, by which the vessel could enter the Gulf, consistently with the first written line, except by the permission in the second written line, and that permission gave her no right to be west of New Orleans on a voyage to Morgan City. There is a clear intention manifested and expressed by the words of the policy, of not insuring against the perils of a coasting trade on the Gulf Coast west of New Orleans, or against the perils of trying to enter a United States' Gulf port west of New Orleans.

The case of *Snow v. Columbian Ins. Co.*, (48 N. Y., 624,) was the case of a purely time policy, not prescribing any voyages or trade, and having warranties against using certain ports, places and waters. One of them was a warranty not to use ports in the British North American Provinces except between certain days. The vessel, at a time not between those days, sailed for a port in a British North American Province and was lost on the coast of that Province about 50 miles from that port, at a time not between those days. It was held that the insurer was liable, as there had been no use of the forbidden port. The decision was put on the ground that the vessel had a right to be in the waters where she was. In the present case, on a proper construction of the policy, the vessel was sailing in forbidden waters.

The case of *Palmer v. Warren Ins. Co.*, (1 Story, 360,) was the case of an exception or exclusion of what would otherwise have been included in the general terms of the policy. It differed from the present case. Moreover, the policy was purely a time policy, with no designation of prescribed or permitted voyages or trade.

The libel is dismissed, with the costs of the respondent in the District Court, taxed at \$20, and costs to the respondent in this Court.

H. Stoddard, L. H. Bristol and C. R. Ingersoll, for the libellant.

J. W. Alling, for the respondent.

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JONATHAN DWIGHT AND OTHERS

vs.

THE CENTRAL VERMONT RAILROAD COMPANY AND OTHERS.
IN EQUITY.

A plea to a bill in equity, that there are divers and sundry persons whose names are known to and ascertainable by the plaintiffs and not by the defendant, not setting forth any names, and not accompanied by an answer, but accompanied by a demurrer for want of parties, is not a good plea.

Stockholders in a railroad company filed a bill against the directors of that company, alleging a refusal of the directors to take legal measures to protect their rights, and against the party in possession of the road of that company, and the lessee of it, and persons claiming liens on it, to recover possession of the road for said company. To this bill a plea was filed alleging that the company had brought a like suit in a Court of the State and had discontinued it, through its directors, by preconcert with the plaintiffs, that this suit might be brought to evade the proper jurisdiction of the State Court, and denying any breach of trust by the directors: *Held*, that the plea was bad.

Another plea was filed to the bill, alleging that the plaintiffs did not, before bringing the bill, in good faith request the directors to take legal measures to protect their rights, but by arrangement between the plaintiffs and the directors a simulated request and refusal were made, and this suit was brought by the company in the name of the plaintiffs, and denying that there had been any such refusal by the directors as amounted to a breach of trust: *Held*, that the plea was bad.

Another plea was filed to the bill, alleging that security holders of the same class as those made defendants had brought proceedings in behalf of themselves and all others like security holders, against the company, in a Court of the State, to enforce their security on the road, in which a decision favorable to the validity of their lien had been made, and which were pending, and setting forth the proceedings: *Held*, that the plea was bad.

Another plea was filed to the bill, by the party in possession of the road, alleging that it was in possession as a receiver of a Court of the State and setting forth the proceedings on which its possession took place: *Held*, that the plea must be overruled, and the case proceed to proofs.

(Before WHEELER, J., Vermont, January 14th, 1882.)

WHEELER, J. The orators, as stockholders to a large amount in the Vermont and Canada Railroad Company, and

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citizens of New York, New Hampshire, and Rhode Island, bring this bill in behalf of themselves and all other stockholders having like interests with them, not citizens of Vermont, Massachusetts, or Maine, against the directors of that corporation, citizens of Massachusetts and Pennsylvania, alleging that they refuse to take legal measures to protect the rights of the orators, and against the Central Vermont Railroad Company in possession, and the Vermont Central Railroad Company lessee of, and the other defendants security holders claiming liens upon, the Vermont and Canada Railroad, all citizens of Vermont, Massachusetts, and Maine, to recover the possession of that road for the Vermont and Canada Railroad Company.

The Central Vermont Railroad Company pleads that it is in possession as a receiver of the Court of Chancery of Franklin County and of the State of Vermont, and the proceedings upon which its possession took place are set forth.

John Gregory Smith pleads that security holders of the same class as those made defendants have brought proceedings in behalf of themselves and all other like security holders, against the Vermont and Canada Railroad Company, in the same Court of Chancery, to establish and enforce their security upon this road, in which a decision favorable to the validity of their lien has been made by the Supreme Court of the State, and which are now pending in the Court of Chancery, to ascertain the amounts of, and facts concerning, the different classes of securities; and these proceedings are set forth.

Worthington C. Smith pleads that the Vermont and Canada Railroad Company brought a suit like this, and for the same relief, in the same Court of Chancery, and, through its directors, by pre-concert with the orators, discontinued the same, that this suit might be brought to evade the proper jurisdiction of the State Court, and confer a seeming but unreal jurisdiction upon this Court, in pursuance of which this suit was brought; and denying that the directors have vio-

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lated their duty, committed any breach of trust, or done otherwise than as requested by the orators.

Jed P. Clark pleads that the orators did not, before bringing this bill, in good faith, request the directors to take legal measures to protect their rights, but that, by the planning, suggestion and request of the directors, and concert and arrangement made between them and the orators, for the sake of escaping from the jurisdiction of the State Court, to which the jurisdiction of right belonged, and to confer upon this Court a seeming jurisdiction, not real or of right, a simulated and unreal pretence of request and refusal were made, and that this suit is prosecuted by the Vermont and Canada Railroad Company in the name of the orators, for the common benefit of them all, and denying that there has been any such refusal by the directors as amounts, in legal effect, to a breach of trust.

The Vermont Central Railroad Company sets out, by plea, that there were, when this bill was brought, and are now, divers and sundry stockholders of the Vermont and Canada Railroad Company, citizens of Vermont, Massachusetts, and Maine, whose names are known to and ascertainable by the orators and not by the defendant, and demurs to the bill for want of the necessary parties.

None of these pleas is supported by answer. All of them and the demurrer have been argued. They may properly be considered in the inverse order of their statement.

The last one, that of the Vermont Central Railroad Company, is not in the proper form and sufficient, even if the fact that there were stockholders citizens of Vermont, Massachusetts, or Maine, and not invited to take part in the prosecution of the suit, would defeat it. In such cases the defendant should, at law, give the plaintiff a better writ, by setting out the name and identifying the party whose existence is alleged to create a fatal non-joinder, so that the plaintiff may traverse the allegation and form a definite issue to be tried, or discontinue and bring a new suit, joining the proper parties, upon the information given. The rules of pleading are the same

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in equity as at law, unless the reasons of them are varied by the different methods of procedure. There is no reason, growing out of the proceedings in equity, for varying this rule. The orators have the right to have the names of the stockholders, if there are any, in those States, whose existence would defeat the suit, set forth, so that they could traverse the existence of the persons or the fact of their being stockholders. They could not do that upon these allegations. There is no person named whom they may say is not a stockholder, or about whom they may say there is no such person. A traverse of the plea in its terms would put in issue what the orators know that the defendants do not know about the stockholders in those States. It would be quite singular if a suit should be abated, at the instance of defendants, on account of the supposed existence of persons whom they cannot name or identify. The want of such persons as parties is not likely to harm them. (*Hotel Company v. Wade*, 97 U. S., 13.)

The pleas of Clark and Worthington C. Smith are to the same effect, and so nearly alike that they may well be considered together. They have been spoken of in argument as pleas to the jurisdiction of the Court, or to the ability of the orators to bring suit, or as pleas in abatement otherwise; but, correctly speaking, they are not either. The orators and defendants are alleged in the bill to be citizens of different States. This fact gives the Court jurisdiction of the controversy between them, and enables the orators to bring the suit, and to maintain it if they can establish their case. The refusal of the directors is a part of their case, which they must establish, and not a fact on which the jurisdiction of the Court, or their ability to sue, at all depends. If they can establish the fact of refusal, together with the other facts necessary to make out a case for the relief asked, then they have a case on which they can rest; otherwise, not. They have the right to a full answer and discovery from the defendants as to their whole case, this part as well as the rest, unless there is some outside fact which would show that they have

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no right to maintain the suit at all; or some single fact on which the whole case depends is objected to by plea, and full answer and discovery is made to that part of the case. Pure and proper pleas in equity were such as set up some fact outside of the bill, which would show that the bill should not be answered at all. These pleas required no answer to support them, for they would not be included in that which the party was called upon to answer. Anomalous pleas, denying a single part of the case made by the bill, on which the whole case depended, came to be allowed, for convenience, to save trying the whole case when the failure of that part would be fatal; and for safety against enforced discovery in a suit by those not in any manner entitled to the discovery; but, as the ground of the plea would be included in what the defendant was called upon to answer, he could not avoid the right to have at least that part answered, by merely pleading to it. He must answer that, although the plea raising the objection and the answer supporting it might show that no answer to the rest of the case ought to be required. If this plea should be allowed, the orators would be deprived of the discovery on oath to which they are entitled, as to this part of the case, as evidence upon the traverse of the plea, if they should traverse it, as they would have a right to. This would be contrary to sound principles and to authority. (*Story's Eq. Pl.*, § 672, *et seq.*) These views are not contrary to the decision in *Memphis v. Dean*, (8 *Wall.*, 64,) cited and much relied upon in behalf of the defendants. There there was an answer by the party pleading, as well as the plea, denying refusal of the directors to prosecute, and the cause appears to have been decided, in both Courts, in chief, and not upon the plea alone.

The plea of John Gregory Smith depends solely upon the effect of the pendency of the suit in the State Court of Chancery, in favor of himself and other security holders, of which James R. Langdon is the foremost plaintiff in the title to the suit, against the Vermont and Canada Railroad Company, through whose rights the orators here make claim. Doubts have been entertained by this Court and some others as to

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whether the pendency of a suit in a State or Federal Court in the same District might not be successfully pleaded to the further prosecution of a like suit in the other Court, and this Court inclined to the opinion that it could be. (*Mercantile Trust Company v. Lamoille Valley Railroad Company*, 16 *Blatchf. C. C. R.*, 324; *Andrews v. Smith*, 19 *Id.*, 100.) But it now seems to be well settled that it cannot be. (*Gordon v. Gilfoil*, 99 *U. S.*, 168; *Latham v. Chafee*, 7 *Fed. Rep.*, 520.) If this were not so, it has always been held, that, in order to have the mere pendency of one suit defeat another, the suits must be between the same parties, or their representatives, upon the same facts and for the same relief. (*Watson v. Jones*, 13 *Wall.*, 679.) A very slight examination and comparison of the two cases will show that they are not brought upon the same facts nor for the same relief. The plea is pleaded to the whole bill. According to both bills the Central Vermont Railroad Company is in possession of the road. In that case it is an orator, as a security holder, seeking to hold the road as security for its pay. This particular defendant is a defendant there, admitting the right of the Central Vermont Railroad Company. That is essentially a bill of foreclosure by security holders in possession. The decree would ordinarily be that those interested must pay or be foreclosed of all right to redeem. The decree could go no further than to cut off their right if they should not redeem. If they should redeem, the possession would remain to be maintained by any other right which the possessor might have or claim to have, so far as it would prevail. Another suit would be necessary to determine the rights of the Vermont and Canada Railroad Company and its stockholders, as to everything but the foreclosure. In this suit the right to the road is attempted to be maintained outside of the right to redeem. If this plea should prevail there would be no suit left in which that right could be tried.

The plea of the Central Vermont Railroad Company raises the most important questions of any of these pleas, and has received such careful consideration as its importance has

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seemed to demand. The bill alleges that this defendant is in possession of the road without right and against the right of the Vermont and Canada Railroad Company and of the orators. This plea asserts that it was placed in possession by the Court of Chancery of Franklin County, to run, operate and manage the road under the decrees and orders theretofore made, and under the direction of the Court, so long as it should continue to act as such receiver and manager, and denies that it is in possession without right and that it ought to be compelled to surrender its possession to the Vermont and Canada Railroad Company, and prays judgment whether it ought to answer further. The proceedings upon which it was placed in possession show that certain persons were in regular course made receivers of this road, with other railroad property, to operate the roads, and out of the income to pay the rent to the Vermont and Canada Railroad Company; that, pursuant to an agreement between the parties, according to its terms embodied in a decree, the then receivers continued to operate the roads according to the provisions of the agreement and decree, by which they were to operate them and apply the income to the payment of the rent, then to the payment of the first mortgage bonds of the Vermont Central Railroad, then to the second mortgage bonds of the Vermont Central Railroad, and then to pay it to the Vermont Central Railroad Company; and that, upon the joint petition of those receivers and their successors and the Central Vermont Railroad Company, a decree was made, by which the Central Vermont Railroad Company was placed in possession in their stead. The orators claim that the prior possessors had lost their right to this road through their non-payment of rent, and that the transfer to the Central Vermont Railroad Company was merely a transfer by one to the other, although sanctioned by the Court, and that the transferee took no greater or different rights than the transferrers had. The defendants claim that the transfer was ordered by the Court, that the rights of the Central Vermont Railroad Company under the transfer cannot be inquired into anywhere except

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in that Court, and that they are valid everywhere else against all claimants. The right of the orators, denied by the plea, is the same which they set up and seek to enforce by their bill, and which they claim to have tried and determined upon the answer of the defendants, in the usual course. As stated before, the parties are citizens of different States, and this is a suit in which there is a controversy between them, and which those bringing it have the right to have determined in this Court, unless there is some unusual reason for turning them out of Court. As said by Mr. Justice Campbell, in *Hyde v. Stone*, (20 *How.*, 170 :) "But the courts of the United States are bound to proceed to judgment, and to afford redress to suitors before them, in every case to which their jurisdiction extends. They cannot abdicate their authority or duty in any case in favor of another jurisdiction." This is not a mere matter of abatement ; it goes to the right, and none the less because the right of the defendant may rest upon an order of the Court. The order of Court, whatever its effect is, may be discharged before any decision is reached and, if it should be, the rights of the parties otherwise would still remain to be determined. If it should not be, but should remain in force, whatever right it should give to any party, or whatever immunity from interference it should afford, could be maintained and upheld. If that should be the defendant's title, and it should be found to be good, it would prevail. There would be no conflict between Courts, for all rights acquired through the State Court, and all protection furnished by the authority of that Court, would be respected. There is no sound reason apparent why these rights may not stand for trial according to the usual course, the same as rights acquired by contract, or in any other mode. On principle, this seems to be the proper course. And there is not any case shown by counsel, or which has been seen by the Court, among the many wherein rights acquired under legal proceedings have come up for adjudication, in which the decision has been made otherwise than in chief. In *Hagan v. Lucas*, (10 *Pet.*, 400,) where the title of a sheriff to property seized by him

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and receipted, was upheld against a marshal of the United States who seized it subsequently, the trial was upon the merits of these respective rights. So, in *Brown v. Clarke*, (4 How., 4,) and in *Pulliam v. Osborne*, (17 How., 471.) And in *Taylor v. Carryl*, (20 How., 583,) where the question was as to the right of a State seizure as against proceedings in Admiralty, the trial was not upon any plea denying the right to interfere, but was upon the title acquired through the proceedings. In *Freeman v. Howe*, (24 How., 450,) the right of a mortgagee to personal property taken by the marshal on process against the mortgagor was tried on replevin, in chief. So, similar rights were tried in an action of trespass, in *Buck v. Colbath*, (3 Wall., 334.) And, in *Wiswall v. Sampson*, (14 How., 52,) the right acquired by the levy of a marshal upon property in possession of a receiver was tried upon ejectment, on the merits. In *Pond v. Vermont Valley Railroad Company*, (12 Blatchf. C. C. R., 292,) the question of this same receivership was raised, but not until after the decision reported, and upon the hearing before Circuit Judge Johnson, on answers and proofs, and it was disposed of as not affecting the rights of the parties to the property involved, nor the jurisdiction of the Court over the case.

Attention has been particularly called to the provisions of section 5 of the Act of March 3d, 1875, to determine the jurisdiction of the Circuit Courts, &c., (18 U. S. Stat. at Large, 472,) enacting, "that if, in any suit commenced in a Circuit Court, or removed from a State Court to a Circuit Court of the United States, it shall appear to the satisfaction of said Circuit Court, at any time after such suit has been brought or removed thereto, that such suit does not really and substantially involve a dispute or controversy properly within the jurisdiction of said Circuit Court, or that the parties to said suit have been improperly or collusively made or joined, either as plaintiffs or defendants, for the purpose of creating a case cognizable or removable under this Act, the said Circuit Court shall proceed no further therein, but shall dismiss the suit or remand it to the Court from which it

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was removed, as justice may require, and shall make such order as to costs as shall be just." Speaking of this section, Johnson, J., in *Warner v. The Pennsylvania Railroad Company*, (13 *Blatchf. C. C. R.*, 231,) said: "All that is necessary to bring the case really and substantially within the jurisdiction is, that it involves a controversy of the character, either as to the subject-matter or the parties, specified in either the section which defines the jurisdiction by original suit, or that which authorizes removal and the acquisition of jurisdiction in that manner." As before stated and shown, the parties to this suit are citizens of different States and the suit is one of which this Court has jurisdiction for that reason, if the orators can make out the case presented by their bill, including the refusal of the directors to prosecute, as a part of their case; if they cannot, they have no case. That part of their case, as also before shown, has not been denied in the necessary manner, by answer, to be effective to defeat the case upon that point, and there is no evidence before the Court, upon that or any other point, to make it appear at all that parties have been either improperly or collusively made or joined for the purpose of creating a case within the jurisdiction. There is nothing before the Court now on which the Court is authorized to act under the provisions of that section.

The pleas and demurrer are overruled, the defendants to answer over by the first day of next term.

E. J. Phelps and Prout & Walker, for the plaintiffs.

B. F. Fifield, for the defendants.

JONATHAN DWIGHT AND OTHERS

vs.

J. GREGORY SMITH AND OTHERS. IN EQUITY.

In this case a demurrer to a bill in equity was sustained because the bill did not show definitely and distinctly a right in the plaintiffs to equitable relief against the defendants.

(Before WHEELER, J., Vermont, January 14th, 1882.)

WHEELER, J. This cause has been heard upon a demurrer to the bill of complaint for want of equity in favor of the orators, generally; and for want of sufficient definiteness in stating the grounds for the relief claimed. The bill alone is to be looked at in determining the questions so raised. According to the bill, the orators are now the holders of the first mortgage bonds to a large amount, but when they became such holders is not shown; some of the defendants are trustees in that mortgage, others are the representatives of a trustee deceased; another defendant is the Central Vermont Railroad Company alleged to be in possession of the mortgaged property, others are directors in the latter corporation; the trustees have both neglected and violated their duty to the first mortgage bondholders while in possession of the mortgaged property, in not accounting to them for moneys received by them as trustees for them, and in delivering the property to the Central Vermont Railroad Company against their rights and expressed wishes; and the Central Vermont Railroad Company has received the income of the mortgaged property and not accounted for it, and its directors made defendants have participated in that act.

If the trustees received income from the mortgaged property, belonging to the bondholders and to be distributed to them, the money would belong and be to be distributed to

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the persons who were at that time bondholders, and the right to it would not pass to persons subsequently acquiring the bonds, unless they expressly acquired the right to it also. The claims of the bondholders against the trustees would not be upon the bonds themselves, like the claims against the obligors in the bonds, although they would be on account of the bonds, but would be claims against the trustees personally for the moneys received to the use of the bondholders, and these claims would not be assignable at law, although they might be in equity. In a suit or proceeding upon the bonds themselves the production of the bonds and coupons, or the allegation of their ownership, might import that the holder had held them at the time of the accruing of the interest incidental to the debt, and entitle him to recover for the whole; but not so as to a claim not upon the bonds, but for money received to the use of the bondholders. The production of the bonds would not make out a cause of action or claim for relief on account of that money. More would have to be shown, and enough more to make out a cause of action or ground for relief, and that would include showing a right to the money at the time it was received. The orators fall short of showing such right.

And, if the orators had been holders of the bonds ever after they were issued, and had so shown in their bill, it would be incumbent on them to show that their trustees, or those holding the property in place of the trustees, did receive money belonging to them, or did so conduct themselves with the property as to make themselves accountable for money as if they had received it. The bill does not allege that the trustees received any money belonging to the bondholders prior to their appointment as receivers; nor that, while they were in fact receivers, they received anything more than enough to pay the Vermont and Canada rent, which was to be first paid; nor that they ceased to be receivers in fact until the making of the compromise agreement; nor then otherwise than by the force of that agreement. That agreement is annexed to the bill and made a part of it. The bill does

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not show that the orators are not bound and willing to stand upon that agreement. If they are, then, as to them, the income raised afterwards was to be distributed according to that agreement. Some of that income was to go to the Vermont and Canada Railroad Company for rent; how much does not appear. A gross amount of income for a term of years is stated, but whether that amount was greater than the amount of rent to be first paid is not shown or stated. The same would be true if the compromise agreement was not binding upon them; the amount to be paid before anything would remain to apply on these bonds would not appear, and, consequently, whether anything would be left to go to the bond-holders would not in either case appear. The bill should show definitely and distinctly not merely a right in somebody to equitable relief, but a right in the orators to equitable relief against the defendants.

The demurrer is sustained.

Francis A. Brooks and William G. Shaw, for the plaintiffs.

Benjamin F. Fifield and Daniel Roberts, for the defendants.

JOHN N. A. GRISWOLD AND OTHERS

vs.

THE CENTRAL VERMONT RAILROAD COMPANY AND OTHERS.
IN EQUITY.

J. and others, citizens of New York, and executors in that State of G., late a citizen of New York, filed this bill to enforce liens on rolling stock, and earnings of rolling stock, of two railroads, pledged by some of the defendants while in possession of those roads, and a corporation, their successors in possession, by consent of parties and order of a Court of the State of Vermont thereupon, for the security of several series of equipment loans, in which the

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plaintiffs, as executors, invested. Some of the defendants demurred on the ground that owners of the different series of the bonds had no common interest in the securities; that the bonds were not referred to as a part of the bill, nor made a part of, nor attached to, the bill; that the doings of the managers in possession prior to the possession of the corporation could not properly be joined with its doings; and that, on the face of the bill, it appeared that the Court had not jurisdiction. The corporation pleaded the proceedings of the State Court in bar of jurisdiction, part of which was a provision, in a decree in that Court, that that Court might be applied to for the realization of the securities held by the plaintiffs: *Held*, that the demurrer and the plea must be overruled.

The plaintiffs, although executors in New York, could sue in Vermont, their rights never having accrued to their testator.

The said provision for relief in said decree of the State Court did not exclude all other remedies.

The fact that property is being administered upon in State proceedings does not prevent citizens of other States from proceeding in the Federal Courts to establish their claims and obtain relief.

(Before WHEELER, J., Vermont, January 14th, 1882.)

WHEELER, J. The orators are citizens of New York, and executors in that State of George Griswold, late a citizen of that State, and bring this bill to enforce liens upon rolling stock, and earnings of rolling stock, of the Vermont Central and Vermont and Canada Railroads, pledged by some of the defendants while in possession of those roads, and the Central Vermont Railroad Company, their successors in possession, by consent of parties, and order of the Court of Chancery of the State of Vermont thereupon, for the security of several series of equipment loans, in which the orators, as executors, invested.

Some of the defendants have demurred, assigning, for cause, that owners of the different series of bonds have no common interest in the securities; that the bonds are not referred to as a part of the bill, nor made a part of, nor attached to, the bill; that the doings of the managers in possession prior to the possession of the Central Vermont Railroad Company cannot properly be joined with the doings of that company; and that, on the face of the bill, it appears that this Court has not jurisdiction. The Central Vermont Railroad Company has pleaded the proceedings of the State Court of

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Chancery in bar to the jurisdiction of this Court, from which it appears, that some of these defendants, with other persons, were made receivers of these roads in a cause pending between the Vermont and Canada Railroad Company, and the Vermont Central Railroad Company and its security holders; that, while so in possession, an agreement was made between the parties, and embodied in a decree of the Court, under which those in possession and their successors were continued in possession, and by one of the provisions of which the cause in which the proceedings had been taken was kept in Court, with liberty to any party to apply to the Court for further orders, as they might be advised; that, in the proceedings authorizing these loans, and as a part of the decrees under which they were issued, it was provided, that, in case the trustees should fail to pay the notes or interest, the holders might apply to that Court for the realization of their securities, or for a summary order for the payment of the amount due, out of any property in the hands of the trustees, and that a copy of this part of the decrees was printed upon, and made a part of, the notes. The cause has now been heard upon these causes of demurrer and this plea.

The causes of demurrer do not require any extended notice. The claims are asserted in favor of parties having like claims upon common property against parties in possession of that property, to enforce a common trust. The Central Vermont Railroad Company succeeded to the duties of its predecessors in respect to the property, and still the predecessors were not discharged; therefore, all are connected, and all are properly joined. If the bonds or notes are sufficiently set forth to show their terms and effect, that is enough, without reciting them, further referring to them, or attaching copies of them; and it is not pretended but that they are so set forth. The question as to the jurisdiction of this Court is involved and included in that made by the plea, except as to a question made whether the orators, being executors in the State of New York, can sue out of that State. This does not involve any question as to whether they so succeed to the

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rights of their testator out of the State where they are executors, that they can represent him and recover upon his rights elsewhere; these rights never accrued to him at all. They accrued to the orators themselves, and accrued to them in the same capacity, and, for aught that appears, in the same place, in which they are attempting to enforce the rights. Letters of executorship or administration extend only to the goods or estate which were of the testator or intestate at the time of decease, and would not include these securities, if taken out in Vermont, as against the rights of the orators.

As to the other question of jurisdiction, as the parties are citizens of different States, the amount in dispute is large enough, and this Court has, and is bound to take, jurisdiction, when a proper case is brought, unless there is something in the nature of the case or situation of the property that excludes the jurisdiction. It is argued, for the defendants, that those contracting the debts were still the receivers of the Court; that they contracted the debts as such; that all the property from which the debts were to be paid was in their possession as receivers; that no other Court could reach the property to afford relief for non-payment, and that the provision for relief, in the order authorizing the loans and made a part of the notes, excludes all other remedies. The jurisdiction of Courts is given by the law, and not by the parties, and can neither be conferred nor taken away by their mere consent or agreement. If the conditions prescribed by the law for jurisdiction exist, the jurisdiction exists. The conditions prescribed for giving this Court jurisdiction of the parties exist, and jurisdiction of the case must follow, unless the subject is out of reach. Neither by the terms of the securities, as set forth in the bill, or as shown in the plea, nor by the conditions of the proceedings, was anything to be done by the Court before the defendants could carry out their obligation to set apart the earnings of the rolling stock as agreed and apply them to the satisfaction of these notes. They were at liberty to do it, and, so far as appears, were bound to do it. If there was a failure, the holders of the notes would have a

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right to apply to the Courts of the land for relief, and they would not be deprived of the right to apply to any one Court because they had the right to apply to another. Those which were provided were provided for the purpose of giving the right to apply to them. There is nothing to prevent applying to this Court, unless it may be that, as is argued, the property is in the course of administration of the State Court. It is, however, well settled, that the fact that property is being administered upon in State proceedings does not prevent citizens of other States from proceeding in the Circuit Courts of the United States to establish their claims and obtain relief, if entitled to it. (*Suydam v. Broadnax*, 14 Pet., 67; *Erwin v. Lowry*, 7 How., 172.) In *Shelby v. Bacon*, (10 How., 56,) the assets of an insolvent corporation were being administered, under the laws of Pennsylvania, by assignees accountable to the State Court of Common Pleas. The assignees refused to allow the claim of the plaintiff, and he brought suit in the United States Circuit Court, to which the assignees pleaded the pendency of the State proceedings. After noticing some defects in the plea, Mr. Justice McLean, in delivering the opinion of the Court, said: "But, if the plea had been perfect in this respect, it would not follow that the complainant could not invoke the jurisdiction of the Circuit Court. He, being a non-resident, has his option to bring his suit in that Court, unless he has submitted, or is made a party, in some form, to the special jurisdiction of the Court of Common Pleas. It appears from the bill, that the assignees have refused to allow the claim of the plaintiff, or any part of it. To establish this claim as against the assignees, the complainant has a right to sue in the Circuit Court, which was established chiefly for the benefit of non-residents. Not that the claim should thus be established by any novel principle of law or equity, but that his rights might be investigated free from any supposed local prejudice or unconstitutional legislation. On the most liberal construction favorable to the exercise of the special jurisdiction, the rights of the plaintiff in this respect could not, against his consent, be drawn into

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it." In *Mallett v. Dexter*, (1 *Curtis' C. C. R.*, 178,) sometimes relied upon to avoid the jurisdiction of the Circuit Court, jurisdiction was entertained in favor of a non-resident, to reopen accounts of administrators settled in the Probate Court of Rhode Island, on the ground of fraud, although it was refused as to accounts then actually in process of settlement in the State Court. (*Union Bank v. Jolly*, 18 *How.*, 503; *Hyde v. Stone*, 20 *How.*, 170; *Payne v. Hook*, 7 *Wall.*, 425.)

According to the allegations of the bill, a particular fund was to be set apart for the payment of the orators' notes, which was not set apart, or, if set apart, has not been applied to that purpose. The orators have the right to apply to the Federal Courts, on account of their citizenship, to have their claims investigated. The merits of their claims are not yet before the Court, and cannot be until answer and proofs are made. The only question now is, whether the case shall proceed to answer and proofs. Nothing is seen adequate to deprive the orators of their right to resort to the Federal Courts, in common with all citizens of one State having or claiming to have cause of action against citizens of another State, to have their causes tried.

The demurrer and plea are overruled, defendants to answer over by the first day of next term.

Prout & Walker, for the plaintiffs.

B. F. Fifield and *L. P. Poland*, for the defendants.

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WILLIAM H. WEBB AND OTHERS

vs.

THE VERMONT CENTRAL RAILROAD COMPANY AND OTHERS.
IN EQUITY.

The bill in this case was sustained, on demurrer, as a bill by second mortgage bondholders of a railroad company, against the mortgagor and a trustee in the mortgage, to foreclose the mortgage.

It is a sufficient reason for the bondholders to proceed in their own names and behalf, making the trustees defendants, that the trustees have acquired adverse interests, and stand in a hostile position, so that they cannot maintain the plaintiffs' rights without attacking their own.

A demurrer to the bill by the trustees of a prior mortgage and by parties in possession under them was sustained, because the bill was not framed as a bill to redeem the prior mortgage.

(Before WHEELER, J., Vermont, January 14th, 1882.)

WHEELER, J. The defendants, the Vermont Central Railroad Company, the Central Vermont Railroad Company, John Gregory Smith, Worthington C. Smith, and James R. Langdon demur to the bill, and the cause has been heard upon the demurrer. The orators are second mortgage bondholders of the Vermont Central Railroad; the defendant John Gregory Smith is a trustee in the first mortgage; Worthington C. Smith is a trustee in the second mortgage; and both of them and the defendant Langdon are officers in the Central Vermont Railroad Company, which is in possession received from the trustees of the first mortgage.

One cause of demurrer assigned is, that the bill does not show sufficient reason for the bondholders to proceed in their own names and behalf. But the bill does show that the trustees have acquired adverse interests and stand in a hostile position, so that they cannot maintain the orators' rights without attacking their own. They could not be orators against themselves; and this is a sufficient reason for making them

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defendants, where the orators' interests were in suit, and with them as defendants there would be no one to prosecute the orators' claims but the orators themselves. The bondholders are the real owners of the mortgage interest, and the trustees have but a dry legal title, and, when they hold that title in opposition to the bondholders, the latter have good ground for proceeding in their own behalf, to protect such rights as they have, and the proper position of the trustees in the proceedings is with the defendants. This cause of demurrer cannot prevail.

Another ground is a want of equity in the case made by the bill generally. While being considered on this question, the bill cannot be aided by what is stated elsewhere, or by what is known in some other way, but must stand alone for examination, with all its allegations taken for this purpose to be true. It states the prior mortgage as a valid incumbrance prior to the second mortgage, and that the trustees of the first mortgage were rightfully in possession by virtue of that mortgage, and that they procured their possession to pass to the Central Vermont Railroad Company. The orators' rights are subordinate to the first mortgage, and to those of the first mortgage trustees, and all holding under them. As against such they have no right but to redeem, and this bill is not adapted to that purpose; it has not the proper allegations, offers of payment, nor parties. The bill states proceedings of Court by which the Central Vermont was placed in possession, but alleges that they were all void as to the orators, and alleges that they were had at the instance of the trustees in the first mortgage, and that the Central Vermont claims to hold possession by the force of the proceedings. This does not show the Central Vermont to be in possession as a mere wrong-doer, subject to the rights of any owner, with none of its own. It would not lose the rights it had by claiming to hold under those it had not. If the proceedings were void they conferred no right; but those who made use of them to transfer possession would, by the act, pass such possession as they had to pass, and the possession taken would be good as

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theirs, because they gave it, although there was nothing else to uphold it. Thus, the possession of the Central Vermont appears to be the same as that of the first mortgage trustees, and such that the second mortgage bondholders cannot, upon the allegations of this bill, disturb it, without redeeming the first mortgage. They cannot foreclose their mortgage against either, because both stand upon a mortgage which is prior to theirs.

The bill states a transaction by which an agreement, and a decree upon it, were made, providing for payment of rent, then of the first mortgage, and then of the second mortgage, by those in possession, and that the Central Vermont is under that duty, but does not state that anything has been received to apply upon the second mortgage, and does not pray for any account; so, there is no ground for relief in that direction. It states that the first mortgage has been enlarged against the rights of the second mortgage bondholders, and that the trustees and the Central Vermont hold securities which they claim to be a prior lien to the second mortgage, and which are not; but, as the orators do not seek to redeem such prior incumbrances as they have which are valid, there is no relief to be afforded by determining the validity of any, and no ground for making such a determination. The bill shows a right to foreclose the mortgage against the mortgagor, and to have the trustee a defendant for that purpose, and shows no other ground for relief.

The demurrer of the Central Vermont Railroad Company, and John Gregory Smith and James R. Langdon is sustained, and that of the Vermont Central Railroad Company and Worthington C. Smith is overruled.

William G. Shaw and Francis A. Brooks, for the plaintiffs.

Benjamin F. Fifield and Daniel Roberts, for the defendants.

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LORING COES

vs.

THE COLLINS COMPANY. IN EQUITY.

Claim 1 of re-issued letters patent No. 3,483, granted to Loring Coes, June 1st, 1869, for an "improvement in wrench," the original patent, No. 40,590, having been granted to Thomas H. Dodge, as assignee of George C. Taft, the inventor, November 10th, 1863, for an "improvement in wrenches," namely, "An improved Coes wrench, so constructed that the thrust or back strain of the rosette screw, when the wrench is used, shall be borne by the shank, instead of the handle of the wrench, substantially as described," is not infringed by a wrench made in accordance with the description in letters patent No. 50,364, granted to Jordan and Smith, October 10th, 1865, for an "improved wrench."

The claim is not a claim to so constructing a Coes wrench of 1841, that the back thrust shall be borne by the shank ultimately, through the plate and the handle and the end nut, nor is it a claim to having the shank bear the thrust at some point before the handle is reached, without reference to the mechanical means, but it is a claim to the means shown "substantially as described," and it is not infringed by a wrench in which the plate is not relieved.

(Before BLATNFORD, J., Connecticut, January 16th, 1882.)

BLATNFORD, J. This suit is brought on re-issued letters patent No. 3,483, granted to Loring Coes, the plaintiff, June 1st, 1869, for an "improvement in wrench," the original patent, No. 40,590, having been granted to Thomas H. Dodge, as assignee of George C. Taft, the inventor, November 10th, 1863, for an "improvement in wrenches." The specification of the re-issue is signed by Loring Coes, and is as follows, including what is inside of brackets, and what is outside of brackets, omitting what is in italics: "Figure 1 represents a perspective view of [a 'Coes wrench,' having the said Taft's improvements applied thereto,] *my improvement*, and Figure 2 represents [sections of detached parts of the wrench shown in Fig. 1.] *a detached view of the 'rosette' and parts therewith connected*. Similar letters of

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reference indicate like parts in the drawings. * * * [The nature of the said Taft's invention relates to a mode of constructing the Coes wrench patented April 16, 1841, in such a manner that the handle shall be relieved from the back thrust or strain of the rosette screw, when the wrench is used. In my said wrench, the rosette presses against the ferrule, and the ferrule, in turn, against the front end of the handle, whereby the handle was often split and broken. In the drawings] A is the shank of [the] *my* wrench; B, the stationary jaw; and B' the sliding jaw, through the part B'' of which the operating screw C works. D is the rosette, formed in one piece, *as shown*, with the screw C, [as shown,] and journalled, at *a*, to [the] ferrule E. Parallel grooves, *d, d, d*, [in this instance,] are cut in the shank A, [at right angles to the line of motion of the movable jaw B''] in which [grooves] projections, *e, e, e*, of the rosette turn. The projections *e, e, e*, are made parallel to each other, and are bevelled on one side, as shown, to lessen the friction of the rosette [in] *upon* turning. The operation is as follows: To adapt the opening between the jaws to the size of the object to be clasped thereby, the operator turns the rosette to the right or left, as the size of the object [may require,] *will indicate*, which will turn the screw in the part B'' of the sliding jaw B', [thereby increasing or diminishing, as the case may be,] *and, as to the way turned, will increase or diminish* the distance between the jaws, as required. The [advantage] *advantages* of *having a rosette* of this [improvement] *form* is that *it sustains* the pressure which [would otherwise] *otherwise would* come [upon] *on* the [handle is transferred to the shank of the wrench, thus obviating one, and really the only serious, objection to the said Coes wrench.] *ferrule E, which pressure is often so great as to break it off, or displace it, thus rendering the whole wrench useless. Having thus described my improved wrench, I am aware that the [rosettes] rosette of screw wrenches [have] has heretofore been constructed with [screw threads] a screw thread, and [such devices are not claimed,] I do not claim such device, but what [is claimed as the invention of the said George C.*

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Taft, and desired to have secured] *I claim and desire to secure* by letters patent is:” Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, gives the text of the specification of the original patent. There are 3 claims in the re-issue, as follows: “1. An improved Coes wrench, so constructed that the thrust or back strain of the rosette screw, when the wrench is used, shall be borne by the shank, instead of the handle of the wrench, substantially as described. 2. A notch formed at right angles to the line of motion of the movable jaw, in the shank of a Coes wrench, for relieving the handle from the back strain of the rosette screw, substantially as described. 3. The combination of two or more parallel grooves, *d*, in the shank A, with two or more corresponding projections, *e*, on the rosette D, the same not being spiral, but running at right angles to the line of motion of the jaw, substantially as described.” There was only one claim in the original patent, as follows: “The combination of the parallel grooves *d*, *d*, *d*, in the shank A, with the corresponding projections *e*, *e*, *e*, on the rosette D, the same not being spiral, but running at right angles to the line of motion of the jaw, thus relieving the ferrule from all strain, while retaining the rosette in the same relative position as respects the handle of the wrench, substantially as and for the purposes set forth.”

The defendant’s wrench which is alleged to infringe claim 1 of the re-issue is made in accordance with the description in letters patent No. 50,364, granted to Jordan and Smith, October 10th, 1865, for an “improved wrench.”

The plaintiff’s wrench and the defendant’s wrench both of them contain improvements engrafted upon the form of wrench shown in letters patent No. 2,054, granted to Loring Coes, the plaintiff, April 16th, 1841, for an “improvement in the method of constructing screw wrenches,” and re-issued to him, No. 139, June 26th, 1849, for an “improvement in screw wrenches.” The main feature of the Coes wrench of 1841 was the moving of the adjustable jaw by a screw placed at the side of, and parallel with, the main bar which carried the

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permanent jaw at one end of it and the handle at the other end, the screw taking into an attachment to the adjustable jaw, and working that jaw to and fro without itself moving otherwise than by rotation, and having on its end farthest from the fixed jaw a rosette or milled head, which never approached to or receded from the fixed jaw, and could therefore be rotated, so as to rotate the screw, by the thumb of the hand which held the wrench, because the rosette always retained the same position relatively to the handle of the wrench. A wooden handle was slipped over the handle end of the main bar, and a screw nut on that end, bearing against the adjacent end of the wooden handle, held the other end of the wooden handle against a ferrule, and that against an iron plate, and that against a shoulder on the main bar. The iron plate projected out on the same side with the rosette and next that face of it farthest from the fixed jaw. The plate carried the revolving end of the screw, the bearing point projecting beyond the face of the rosette, such revolving end, rosette and screw being practically one piece and revolving together. In order to prevent the screw and the rosette from being carried bodily towards the fixed jaw by the sliding of the adjustable jaw on the main bar, a notch as long as the width of the periphery of the rosette was cut in or out of the substance of the main bar opposite the place intended for the permanent position of the rosette, and the periphery of the rosette turned within the notch, so that the edge of the rosette face nearest to the fixed jaw would catch against the edge of the notch, the angle of the notch being towards the fixed jaw. But, while this Coes wrench of 1841 had advantages it had difficulties. There was a pressure against the plate by the rosette face farthest from the fixed jaw and by the end of the screw in its bearing, and thus the back strain or thrust from the bite of the jaws was communicated through the adjustable jaw, its attachment, the screw and the plate, to the ferrule and so to the wooden handle, before it reached the main bar through the screw nut at the handle end. The plate and the ferrule were often broken or bent and pushed out of

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place and the wooden handle was split or crushed. It became desirable, therefore, to devise a way of taking off this back thrust before it could reach the plate or the ferrule and thus the wooden handle, and of bringing it against the resisting strength of the main bar itself between the plate and the fixed jaw. Taft did this by his invention of 1863. He took the Coes wrench of 1841, with its main bar, fixed jaw, adjustable jaw, attachment thereto, screw, bearing, plate, ferrule, wooden handle, screw nut and extension of main bar, all as they were, and, in place of one rosette, he put in three parallel rosettes, with narrower peripheries, revolving, at right angles to the line of motion of the adjustable jaw, in three parallel grooves in the adjacent face of the main bar, each groove bearing against both faces of its rosette, so as not only to prevent the rosette and the screw from being carried bodily towards the fixed jaw, but to cause the back thrust to be received by the side of the groove farthest from the fixed jaw, instead of, as before, by the plate. The grooves being cut in the main bar, the back thrust was intercepted by them, and the plate and the ferrule, and thus the wooden handle, were relieved from all liability to injury from the back thrust, while the rosette was retained in the same relative position to the handle which it had in the Coes wrench of 1841. In the original patent of 1863 the plate and the ferrule together are called the ferrule E, and it is stated that by the new arrangement the pressure which would otherwise come on the ferrule is taken off from it, such pressure being "often so great as to break it off, or displace it, thus rendering the whole wrench useless." The claim in that patent states that the arrangement relieves the ferrule from all strain, while the rosette is retained in the same relative position as respects the handle of the wrench. The re-issue states that the nature of the invention relates to a mode of constructing the Coes wrench patented in 1841 in such a manner that the handle shall be relieved from the back thrust of the screw, the arrangement of the wrench of 1841 being that the rosette pressed against the ferrule, (the ferrule, E, being the plate and the

ferrule together,) and the ferrule against the front end of the handle, whereby the handle was often split and broken. It is not said, in the re-issue, that the rosette continues to maintain always the same position relatively to the handle, but that is necessarily implied in speaking of the wrench improved upon as the Coes wrench patented in 1841, and is a necessary result of what is described in the text and shown in the drawings. The re-issue also states that the advantage of the improvement is that the pressure, which would otherwise come upon the handle, is transferred to the shank of the wrench.

In the monkey wrenches used before the Coes patent of 1841, a screw nut on the body of the main bar moved the movable jaw, a screw being cut on the body of the main bar, as shown in figure 2 of the Coes patent of 1841. In that form the direct linear or columnar strength of the main bar was availed of to resist the back thrust. When the Coes improvement of 1841 was introduced that advantage was thrown away. The improvement of Taft in 1863 was an effort to restore that advantage and yet retain the Coes improvement of 1841.

In the defendant's wrench the Coes wrench of 1841 is taken, with its main bar, fixed jaw, adjustable jaw, attachment thereto, screw, rosette, bearing and plate. But underneath the plate a screw nut is put on the extension of the main bar, a screw thread being cut in the extension, and this screw nut is screwed up tightly against the bottom of the plate, so that the back thrust comes against the extension at the screw thread. The wooden handle is slipped over the end of the extension and is held up against the bottom of the said screw nut by a screw nut at the extreme end of the extension below the handle. The rosette is the same as the Coes rosette of 1841 and always maintains the same position relatively to the handle.

The first claim of the re-issue, which is the only claim alleged to have been infringed, is a claim to "an improved Coes wrench, so constructed that the thrust or back strain of the rosette screw, when the wrench is used, shall be borne by

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the shank, instead of the handle of the wrench, substantially as described." Mr. Waters, an expert for the plaintiff, testifies that the defendant's wrench is, in his judgment, the same in its construction and mode of operation as the wrench described in the re-issue and referred to in the first claim, because the essential novelty of the wrench described in the re-issue consists in a mode of construction to relieve the Coes wrench of the difficulty described in the re-issue; that this is done in the re-issue by bringing the back thrust to bear against projections on the main bar, running across it, against which the rosettes on the screw act; that in the defendant's wrench the end thrust is taken on the plate, and then, through the screw nut, comes on the shank by means of the threads inside of the screw nut and the threads on the shank, which bear against the former threads; and that this is only an equivalent for the projections on the main bar, in the re-issue, against which the rosettes bear. Another of the plaintiff's experts, Mr. E. S. Renwick, states that the two wrenches obtain by substantially the same means the result of sustaining the strain of the movable jaw and of the rosette screw by the shank or bar of the wrench, in this, that in the defendant's wrench the rosette and the screw are combined with the rectangular part of the shank, or its equivalent, by a notch which limits the movement of the rosette and screw in both directions, without the intervention of the handle, the notch having its upper shoulder formed by a portion of the rectangular shank itself, and its lower shoulder formed by the upper surface of the plate, which plate is rigidly secured to the shank; and that holding the lower shoulder of the notch to the shank by the screw nut in the defendant's wrench is a well known substitute for the Taft method of holding the lower shoulders of the grooves to the shank by the substance of the material of which they are composed.

It is entirely clear, as is testified to by Mr. H. B. Renwick, the defendant's expert, that if, in the Coes wrench of 1841, the back thrust of the screw reaches the plate it is transmitted through it and the wooden handle and the nut at the

end of the shank, which is an extension of the main bar, to the shank, so that it is borne by the shank. It comes back thus to the column formed of the main bar and shank, as one piece. If the plate bends or the ferrule is displaced or the wooden handle is broken, those are incidents of the pressure, and those incidents happen only because the thrust is being resisted by the shank. Taft brought the pressure back to the main bar by taking it off by the grooves and rosettes, before reaching the plate, thus relieving not only the wooden handle and the end nut but also the plate. He did this by right angled grooves and rosettes, interposed before reaching the plate. If the first claim of the re-issue claims any more than this, it cannot be maintained. As a claim to so constructing a Coes wrench of 1841, that the back thrust shall be borne by the shank ultimately, through the plate and the handle and the end nut, it would cover the Coes wrench of 1841. As a claim to having the shank bear the thrust at some point before the handle is reached, without reference to the mechanical means, it is invalid. It must be regarded as a claim to the means shown "substantially as described." As such it is not infringed. Taft left the plate and the handle and the end nut outside of the course of the back thrust. The defendant's wrench does not leave the plate outside of such course. In it the thrust acts fully on the plate and a screw nut is interposed between the handle and the plate, having on it and on the shank the usual spiral threads. The two inventions are inventions in different directions, though both have a common ultimate object and design. The wooden handle is relieved in both. But that is not sufficient to make out infringement. The plate is relieved by Taft, and not by the defendant.

Claim one of the Taft re-issue must be read as a claim to an improved Coes wrench, constructed substantially as described. What is said in it about the bearing of the thrust by the shank instead of the handle is merely a statement of a result which the construction will effect, and is not a statement of means or mechanism. It is a claim to means, to the

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mechanism described which effects the result stated. The means employed by the defendant are different and are not a mechanical equivalent for the means in the re-issue.

The bill is dismissed, with costs.

George L. Roberts, for the plaintiff.

William E. Simonds, for the defendant.

HENRY LOUIS BISCHOFFSHEIM

vs.

HERMAN R. BALTZER AND WILLIAM G. TAAKS. IN EQUITY.

The modes of taking testimony in equity cases explained.

The provision of Rule 68, in Equity, for taking testimony in an equity case, after it is at issue, by deposition, according to the Acts of Congress, is still in force.

Where testimony in a foreign country can be taken orally, it ought not, except for special reasons, to be taken otherwise.

The plaintiff in an equity suit having applied for an order for a commission to examine himself on written interrogatories to be annexed to the commission, on an affidavit showing that he expected to prove by himself the material averments in the bill, or many of them, the Court allowed the defendant to cross-examine him orally.

(Before BLATCHFORD, J., Southern District of New York, January 16th, 1882.)

BLATCHFORD, J. This is a suit in equity. Issue was joined by the filing of a replication to the answer, December 1st, 1879. On the 5th of February, 1881, the plaintiff's solicitors, not having before taken any testimony, served a notice in writing on the defendants' solicitors, that the plaintiff "desires the evidence to be adduced in this cause to be taken orally," and that witnesses would be examined in the city of New York, on February 11th. Two witnesses for the plaintiff

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iff were examined orally under this notice, the last one in June, 1881. The time to take testimony has been extended and has not expired. In May, 1881, the defendants' solicitors having been previously informed by the plaintiff's solicitors that the latter intended to have a commission issued to take in London, England, the deposition of the plaintiff, who resides in London, gave notice in writing to the plaintiff's solicitors that the defendants' solicitors desired to cross-examine the plaintiff orally, and requested them to have the commission executed during the ensuing July or September, when one of the defendants' solicitors would be in London and attend to the matter. To this notice no reply was ever received. One of the witnesses so examined in New York was the confidential manager of the plaintiff's business, residing in London, and it appears that the plaintiff has there legal advisers who have been consulted concerning the matters in issue herein.

The plaintiff now applies for an order for a commission to examine himself on written interrogatories to be annexed to the commission, on an affidavit showing that he expects to prove by himself the material averments in the bill or many of them. The defendants ask that if a commission to examine the plaintiff on written interrogatories be issued, the defendants have leave to cross-examine the plaintiff orally themselves.

By Rule 67 in Equity, as in force prior to the December Term, 1861, testimony in suits in equity might be taken by commission, on written interrogatories and cross-interrogatories, but by agreement it might be taken by oral interrogatories, under a commission. This applied even to testimony to be taken where a subpoena from the Court could reach the witness. By Rule 68, testimony might also be taken in the cause, after it was at issue, by deposition, according to the Acts of Congress. Under Rule 69, publication of the testimony taken under such commissions might be ordered immediately upon the return of the commissions. The idea was that it was not known to the parties what the witnesses

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had testified to, the commission being executed without the presence of either party or solicitor. Formerly, the general mode in England of examining witnesses in equity was by interrogatories in writing exhibited by the party. (*Daniell's Ch. Pr.*, ch. 22, § 9.) At the December Term, 1861, (1 *Black*, 6,) a new practice was introduced, by a Rule made by the Supreme Court. The clause in Rule 67 relating to taking testimony by agreement on oral interrogatories was repealed, and the Rule was amended by adding to it provisions making oral examination the rule, if either party desires it, and examination by written interrogatories the exception. Under Rule 67 as amended, if neither party gives notice to the other that he desires the evidence to be taken orally, then the testimony may be taken by commission, as formerly, even where the witnesses are within the reach of the subpoena of the Court. But if either party gives notice to the other that he desires the evidence to be taken orally, then "all the witnesses to be examined shall be examined before one of the examiners of the Court, or before an examiner to be specially appointed by the Court," the examination to take place on notice, in the presence of the parties and by counsel, and the witnesses to be cross-examined and re-examined, as nearly as may be in the mode used in common law Courts. At the close of the added provisions is this: "Testimony may be taken by commission in the usual way by written interrogatories and cross-interrogatories, on motion to the Court in Term time, or to a judge in vacation, for special reasons, satisfactory to the Court or judge." This refers to the former way, to the way for which the new way was substituted, in case either party should give notice of his desire for an oral taking; and the notice so given was thus made subject to the power of the Court, for special reasons, to annul the usual effect of the notice. This last provision about taking testimony by commission in the usual way has no reference to issuing a *dedimus potestatem*, under § 866 of the Revised Statutes, formerly § 30 of the Act of September 24th, 1789,

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(1 *U. S. Stat. at Large*, 90.) It refers to the usual way before practised in equity cases.

Depositions may be taken under a *dedimus potestatem*, under § 866, "according to common usage," now as at any time hitherto, in a suit in equity. The words "common usage," in regard to a suit in equity, refer to the practice in Courts of equity. Under this practice, it was usual to examine witnesses abroad by written interrogatories and cross-interrogatories.

The provision of Rule 68, for taking testimony in an equity case, after it is at issue, by deposition, according to the Acts of Congress, is still in force. Under §§ 863 and 1,750 of the Revised Statutes, depositions *de bene esse* in civil causes may be taken in a foreign country by any secretary of legation or consular officer. The mode of taking such depositions under §§ 863, 864 and 865 is by oral questions put at the time, if desired, and not necessarily by written interrogatories given to the officer before commencing the taking. It is the same mode provided for by the amendment to Rule 67. As, after either party has given notice to the other that he desires the evidence to be adduced in the cause to be taken orally, the testimony is not, except for special reasons, to be taken otherwise, so, by analogy, where testimony in a foreign country can be taken orally, it ought not, except for special reasons, to be taken otherwise. What would in any given case be sufficient special reasons must be left to be decided in each case. In the present case, the defendants are, I think, entitled to cross-examine the plaintiff orally. There is no reason why his direct examination should not be taken on written interrogatories, if desired.

J. H. Choate, for the plaintiff.

C. M. Da Costa, for the defendants.

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JOHN MATTHEWS

vs.

ALVIN D. PUFFER AND OTHERS. IN EQUITY.

P., in a suit in equity against him for the infringement of a patent, moved to set aside the service of the subpoena on him, on the ground that the service was made upon him while he was attending the examination of witnesses in New York on an interference depending between him and the plaintiff before the United States' Patent Office. His moving affidavits did not show where he resided or carried on business. The motion was denied. P. afterwards renewed the motion on papers showing that at the time of the service he was a citizen and resident of Massachusetts: *Held*, that the defendant had waived the objection to the service, as made while he was protected by a privilege, by not showing, on the first motion, where he resided.

(Before BLATCHFORD, J., Southern District of New York, January 18th, 1882.)

BLATCHFORD, J. The defendant, Alvin D. Puffer, heretofore made a motion to this Court founded on affidavits, to set aside the service made on him of the subpoena to appear and answer herein. The suit is one for the infringement of letters patent. The motion was opposed and denied by an order made December 30th, 1881. The reasons set out in the motion papers, as grounds for the motion, were, that the service was made upon the said defendant while he was attending the examination of witnesses in the office of the counsel for the plaintiff herein, in the city of New York, in a cause of interference then depending between him and the plaintiff before the United States' Patent Office, and when he was lawfully attending at said office "in his right as a party to said interference cause." The moving affidavits did not show where the defendant resided, or where he carried on business, but merely that he "went to New York" to attend such examination, not stating from what place he went. The motion was made upon the bill as a part of the moving papers. The bill speaks of the defendants as "doing business" at Boston

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and New York, and as being citizens of the United States. In opposition to the motion, it was shown by affidavits on the part of the plaintiff, that the defendant served had a place of business in the city of New York and one also in Boston. In regard to him the plaintiff said, in an affidavit: "His place of residence in New York is not known to me and I have been unable to ascertain it." The defendant, after hearing the affidavits in opposition to the motion, chose to submit it for decision, and did not ask leave to withdraw it and renew it on further papers or to put in further papers. The Court, in denying the motion, said: "It does not anywhere appear that A. D. Puffer is a citizen of Massachusetts, or resides in Massachusetts, or is not a citizen of New York, or does not reside in New York. The bill alleges that he does business at New York, and is a citizen of the United States. It is shown that he has a place of business in New York city. The motion is denied."

The defendant now, without leave, renews the motion, on papers showing that at the time of the service he was a citizen and a resident of the State of Massachusetts. This was a fact which the defendant was called upon to show, on the first motion. It is not a newly-discovered fact. It was involved in and pertinent to the first motion. It was called to the attention of the defendant by the opposing papers and yet the judgment of the Court was invoked on the case. The Court had jurisdiction of the subject-matter of the suit. The service of the subpoena was made on the defendant personally in this district. The objection to the service, as made while the defendant was protected by a privilege, was one which the defendant could waive, and one which he might waive by not making it when he ought to make it, or by not making it in a proper way, as well as by not making it at all. It is one of those irregularities which must be promptly availed of. In the present case it must be held that the defendant lost his right to show that he was a citizen and resi-

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dent of Massachusetts, and the motion to set aside the service of the subpoena is denied.

A. V. Briesen, for the plaintiff.

E. C. Webb, for the defendants.

THE UNITED STATES vs. WILLIAM JONES.

Evidence that the accused devised a scheme to put counterfeit money in circulation, by sending through the mail, to one B., a letter calculated to induce B. to purchase counterfeit money at a low price, for the purpose of putting it off as good, and that, in order to carry said scheme into effect, he placed in a post office a letter addressed to B., for the purpose of inducing B. to purchase counterfeit money at a low price, in order that he might put it off as good money, for its face value, is sufficient to establish an offence under § 5,480 of the Revised Statutes, although no evidence is given to show an intention in the accused to defraud B., or any other particular person.

The *corpus delicti*, in such offence, is the mailing of the letter in execution of the unlawful scheme.

On the trial, the Court refused to permit the jury to inspect a copy of the letter proved to have been mailed, which copy the accused made in the presence of the jury: *Held*, no error.

The Court also refused to permit an expert in handwriting to say whether the original letter put in evidence by the Government, and the copy of it made by the accused in the presence of the jury, were in the same handwriting: *Held*, no error.

(Before BLATCHFORD, BENEDIOT and BROWN, JJ., January 23d, 1882.)

BENEDIOT, J. The accused was tried upon an information framed under § 5,480 of the Revised Statutes. Having been convicted, he now moves for a new trial. One ground of the application is, that the evidence failed to make out an offence such as is described in § 5,480. The evidence was, and the jury, under the charge, must have found, that the accused devised a scheme to put counterfeit money in circulation, by sending through the mail, to one Bates, a letter calculated to

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induce Bates to purchase counterfeit money at a low price, for the purpose of putting it off as good. The evidence further showed, and the jury found, that the accused, in order to carry his said scheme into effect, did place in the post office, at New York city, a letter such as is described in the information, for the purpose of inducing Bates to purchase counterfeit money at a low price, in order that he might put it off as good money, for its face value. This evidence was sufficient to make out an offence such as is created by the statute under which this information was framed, notwithstanding the absence of any evidence to show an intention on the part of the accused to defraud Bates or any other particular person. The scheme to defraud, described in the information, may be a scheme to defraud any person upon whom the bad money might be passed, and it is within the scope of the statute, although no particular person had been selected as the subject of its operation. Any scheme the necessary result of which would be the defrauding of somebody is a scheme to defraud, within the meaning of § 5,480 ; and a scheme to put counterfeit money in circulation is such a scheme. We are, therefore, of the opinion, that the offence charged was proved by the evidence.

Another point taken is, that there was no evidence of the *corpus delicti*, except the defendant's admission. But, the gist of the offence consists in the abuse of the mail. The *corpus delicti* was the mailing of the letter in execution of the unlawful scheme. There was direct evidence of the mailing of the letter by some one, and the letter itself showed its unlawful character. This much being shown, it was, certainly, competent to prove that the defendant was the sender of the letter, by his admission to that effect.

Another point made is, that error was committed, at the trial, by the refusal to permit the jury to inspect a copy of the letter proved to have been mailed, which copy the accused made in the presence of the jury. In this there was no error. It is not allowable, upon an issue as to handwriting, to put in evidence papers, otherwise irrelevant,

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merely for the purpose of enabling the jury to institute a comparison of the writing. The statute of the State of New York permitting a comparison of writings, for the purpose of determining handwriting, has no effect upon criminal proceedings in the Courts of the United States. In those Courts, the extent of the rule is to permit the jury to compare writings lawfully in evidence for some other purpose. It has never been permitted to introduce writings for the mere purpose of enabling the jury to institute a comparison of writings. To permit the practice here sought to be established would be to permit the defendant to make evidence for himself.

The last point made is, that error was committed in refusing to permit an expert in handwriting to say whether the original letter put in evidence by the Government, and the copy of it made by the accused in the presence of the jury, were in the same handwriting. Here was no error. It was not shown that the expert knew the defendant's handwriting, and whether the two letters were in the same handwriting was immaterial, except upon the assumption that, because the copy of the letter was made by the defendant, it was in his usual handwriting, an assumption by no means justifiable by the circumstances under which the copy was made.

The motion is, accordingly, denied.

William P. Fiero, (Assistant District Attorney,) for the United States.

Charles S. Spencer, for the defendant.

JAMES F. WHITE AND OTHERS vs. CHESTER A. ARTHUR.

On the 1st of March, 1881, a judgment was docketed in this Court, in favor of the plaintiffs, and against the defendant, for a sum of money, in a suit against a late collector of the port of New York, to recover back money paid to him for customs duties, and by him paid into the Treasury, in the performance of his official duty. Prior to that, and at the trial of the action, the Court, un-

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der § 989 of the Revised Statutes, made a certificate of probable cause. The Government paid to the plaintiffs the amount of the judgment, but refused to pay any interest on such amount. The United States' attorney then applied to the Court to require the plaintiffs to execute a full satisfaction piece of the judgment, or to make an order that full satisfaction of the judgment be entered on the records of the Court: *Held*, that the judgment was satisfied and that the clerk must make all proper entries to that effect in the records of the Court.

The question of the payment of interest by the United States considered, and the legislation and practice on the subject reviewed.

Whatever may have been the practice under the permanent appropriation in the Revised Statutes, and under statutes prior to the appropriation bill of 1878, it is clearly expressed in the appropriation bills of 1878, 1879, 1880 and 1881, that, where there are judgments against collectors of customs for duties paid under protest, interest accruing after judgment, on the amount of the judgment, or on the duties improperly paid, is not to be paid by the Government, either from the permanent appropriation or from the special appropriations.

Where there has been a certificate of probable cause, under § 989, there can be no execution against the collector, and he is not liable, under the judgment, for interest on it.

(Before BLATCHFORD, J., Southern District of New York, January 25th, 1882.)

BLATCHFORD, J. This is a suit against a late collector of the port of New York, to recover back money paid to him for customs duties, and by him paid into the Treasury in the performance of his official duty. On the 1st of March, 1881, a judgment in this suit was docketed in this Court in favor of the plaintiffs and against the defendant, for \$2,295.90. Prior to that, and at the trial of the action, this Court, under § 989 of the Revised Statutes, made a certificate of probable cause. It is provided as follows by § 989: "When a recovery is had in any suit or proceeding against a collector or other officer of the revenue, for any act done by him, or for the recovery of any money exacted by or paid to him and by him paid into the Treasury, in the performance of his official duty, and the Court certifies that there was probable cause for the act done by the collector or other officer, or that he acted under the directions of the Secretary of the Treasury, or other proper officer of the Government, no execution shall issue against such collector or other officer, but the amount so recovered

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shall, upon final judgment, be provided for and paid out of the proper appropriation from the Treasury."

On the 16th of March, 1881, the Commissioner of Customs addressed a circular to the First Auditor of the Treasury, stating that, in view of the decision of the Supreme Court in *United States v. Sherman*, (8 Otto, 565,) and of the decision of the First Comptroller of the Treasury in *Stephani's Case*, (26 Int. Rev. Record, 313,) nothing would thereafter be allowed or paid by the United States on judgments against customs officers, under § 989, beyond the amount recovered on final judgment, excluding interest on the amount of the judgment. The decision in *United States v. Sherman* was made at the October Term, 1878, and that in *Stephani's Case* in August, 1880.

Under instructions from the Commissioner of Customs, dated March 24th, 1881, the collector of the port of New York paid to the plaintiffs \$2,295.91, the amount of the judgment, which was paid and received without prejudice to the claim of the plaintiffs for interest on the judgment from March 1st, 1881. The plaintiffs have never executed any satisfaction piece of the judgment, because the Commissioner of Customs directed the collector not to require one, in order to enable the plaintiffs to procure a judicial determination of the legality of the said decision of the Commissioner of Customs, of March 16th, 1881.

The plaintiffs have not applied to the Supreme Court for a mandamus to compel the Secretary of the Treasury or other officer to pay the interest in question, but the United States' attorney now applies to this Court, on the foregoing facts, to require the plaintiffs to execute and deliver a full and complete satisfaction piece of the judgment, or to make an order that full and complete satisfaction of the judgment be entered on the records of the Court.

Although the Commissioner of Customs directed the collector not to require a satisfaction piece, it must be assumed that the present application is made with the consent of the Treasury Department, and that, although it is in form an ap-

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plication by the defendant, it is also an application by the Government, for the purpose of obtaining a judicial decision as to the liability of the Government to pay the interest. It is so treated by both parties. The United States' attorney relies wholly on the views taken in the decision in *Stephani's Case*. If the Government is liable for the interest, the plaintiffs ought not to be required to now enter satisfaction. But the further question arises, whether the plaintiffs are now bound to enter satisfaction even though the Government may not be liable for the interest.

(1.) The question of the liability of the Government to pay the interest will be first considered. The case of *Stephani* was a judgment against a collector of internal revenue to recover back taxes illegally exacted. It arose under § 989. There was a certificate of probable cause, and the question was whether interest should be paid from the date of that certificate. In his decision the First Comptroller says that the practice theretofore, in his office, had been "to allow interest on judgments from the date of the certificate of probable cause to the time of filing the judgment in the Treasury Department for payment." He holds that the expression "the amount so recovered," in § 989, "as applied to the Government, includes only the sum of the judgment and costs;" that the Government is not liable to pay interest by force of § 966, which provides that interest shall be allowed on all judgments recovered in civil causes in a Circuit Court, because the Government is not named nor intended by clear inference; that the doctrine that interest is an incident of the judgment, and so follows the principal, has no application to judgments against the Government, or to judgments which the Government has, by force of a statute, assumed to pay; that it is specially provided in some cases that the Government shall pay interest on judgments or on debts, as in § 1,090 and in the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 481,) such provision being necessary "because at common law interest would not be paid;" and that, under § 3,220, authorizing the repayment to internal revenue collectors of moneys

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recovered against them in a Court for taxes collected by them, and of damages and costs recovered against them in a suit brought against them by reason of anything done in the due performance of official duty, the practice had been to allow interest on such judgments from the time of rendition until paid, but that could "no longer be permitted."

It is contended for the plaintiffs, that the measure of the responsibility of the Government is the liability of the defendant. There can be no doubt that the liability of the defendant to the plaintiff, under the judgment, under § 966 of the Revised Statutes, is not only for the amount of the judgment but for interest on it, unless that liability is barred by other statutes. It is provided as follows by § 966: "Interest shall be allowed on all judgments in civil causes, recovered in a Circuit or District Court, and may be levied by the marshal under process of execution issued thereon, in all cases where, by the law of the State in which such Court is held, interest may be levied, under process of execution, on judgments recovered in the Courts of such State; and it shall be calculated from the date of the judgment, at such rate as is allowed by law on judgments recovered in the Courts of such State." But the question is whether the Government has assumed to its full extent, by § 989, the liability of the defendant. It is very clear that it has not, even without reference to § 966, because, by § 989, not only is it necessary that there shall have been a recovery against the collector, but there must be a certificate of probable cause, before the liability of the Government begins. This is what was decided in *United States v. Sherman*, a case to which the provisions of § 12 of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 741,) now § 989 of the Revised Statutes, were applied by § 8 of the Act of July 28th, 1866, (14 *Id.*, 329.) In that case there was a judgment, in June, 1869, against an agent of the Treasury Department. There was no certificate of probable cause made till June, 1874, and then it was obtained by the plaintiff in the judgment and not by the defendant. The Treasury Department then paid to the plaintiff in the judgment the amount of it,

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with interest from the date of the certificate of probable cause. The plaintiff then applied to the Supreme Court for a mandamus to compel the payment of the interest from the date of the judgment to the date of the certificate. The application was denied. The Court held that no claim against the Government arose under § 12 of the Act of 1863, as applied to that case, until the certificate was made, and that the Government was not liable for the interest which accrued on the judgment prior to the making of the certificate.

In the present case the certificate was made before the judgment was entered, but still the question remains whether the Government is liable for interest on the judgment from its date, if a certificate of probable cause was made prior to or at the time of the date of the judgment. This point was not decided in *United States v. Sherman*.

It is well settled that the liability of the Government for the interest claimed in this case must be created by some statute. There is no contract by the Government or any of its authorized agents to pay interest. There is no judgment against the United States. There is no suit against the United States. There is no liability of the United States till after a recovery against the collector and a certificate of probable cause. So, the question arises as to the construction of § 989. "As a general rule, the Government does not pay interest. The exceptions to this rule are found only in cases where the demands are made under special contracts or special laws, expressly providing for the payment of interest. An obligation to pay it is not to be implied against the Government, as it is against a private party, from the mere fact that the principal was detained from the creditor after the right to receive it had accrued." (9 *Opinions of Attorneys-General*, 59.) The principle that interest is not recoverable against the Government if it unreasonably delays payment of its debts, as it would be against a citizen, and the further principle that interest is not to be allowed on claims presented to the Departments, unless it is specially provided for, are recognized by

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the Supreme Court in *Tillson v. United States*, (10 Otto, 43, 47.)

The plaintiffs contend, however, that the interest on the judgment in this case is expressly provided for by statute. A review of the history of legislation and adjudication in respect to suits against collectors to recover back customs duties illegally exacted will aid in a decision as to the meaning of the present statutory provisions ; and legislation in regard to paying interest on other claims and on judgments for them may also be referred to.

Prior to the enactment of § 2 of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 348,) the moneys paid to a collector of customs for unascertained duties or for duties paid under protest against the rate or amount of duties charged, were retained by the collector. That Act required such moneys to be paid into the Treasury, and made it the duty of the Treasury Department to refund overpayments, made under protest, out of any money in the Treasury not otherwise appropriated. In 1845, it was decided by the Supreme Court, in *Cary v. Curtis*, (3 *Howard*, 236,) that the effect of § 2 of that Act was to take away the right to bring an action against the collector, for moneys illegally exacted by him as and for duties, and paid to him under protest, where he had paid them into the Treasury before suit brought. This decision was followed by the Act of February 26th, 1845, (5 *U. S. Stat. at Large*, 727,) which provided that nothing in § 2 of the Act of 1839 should be construed to take away the right of any person paying money as and for duties, under protest, to a collector, in order to obtain goods imported by him, the duties not being authorized by law, to maintain an action at law against the collector to try the legality and validity of the demand and payment of duties, and to have a trial by jury touching the same ; or to authorize the Secretary of the Treasury to refund any duties paid under protest. This legislation restored the right to sue the collector. Of course, a judgment against him could be enforced by execution against him, and, under § 8 of the Act of August 8th, 1842, (5 *U. S. Stat. at Large*,

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518,) now § 966 of the Revised Statutes, interest on such judgment from its date could be collected by execution against him.

On the 8th of August, 1846, an Act was passed, (9 *U. S. Stat. at Large*, 84 and 675,) providing for the payment by the Secretary of the Treasury to six different parties named, of any excess of duties paid by them to the collector of the port of New York, upon the importation of certain specified goods, beyond what the same were legally chargeable with, and in four of the six cases interest on the excess is specified as to be paid, the direction as to three of the four being that it is to be interest from the time of the payment to the collector. By § 2 of that Act the Secretary is authorized, out of any money in the Treasury not otherwise appropriated, "to refund to the several persons entitled thereto such sums of money as have been illegally exacted by collectors of the customs under the sanction of the Treasury Department, for duties on imported merchandise," since March 3d, 1833, "provided, that, before any such refunding, the Secretary shall be satisfied, by decisions of the Courts of the United States upon the principle involved, that such duties were illegally exacted, and provided, also, that such decisions of the Courts shall have been adopted or acquiesced in by the Treasury Department as its rule of construction." In this § 2 nothing is said about paying the amounts of judgments, or about paying interest on judgments, or about paying interest on sums illegally exacted, but it is the sums illegally exacted which are to be refunded, and the refunding is made to depend on the adoption of, or acquiescence in, the decision of the Court by the Treasury Department. There is nothing in this § 2 to indicate that it was limited to cases of duties paid under protest, while under the Act of February 26th, 1845, suits could be brought against a collector only where duties had been paid under protest. On the 10th of August, 1846, an Act was passed, (9 *U. S. Stat. at Large*, 677,) directing the refunding to a party named of "the balance remaining unpaid, and interest thereon," of a judgment recovered by him in this Court, against a collector of this

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port, for the recovery of duties illegally exacted, "a part of which judgment has been heretofore paid." This general and special legislation indicates an intention in Congress to specify interest when it is to be paid. Like instances of refunding to parties named duties illegally or erroneously collected on imports, but without mentioning interest, are found in Acts passed June 28th, 1848, and March 3d, 1849, (9 *U. S. Stat. at Large*, 720, 780.)

The Act of March 3d, 1857, § 5, (11 *Id.*, 195,) provided for an appeal to the Secretary of the Treasury, after protest, from the decision of a collector as to the liability of imported goods to, or their exemption from, duty, and made the decision on such appeal final, unless suit should be brought within 30 days after such decision.

By the Act of April 11th, 1860, (12 *Id.*, 837,) provision is made for the repayment, with interest at 6 *per cent. per annum* from the date of exaction, of certain duties illegally exacted, as tonnage and light duties, while by the Act of March 2d, 1861, (*Id.*, 690,) provision is made for the repayment of a certain amount erroneously paid as duties, nothing being said about interest. Like provisions, with no mention of interest, are made by the Acts of May 1st, 1862, and February 18th, 1863, (*Id.*, 903, 917.)

By the Act of March 3d, 1863, § 31, (*Id.*, 729,) the Commissioner of Internal Revenue, subject to the regulations of the Secretary of the Treasury, was authorized "to remit, refund and pay back all duties erroneously or illegally assessed or collected, and all judgments or sums of money recovered in any Court against any collector or deputy collector, for any duties or licenses paid under protest." That provision referred solely to internal revenue and is superseded by later provisions of law.

By § 12 of the Act of March 3d, 1863, (*Id.*, 741,) the provision was enacted which is now found in § 989 of the Revised Statutes, as before quoted. By § 13 of the same Act it was made the duty of the District Attorney of the District within which any suit should be brought against a collector

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or other officer of the revenue, for any act done by him, or for the recovery of any money exacted by or paid to him, which should have been paid into the Treasury of the United States, to appear on behalf of such officer, unless otherwise instructed by the Secretary of the Treasury, and to make a report in regard to such suits annually to the Solicitor of the Treasury, and it was directed that the same should be reported annually to Congress, "with a statement of all moneys received by the Solicitor and by each District Attorney" under the Act. Most of these provisions of § 13 are now in §§ 771 and 773 of the Revised Statutes. By said § 12 it was also provided, that when, in any such suit, any district or other attorney should be directed to appear on behalf of such officer by any proper officer of the Government, such attorney should be allowed such compensation for his services therein as should be certified by the Court to be reasonable and proper, and approved by the Secretary of the Treasury. This provision is now in § 827 of the Revised Statutes.

By § 7 of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 766,) now §§ 1,089 to 1,093 of the Revised Statutes, interest on judgments rendered by the Court of Claims is not to be paid unless the United States have appealed, and then interest at the rate of 5 *per cent. per annum* is to be paid from the time a certified copy of the judgment is presented to the Secretary of the Treasury for payment.

By § 14 of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 215,) an appeal to the Secretary of the Treasury from the decision of the collector of customs as to the rate and amount of duties, costs and charges on imported goods was provided for, after protest, with the requirement that a suit to recover back the duties should be brought within ninety days after the decision. This is now § 2,931 of the Revised Statutes. By § 16 of the same Act it was provided as follows; "Whenever it shall be shown to the satisfaction of the Secretary of the Treasury that, in any case of unascertained duties, or duties or other moneys paid under protest and appeal, as hereinbefore provided, more money has been paid to

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the collector, or person acting as such, than the law requires should have been paid, it shall be the duty of the Secretary of the Treasury to draw his warrant upon the Treasurer in favor of the person or persons entitled to the over-payment, directing the said Treasurer to refund the same out of any money in the Treasury not otherwise appropriated." Nothing was said about interest. The provision is now § 3,012½ of the Revised Statutes. A provision in regard to the paying back by the Commissioner of Internal Revenue, on appeal to him, of internal revenue duties erroneously or illegally assessed or collected, was enacted by § 44 of the Act of June 30th, 1864, (*Id.*, 239,) which provided for repaying "to collectors or deputy collectors the full amount of such sums of money as shall or may be recovered against them or any of them, in any Court, for any internal duties or licenses collected by them, with the costs and expenses of suit, and all damages and costs recovered against assessors, assistant assessors, collectors, deputy collectors, and inspectors, in any suit which shall be brought against them, or any of them, by reason of anything that shall or may be done in the due performance of their official duties." This enactment is now found in § 3,220 of the Revised Statutes.

By § 7 of the Act of July 28th, 1866, (14 *Id.*, 328,) the Secretary of the Treasury was authorized to refund duties overpaid, although the provisions of said § 14 of the Act of June 30th, 1864, had not been complied with, on being satisfied that such non-compliance was owing to circumstances beyond the control of the importer.

By § 3,689 of the Revised Statutes, passed June 22d, 1874, permanent annual appropriations were made, out of any moneys in the Treasury not otherwise appropriated, of such sums as might be necessary for refunding duties erroneously or illegally assessed or collected under the internal revenue laws, and the excess of deposits for unascertained customs duties or customs duties paid under protest.

On the 3d of March, 1875, (18 *U. S. Stat. at Large*, 469,) an important Act was passed. It provided as follows: "No

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moneys collected as duties on imports, in accordance with any decision, ruling, or direction previously made or given by the Secretary of the Treasury, shall, except as hereinafter provided, be refunded or repaid, unless in accordance with the judgment of a Circuit or District Court of the United States giving construction to the law, and from which the Attorney General shall certify that no appeal or writ of error will be taken by the United States, or unless in pursuance of a special appropriation for the particular refund or repayment to be made: *Provided*, That whenever the Secretary shall be of opinion that such duties have been assessed and collected under an erroneous view of the facts in the case, he may authorize a re-examination and re-liquidation in such case, and make such refund in accordance with existing laws as the facts so ascertained shall, in his opinion, justify; but no such re-liquidation shall be allowed unless protest and appeal shall have been made as required by law." This does not require a judgment in the particular case, but only a judgment construing the law, which might be had in another case. It does not refer to the payment of a judgment but to the refunding of moneys collected.

By the Act of February 15th, 1876, (19 *U. S. Stat. at Large*, 3,) provision was made for the payment, under judgments rendered by the Court of Commissioners of Alabama claims, of said judgments with interest on the principal at 4 *per cent. per annum*, from the date of loss until notice should be given for payment.

In § 3 of the appropriation bill passed June 14th, 1878, (20 *U. S. Stat. at Large*, 128,) is the following provision: "For repayment to importers the excess of deposits for unascertained duties, or duties or other moneys paid under protest, including interest and costs in judgment cases, two hundred and fifty thousand dollars: *Provided*, that no portion of this appropriation shall be expended for the payment of claims known as the 'charges and commissions cases.'" In § 1 of the appropriation bill passed March 3d, 1879, (*Id.*, 384,) is the following provision: "To enable the Secretary of the

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Treasury, in his discretion, to refund excess of duties and to pay costs in suits and proceedings in charges and commissions cases, in which judgments may hereafter be obtained, or which may be compromised by said Secretary, fifteen thousand dollars." In § 1 of another appropriation bill passed March 3d, 1879, (*Id.*, 414,) is this provision: "The unexpended balance of the appropriation of two hundred and fifty thousand dollars, made by the Act of June fourteenth, eighteen hundred and seventy-eight, for the repayment to importers of the excess of deposits for unascertained duties, or duties or other moneys paid under protest, including interest and costs in judgment cases, is hereby continued and made available for the payment of all claims to which the appropriation is applicable, which are not payable from the permanent annual appropriation provided for in section thirty-six hundred and eighty-nine of the Revised Statutes; *Provided*, That the claims known as the 'charges and commissions cases' shall not be paid without further legislation." The permanent annual appropriation did not include "interest and costs in judgment cases." Hence, probably, the necessity of a special appropriation. The question is—what do the words "interest and costs in judgment cases" mean? Do they include interest after judgment, either on the judgment or on the excess of duties? In regard to judgments in "charges and commissions cases," only excess of duties and costs were provided for, nothing being said about interest.

In § 1 of the appropriation bill passed June 16th, 1880, (21 *Id.*, 242,) is the following provision: "For the repayment to importers the excess of deposits for unascertained duties, or duties or other moneys paid under protest, including interest and costs in judgment cases, three hundred thousand dollars, which sum is hereby made available for the payment of all claims to which the appropriation is applicable, which are not payable from the permanent annual appropriation provided for in section thirty-six hundred and eighty-nine, Revised Statutes; *Provided*, That no portion of this appropriation shall be expended for the payment of claims known as

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“charges and commissions cases.’” In the same section is the following: “To enable the Secretary of the Treasury, in his discretion, to pay judgments in charges and commissions cases, obtained since January, eighteen hundred and seventy-nine, and which may be hereafter obtained, or to settle any of said cases, in his discretion, by compromise, seventy-five thousand dollars, or so much thereof as may be necessary.” Here the provision is to pay judgments, but nothing is said about interest on judgments. In § 1 of the appropriation bill passed March 3d, 1881, (*Id.*, 418,) is a provision in the same words as the one first above cited from the Act of June 16th, 1880.

It may be admitted that such a suit as the present is a private suit until there is a certificate of probable cause. Then the United States come in and assume, by statute, a certain liability. The question is as to what liability. The plaintiffs contend that the United States assume all the liability which would be that of the defendant if the United States assumed no liability. The case of *Erskine v. Van Arsdale*, (15 *Wallace*, 75,) cited by the plaintiffs, was a suit to recover back an internal revenue tax, illegally collected. The Court had instructed the jury that they might, in their verdict, add interest to the tax paid. This was held by the Supreme Court to be correct. The only decision is that interest might be added from the time of the illegal exaction to the verdict. Nothing is decided as to interest on the judgment, when the Government comes to pay it. The interest put into the verdict is put in before there is any certificate of probable cause, and, if there is none, the Government assumes no part of the liability of the defendant.

The allowance of interest as damages, on a writ of error, under § 1,010 of the Revised Statutes, and under Rule 23 of the Supreme Court, and the form of the mandate in affirming, with interest, a judgment where the collector is the plaintiff in error, cannot affect the question here. These things all of them belong solely to the putting the judgment in shape as one in a private suit.

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Nor does the language "including interest and costs in judgment cases" mean interest on judgments. It is entirely satisfied by confining it to the interest included in the amount of the judgment and the costs forming part of that amount. The "amount so recovered," referred to in § 989, being more than the amount exacted and paid, because including in addition interest and costs, was probably regarded as needing explanation to make it clear that it was not merely the amount exacted that was to be refunded, but also the interest and costs forming part of the recovery, that is, of the judgment. The mention of "costs" is indicative of the meaning of "interest." There are no costs after judgment; and, as "costs" are costs before judgment, so "interest," in the same connection, is interest before judgment.

The legislation before recited shows that Congress has sometimes provided for interest on judgments and sometimes for interest on excessive duties and has sometimes omitted the mention of interest. The result of this review is, that whatever may have been the practice under the permanent appropriation in the Revised Statutes, and under statutes prior to the appropriation bill of 1878, it is clearly expressed in the appropriation bills of 1878, 1879, 1880 and 1881, that, where there are judgments against collectors of customs for duties paid under protest, interest accruing after judgment, on the amount of the judgment or on the duties improperly paid, is not to be paid by the Government, either from the permanent appropriation or from the special appropriations. Hence, all has been paid by the Government in this case which it is obliged to pay.

(2.) Under § 989, as there has been a certificate of probable cause in this case, there can be no execution against the collector. There cannot be an execution against him for the interest from March 1st, 1881, on the view that, under § 966, interest is due on the judgment as one against the collector personally, and that § 989 only means that there is to be no execution against him for what the Government pays. He is required to pay the money into the Treasury. He does so.

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The District Attorney is required to defend the suit and is paid by the Government for doing so. The suit is one which can be brought only because Congress allows it to be brought. Congress could prevent its being brought. It did so by the Act of 1839, as was held in *Cary v. Curtis*. Then it restored the right by the Act of 1845. But the suit is one only "to try the legality and validity of the demand and payment of duties," as the Act of 1842 says. When the collector has paid the money into the Treasury, and there is a certificate of probable cause, it is clearly the intention of § 989, that the collector shall not be liable, under the judgment, for interest on it, if the Government is not liable under that section for interest on it. The object of the suit and the judgment is solely to put the claim into an adjudicated shape. What is to be paid on it either by the collector or the Government is a matter to be determined by Congress. It follows that the defendant is not liable to pay the interest in question.

As everything has been paid on the judgment which is legally payable on it, under existing laws, the judgment is satisfied, and an order will be entered to that effect and directing that the clerk enter in the records of the Court all proper entries to show that the judgment is satisfied.

Hartley & Coleman, for the plaintiffs.

Stewart L. Woodford, (*District Attorney*), for the defendant.

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GEORGE W. HARRIS AND JAMES B. LEONARD

vs.

HENRY HESS AND JONAS HESS.

H., on behalf of G., sold to a national bank a promissory note, not due, and received from the bank the purchase price, and delivered the note to the bank. H. gave to G. a cheque for the proceeds, less \$3 77 commission. Before the cheque was paid, the said bank learned that when the note was sold its maker had suspended payment, and notified H. of the fact and tendered back the note and demanded back the purchase money. H. then stopped payment of the cheque, and G. brought this suit against H., on the cheque, to recover its amount. The said bank claimed from H. the entire proceeds. H., then, on notice to said bank and to the attorney for G., applied to this Court to substitute said bank in place of H., as defendant in this suit, and to discharge H. from liability to either G. or said bank, concerning the claim sued on, on H. paying the money into Court. The application was granted, as being a practice provided for in a suit at law, by § 820 of the New York Code of Civil Procedure, and adopted by § 914 of the Revised Statutes, and H. was ordered to pay into Court the entire proceeds.

The said bank having, after notice of said application was served on it, sued H. in a Court of the State of New York, to recover the money so paid by it to H.: *Held*, that the bringing of such suit did not affect the jurisdiction of this Court to grant the application.

(Before BLATCHFORD, J., Southern District of New York, January 27th, 1882.)

BLATCHFORD, J. The defendants, on behalf of the plaintiffs, sold to the Hanover National Bank a promissory note, not overdue, and received from that bank the purchase price, and delivered the note to the bank. The defendants gave to the plaintiffs a cheque on a bank for the proceeds of the note, less \$3 77 commission. Before the cheque was presented to the bank or paid, the Hanover Bank having ascertained that, when the note was sold, the makers of it, a firm in New Orleans, had suspended payment, notified the de-

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defendants of the fact and tendered the note back to them and demanded back the purchase money. Thereupon the defendants stopped the payment of the cheque. The plaintiffs, citizens of Pennsylvania, then brought this suit in this Court against the defendants, citizens of New York. The Hanover National Bank appears by the papers to be a corporation doing business in the city of New York, and having its place of business in that city, and to be a banking association created by and under the laws of the United States. It is, therefore, to be regarded as a citizen of New York. This suit is a suit on the cheque which the defendants gave to the plaintiffs, and the amount sought to be recovered is \$1,486 41, with interest from November 29th, 1881. The amount of the claim of the Hanover Bank against the defendants is \$1,490 18, with interest from November 30th, 1881. This suit was commenced December 19th, 1881.

It is provided by § 820 of the New York Code of Civil Procedure, that a defendant against whom an action to recover upon a contract is pending may, at any time before answer, upon proof, by affidavit, that a person, not a party to the action, makes a demand against him for the same debt, without collusion with him, apply to the Court, upon notice to that person and the adverse party, for an order to substitute that person in his place, and to discharge him from liability to either, on his paying into Court the amount of the debt; and that the Court may, in its discretion, make such an order. This is a proceeding in a suit at law to substitute one defendant for another. It is a proceeding adopted by § 914 of the Revised Statutes. The defendants, before answer, served on the Hanover Bank and on the attorney for the plaintiffs, on the 10th of January, 1882, the proper papers with notice of an application to be made to this Court, on the 13th of January, to substitute the Hanover Bank in the place of the defendants and to discharge the defendants from liability to either the plaintiffs or the Hanover Bank concerning the claim or debt mentioned in the complaint herein, on the

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defendants' paying into this Court \$1,486 41. The application was adjourned by consent from January 13th to January 20th, and was made on the latter day. On January 19th or 20th, the Hanover Bank commenced a suit against the defendants, in a Court of this State, to recover the said \$1,490 18, with interest from November 30th, 1881. The defendants are willing to pay into Court \$1,490 18, with interest from November 29th, 1881. Both the plaintiffs and the Hanover Bank oppose the application.

The defendants have money which they received from the Hanover Bank. It is claimed by each of the two parties. It is claimed directly by the Hanover Bank, as the money which it paid to the defendants; and, although the suit in this Court is brought on the cheque, yet it is really a suit to recover the money which the Hanover Bank paid to the defendants, as being the money of the plaintiffs. The plaintiffs can be in no better position, as regards the real transaction, than if no cheque had been given. The cheque was given under a mistake of fact. The rights of the plaintiffs as against the money and the defendants, and as against the claim of the Hanover Bank to the money, are no different now from what they would be in a suit by the Hanover Bank against the plaintiffs to recover back from them money paid by the plaintiffs to them directly, as the purchase price of the note. Whether the plaintiffs or the Hanover Bank have the better right to the money is a question not to be settled on this application. The defendants are not questioning the title of the plaintiffs to the note, and as to the money the defendants are mere stakeholders.

The case is clearly one within the State statute. The application has relation back to the time when notice of making it was served, and the bringing of the suit in the State Court subsequently by the Hanover Bank cannot affect the jurisdiction of this Court to grant the application. It is granted and the order to be made will be made *nunc pro tunc* as of the day for which the application was first noticed. The

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amount to be deposited in Court will be \$1,490 18, with interest from November 29th, 1881.

James S. Stearns, for the plaintiffs.

Lauterbach & Spingarn, for the defendants.

Moore, Low & Sanford, for the Hanover Bank.

GEORGE CAMPBELL AND JOHN CLUTE

vs.

LUKE KAVANAUGH. IN EQUITY.

The claims of re-issued letters patent No. 8,391, granted to George Campbell and John Clute, September 3d, 1878, for an "improvement in burrs for knitting-machines," the original patent, No. 48,636, having been granted to W. H. Carr and M. P. Akin, July 26th, 1864, for an "improvement in knitting-machine burrs," on the invention of said Carr, considered, in view of the specification and claims of the original patent.

A hub, composed of two slotted rings, secured together, with an outwardly narrowed annular space between the inner ends of the rings, is not claimed in the re-issue, either by itself or in combination with the rings, but such a hub was claimed in claim 2 of the original, and was claimed in combination with the rings, in claim 3 of the original, and was made a prominent feature of invention in the original. The original showing that the inventor had no idea of using hub rings not slotted, or of an interior annular space in a hub not formed of two slotted rings, claims 2 and 3 of the re-issue must be construed as referring to no hub other than one formed of two slotted rings, and to no annular space except one between two slotted hub rings.

The patent is not infringed by making and selling rings like the ring of the patent, if they are not sold to be used in a burr like that of the patent, there being no claim in the patent to a ring other than a ring to be used in a hollow slotted hub.

(Before BLATCHFORD, J., Northern District of New York, January 28th, 1882.)

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BLATCHFORD, J. This suit is brought on re-issued letters patent No. 8,391, granted to the plaintiffs, September 3d, 1878, for an "improvement in burrs for knitting-machines," the original patent, No. 43,636, having been granted to W. H. Carr and M. P. Akin, July 26th, 1864, for an "improvement in knitting-machine burrs," on the invention of said Carr. The specification of the re-issue is not signed by Carr but is signed by Campbell and Clute. It is as follows, including what is inside of brackets and what is outside of brackets, omitting what is in italics: "Figure 1 is an end view [...] Fig. 2 [is] a side view with part of the blades removed [...] and Fig. 3 [is] a section [as indicated by] *at or about* the [lines] *line z z* in Fig. 1 [...] of a *knitting-machine burr embodying my invention*; and Fig. 4 is a side view of one of the [wings or] blades [...] and Figs. 5 and 6 [are] perspective views of the two parts of the slotted hub which holds the blades, and Fig. 7 [is] a side view of the [screw-bush] *part* by which the two parts of the slotted hub are secured together [...] *in that burr, like* [Like letters of reference indicate like] parts [in the several] *being marked by the same letters in all the figures.* [figures of the drawings.] *Before this invention burrs for knitting-machines had been made with removable wings or blades, clamped in a slotted hub in such manner that the blades, when broken or worn out, could be readily removed and replaced by new ones, upon simply loosening or removing the devices by which the blades were clamped in the slotted hub, examples of such knitting-burrs being shown in the specifications and drawings of English patent No. 10,724, granted in the year 1845, and United States Letters Patent No. 35,565, dated June 10th, 1862. But, in such knitting-burrs, the removable blades were secured in a slotted hub by rings or disks clamped against the lateral edges of the blades, outside of the slotted part of the hub, at its ends; so that that part of the body of the burr which held the blades had a considerably greater thickness than the slotted part of the hub in which the blades were inserted, which greater thickness rendered the burr much more*

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bulky and far less convenient to use in some kinds of knitting-machines than the common knitting-burr having blades of like width soldered fast in a simple slotted hub. [This invention consists in the peculiar construction of the removable wings or blades of knitting-machine burrs, and also in the combination of such wings or blades with the hub and bush, whereby a more complete and efficient knitting-machine burr is produced than heretofore, and in which the necessity for clamping the removable blades at their extreme ends, as has heretofore been done, is avoided. * * *]

Now one part of my invention consists in making the inner ends of removable wings or blades, A, of knitting-machine burrs, each with a dovetail or flaring projection, b, fig. 4, and two shoulders, c, c, one on each side of the said flaring projection, in such manner that blades thus formed can be firmly secured in a hollow slotted hub of suitable construction, by means of devices located within or inside of the hub, instead of at the outer ends or on the outside thereof. Another part of my invention consists in making a slotted [The] hub [is constructed] for a knitting-machine burr of two separable rings, D, D', [see Figs. 5 and 6, which are provided with central holes to receive the screw-bush] having equal series of slots, e, e, in and around them, and held together end to end by a central screw bolt F, or its equivalent, and [with oblique slots, e, e, Figs. 5 and 6, and have] having the unslotted inside parts of their inner ends, g, g, made hollowing or inclined outward toward each other, [substantially as shown in Figs. 3, 5, and 6] so as to form thereby an outwardly-narrowed annular space, h, [see] Fig. 3, between the two hub rings [.] in such manner that a series of separate knitting-burr blades of suitable size and shape can be freely inserted and firmly clamped within and by the said united hub rings themselves, without the aid of any other device or devices. [The hub ring D' is provided with a screw-thread, substantially as shown in Fig. 5. The central screw-bush F, or its equivalent, is constructed, substantially as shown in Figs. 3 and 7, of a diameter to fit the central hole in ring D, and is provided

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with a central hole, see Fig. 3, to receive the arbor or stud upon which the burr revolves. This bush is provided upon one end with a collar of somewhat longer diameter than the central hole in ring D, (see Figs. 3 and 7,) and upon the other end with a screw-thread which fits and screws into the screw in the central hole of ring D'. The blade or wing A, (see Fig. 4,) is constructed from sheet metal of proper thickness in the ordinary way, and is provided with and has attached to its inner edge the dovetail or flaring projection *b*, wider at its inner extreme end than at the point where it is joined to the blade or wing. The ring D is placed upon the screw-bush F close to the collar, (see Fig. 3,) and the ring D' is screwed upon the screw of the bush F a proper distance. The rings are adjusted so that the slots *e, e*, exactly correspond with each other when on the bush F'. A series of wings or blades, A, are placed in proper position successively in the slots *e, e*, with the dovetails or flaring projections *b* extending into the outwardly-narrowed annular recess *h*, formed by and between the ends *g, g* of the hub-rings D D', (see Figs. 3, 5 and 6,) and the screw-bush F is then firmly screwed into the ring D'. This action of the screws closes together endwise the two hub rings D D'] *And another part of my invention consists in the arrangement of a series of knitting-burr blades, A, each having on its inner end a dovetail or flaring projection, b, and shoulders, c, c, on both sides thereof, in combination with a knitting-burr hub composed of two rings, D, D', having equal series of slots, e, e, in and around them, and held together end to end by a central screw bolt F, or its equivalent, with the inside unslotted part, g, g, of their inner ends inclined outward toward each other in such manner [as to cause their] that the said inclined inner ends g, g, [to] of the hub rings clamp against the inclined edges, i, i, of the flaring projections [or dovetails on] b of the blades [or wings] and [thus] thereby draw and hold [them into place] the blades into and with their [edges] shoulders, c, c, [tightly pressed] tight against the bottoms of the [oblique] slots e, e in the hub-rings [.]; and thus produce*

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[From this it will be seen that] a cheap and durable knitting-burr [is produced,] from which any or all of its blades can be readily removed and replaced by others, [by] *upon* simply [unscrewing the screw-bush F, thereby] loosening the hub rings [and] in which the blades are clamped [.] *in a slotted hub, not only by means of devices located inside of the hub, but by means of the inner ends of the two united hub-rings that constitute the slotted hub itself.* [This] *And such a* knitting-burr is thinner and lighter, and *generally* more readily applied to knitting-machines of close and compact construction than a knitting-burr having projected blades of like width clamped in a slotted hub by means of devices applied to the [ends] *edges* of the blades *at the outer ends or on the outside of the slotted hub.*" Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, gives the text of the original specification.

The claims of the re-issue are as follows: "1. A knitting-burr blade, A, having on its inner edge a dovetail or flaring projection, *b*, and shoulders *c, c*, substantially as herein described. 2. A series of knitting-burr blades or wings having a dovetail or flaring projection on the inner edge of each, in combination with a hub having oblique slots and an outwardly-narrowed annular space wherein the dovetails or flaring projections of the blades are secured. 3. The combination of a series of wings or blades having a dovetail or flaring projection on the inner edge of each, a hub having oblique slots and an outwardly-narrowed annular space, and a central hollow screw-bush or its equivalent, all operating together, as described, so as to clamp within the outwardly-narrowed annular space the edges of the dovetails or flaring projections, substantially as described."

The claims of the original patent were as follows: "1. A knitting-burr blade, A, having on its inner end a dovetail or flaring projection, *b*, and lateral shoulders, *c, c*, substantially as herein described. 2. A knitting-burr hub composed of two rings, D, D', slotted and secured together end to end, and

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having an outwardly-narrowed annular space, *h*, formed by and between the inner ends of the said united hub rings, substantially as herein described. 3. The combination of a series of wings or blades, *A*, each having a dovetail or flaring projection, *b*, and shoulders, *c*, *c*, on its inner end, with a hub composed of two rings, *D*, *D'*, slotted and clamped together end to end, and having an outwardly-narrowed annular recess, *h*, formed by and between the inner ends of the said united hub-rings, substantially as herein described."

It cannot fail of observation, that the hub, composed of two slotted rings, secured together, with an outwardly-narrowed annular space between the inner ends of the rings, is not claimed in the re-issue either by itself or in combination with the wings. Such a hub is claimed in claim 2 of the original. Such a hub in combination with the wings is claimed in claim 3 of the original. Such a hub is made a prominent feature of invention in the original, so that the wings may be clamped between and by the rings without other device. In claims 2 and 3 of the re-issue the effort seems to be to reduce the hub to a hub not necessarily of two slotted rings, and to a hub having an outwardly-narrowed annular space somewhere but not between the inner ends of two slotted hub rings. It is clear from the description and drawings of the original patent that Carr had no idea of an annular space anywhere except between the two slotted hub-rings, a hollow interior annular space in a hub formed of two slotted rings. The description in the re-issue speaks only of "an outwardly-narrowed annular space, *h*, between the two hub-rings," which are both of them slotted rings. Therefore, the "hub" in claims 2 and 3 of the re-issue must be construed to be only a hub formed of two slotted rings, and the "outwardly-narrowed annular space" in those claims must be construed to be only such a space when it is a hollow space between two slotted hub-rings. The original specification points out that the old way of securing removable rings in a slotted hub was to press discs against their edges outside of

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the end of the slotted part, and that Carr's idea was to put the pressing device, and, of course, the part to be pressed, inside of the hub. He did this by a hollow hub, made of two separable rings, having an outwardly-narrowed annular space between them, and put into this space a correspondingly shaped dovetail attached to the wing in the slot, and made the rings press against the inclined edges of the dovetail, and so hold it tightly against the bottom of the slot. Under the above construction the defendant does not infringe claims 2 and 3 of the re-issue.

In the defendant's burr No. 7, the hub is in one piece and not in two. There is no hollow space between two rings. The wings No. 6 have a projection downward at one end, which projection is bevelled on its inner edge. That edge comes against a shoulder on one face of the hub, and a disc outside next that face presses against the edges of the wings. This disc is no part of the hub. It is not slotted. It is pressed up by a screw bolt and holds the wings in place. It does so in substantially the same manner referred to as old in the original specification.

The wings No. 6 are no infringement of claim 1. They have but one shoulder and could not be used in the Carr burr.

The wings No. 5, made and sold by the defendant, though like Carr's wing, were not sold to be used in a burr made like Carr's. Carr's burr, it is shown, went out of use, and was superseded by forms not covered by the patent. The burrs in which such wings were to be used were not covered by the patent, because they did not have a hub of two slotted rings. The wing *per se* is useless, and it was not sold to be used, nor was it used, in any infringing structure. Hence, the patent was not infringed by making or selling it. Claim 1 must be limited to a wing to be used in a hollow slotted hub. Otherwise, it is not a claim to any mechanism or to any patentable structure, but only to a piece of metal of a certain shape, incapable of use till incorporated in another structure. The article is not Carr's knit-

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ting-burr blade, unless it is to be used in the manner pointed out in the patent.

The bill must be dismissed, with costs.

E. S. Jenney, for the plaintiffs.

E. Cowen, for the defendant.

ANSON SEARLS

vs.

JOHN O. MERRIAM AND PERRY D. RANDALL. IN EQUITY.

The claims of letters patent No. 221,482, granted to Anson Searls, as assignee of John M. Underwood, the inventor, November 11th, 1879, for an "improvement in whip sockets," namely, "1. The combination with a whip socket having an annular recess in it, of a flexible elastic ring, which may be held in such recess by its own elastic force, and which is provided on its inner edge with non-contiguous projections, separated so that they cannot be pressed into contact with one another by the insertion of the whip stock into the ring. 2. The ring composed of a body with such projections."—are invalid, for want of invention.

A ring with inward non-contiguous projections existed before, though not used with the annular recess, and the annular recess existed before, used with a plain ring.

(Before BLATCHFORD, J., Southern District of New York, January 30th, 1882.)

BLATCHFORD, J. This suit is brought on letters patent No. 221,482, granted to the plaintiff, as assignee of John M. Underwood, the inventor, November 11th, 1879, for an "improvement in whip sockets." The whip socket is formed of a hollow cylinder, the upper open end of which is provided with a flexible elastic ring of india rubber or analogous material, for the purpose of holding the whip stock upright by

the pressure between it and the interior of the ring. The ring fits in a recess or annular groove in the upper open end of the socket, so as to be retained therein by its own elastic expansive force. The inner edge of the ring is corrugated, or provided with projections formed on and extending from the inner edge of the body of the ring, inwards towards its centre. These projections are entirely separated from each other, with spaces between them, so that they will not be pressed into contact with one another, by the insertion of the butt of the whip stock in the socket. The extreme inner faces of the projections form a circle and support the stock by pressing against it, while they yield to permit it to be pushed in or drawn out, and the ring, though disturbed in place by those movements, will readjust itself in the recess when the stock is removed, because it is held therein by its elastic force alone. The patent has two claims: "1. The combination with a whip socket having an annular recess in it, of a flexible elastic ring, which may be held in such recess by its own elastic force, and which is provided on its inner edge with non-contiguous projections, separated so that they cannot be pressed into contact with one another by the insertion of the whip stock into the ring. 2. The ring composed of a body with such projections."

The specification sets forth that "a simple rubber ring, without projections, had been used, held in an annular recess in the mouth of the socket, the interior of the ring being made small enough to grasp the whip stock, and such a ring has been held in place in the recess in the socket by its own expansive force;" also, that radial slits have been cut in the inner edge of the ring without removing any of the rubber. The point of the new arrangement is stated to be, that "the separated projections, while they are rigid enough to hold the whip upright and prevent it from wobbling, will yet so easily give way to the pressure of the stock as to allow the stock to be readily inserted and removed."

It is obvious that a plain ring, or a ring with radial slits, has the same action in combination with an annular recess, in which it is held by its elastic force alone, so far as regards its

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readjustment in the recess when disturbed, that a ring with inward non-contiguous projections has. The co-action between the recess and the part of the ring in it, when the part of the ring out of it and next the stock is disturbed, is the same in all three cases. Therefore, if the ring with inward non-contiguous projections existed before, even though without the annular recess, there was no patentable invention in using such ring with the old annular recess, with which the plain ring had been used.

The date of the Underwood invention was May, 1878. The rubber disc, defendants' exhibit C, with non-contiguous projections, existed in 1873. The number of projections and the number and size of the openings between the projections depended then, and depends now, on the thickness of the rubber. That fact was then known. It was also then known that the capacity of the rubber to exert the expansive force necessary to maintain its place in the annular recess depended on its substance and thickness. In view of the use in an annular recess of a plain ring of sufficient substance and thickness to maintain its place in the annular recess, the fact that defendants' exhibit C was not used in an annular recess, but was clamped between the end of the socket and a cap, is not sufficient to make it a patentable invention to use in an annular recess a rubber thicker than defendants' exhibit C, with the same character of non-contiguous projections. The action of the inner part of the ring against the stock, so far as the non-contiguous projections are concerned, is the same whether the outer part of the ring is held in an annular recess, or is clamped between the end of the socket and a cap. It is quite apparent, as is stated by the expert for the plaintiff, that the number, or size, or shape of the openings between the projections does not constitute a substantial difference, so long as they are of sufficient size and of a proper shape to permit the stock to pass through the ring without forcing the edges of the projections in contact with each other, and the smaller portions of the projections are extended towards the centre. These conditions are found in defendants' exhibit C. When

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the idea is once suggested, as in that exhibit, to have openings of that character, it is but ordinary knowledge to vary their number and size according to the thickness of the material.

Neither claim of the patent can be sustained, and the bill is dismissed, with costs.

J. P. Fitch, for the plaintiff.

N. Davenport, for the defendants.

SARAH E. HERDSMAN AND OTHERS

vs.

HUGH LEWIS AND OTHERS. IN EQUITY.

A motion for a trial before a jury, in an equity suit, on feigned issues, of certain questions of fact raised by the pleadings, was denied, no testimony having as yet been taken, and it appearing that the testimony would be, for the most part, in writing.

(Before BENEDICT, J., Eastern District of New York, January 30th, 1882.)

BENEDICT, J. This is a motion in an equity cause, for the trial before a jury, upon feigned issues, of certain questions of fact raised by the pleadings. It appears by the papers that no testimony whatever has yet been taken in the cause, and that the decision may turn upon the question of fact whether certain instruments described in the bill, and against which the plaintiffs seek relief, were procured by fraud and duress. While it is not doubted that a Court of the United States sitting in equity may, in a proper case, direct questions of fact arising in an equity cause to be passed on by a jury, neither party has an absolute right to such a trial. Whether a jury trial be, in any case, necessary or desirable, depends upon the facts of the case. In this case, I see no necessity, at this time,

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for such a proceeding. Feigned issues are awarded, it is said, "in order to relieve and ease the conscience of the Court," but here the necessity of such relief does not as yet appear. The surmise, that the testimony, when taken before an examiner, will prove conflicting and uncertain, affords no foundation for present action by the Court.

Another of the reasons assigned for granting feigned issues, viz., because "the Court is so sensible of the deficiency of trial by written evidence," also fails in this case, for, it is quite apparent, that, in a jury trial, the testimony would be, for the most part, in writing, owing to the circumstance that the transaction in question occurred in Texas.

For these reasons, the motion to award feigned issues in the case at this time is denied.

H. P. Herdman, for the plaintiffs.

Charles M. Da Costa, for the defendants.

JONATHAN A. FRAZEE AND WILLIAM Y. FRAZEE

vs.

STEPHEN MOFFITT.

Hay is not a manufactured article, under § 2,516 of the Revised Statutes, and so subject to a duty of 20 *per centum ad valorem*, but is a raw or unmanufactured article, under that section, and so is subject to a duty of 10 *per centum ad valorem*.

The protest in this case was "against any greater rate of duties * * * than at the rate of ten *per centum ad valorem*, for the reason and on the grounds that no higher rate than ten *per centum* can lawfully or properly be charged on hay imported." The collector had liquidated the duties at 20 *per cent.*, under § 2,516: *Held*, that the protest was sufficient, under § 2,931.

(Before BLANCHFORD, J., Northern District of New York, February 1st, 1882.)

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BLATCHFORD, J. This is a suit against the collector of customs at Rouse's Point, to recover back duties paid on hay in bales, imported from Canada into the United States. There is no duty on hay by name, but § 2,516 of the Revised Statutes provides as follows: "There shall be levied, collected and paid on the importation of all raw or unmanufactured articles, not herein enumerated or provided for, a duty of ten *per centum ad valorem*; and on all articles manufactured in whole or in part, not herein enumerated or provided for, a duty of twenty *per centum ad valorem*." Hay is not otherwise enumerated or provided for. The collector imposed a duty of 20 *per cent.* on the hay, as a manufactured article. The plaintiffs protested and appealed to the Secretary of the Treasury. The ground of the appeal was that the duty should have been only 10 *per cent.* because, under § 2,516, hay was a raw or unmanufactured article. The decision of the collector was affirmed. This suit was then brought. At the trial the plaintiffs had a verdict for \$1,976 86, and the defendant now moves for a new trial on a bill of exceptions setting forth all the testimony taken on the trial.

1. There is an exception by the defendant as to the sufficiency of the protest. The protest was "against any greater rate of duties being charged upon hay shipped to or by us from Canada to the United States, entered with you or at the customs office at Rouse's Point, than at the rate of ten *per centum ad valorem*, for the reason and on the grounds that no higher rate than ten *per centum* can lawfully or properly be charged on hay imported under the laws of the United States concerning duties on imports." There was also a notice that an appeal would be taken in case of an adverse decision. A proper protest, as well as an appeal, are prerequisites to the right to sue. (§ 3,011 *Rev. Stat.*, as amended by the Act of February 27th, 1877, 20 *U. S. Stat. at Large*, 247.) The protest must set forth "distinctly and specifically" the grounds of objection to the decision of the collector as to the rate and amount of duties. (§ 2,931 *Rev. Stat.*) This provision was made by the Act of June 30th, 1864, § 14, (13

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U. S. Stat. at Large, 214,) and is substantially the same as that in the Act of February 26th, 1845, (5 *Id.*, 727,) which required the protest to set forth "distinctly and specifically" the grounds of objection to the payment of the duties.

It is contended for the defendant that the protest in this case does not comply with the statute, in that, although it objects to paying more than 10 *per cent.*, it states no ground except that no more than 10 *per cent.* ought to be paid; and that it states only a conclusion of law, and leaves the defendant to find out as best he can why it is the law. But, the protest was made in view of a liquidation of duties at 20 *per cent.*, which is the "greater rate of duties" referred to in the protest. The liquidation at 20 *per cent.* was under § 2,516. No other provision of law than that section could possibly apply to hay. With § 2,516 and the protest before him, the collector could not fail to understand from the protest, that the rate of ten *per cent.* claimed in it to be the proper duty was the rate of ten *per cent.* named in § 2,516.

A mere protest against the payment of the duty exacted is not a compliance with the statute. This protest is not a mere protest against the duty charged. It is a protest against that, with the further statement that only 10 *per cent.* should have been charged on hay. Hay not being enumerated or provided for anywhere, if not in § 2,516, and the 20 *per cent.* and the 10 *per cent.* being put in contrast both in the protest and in § 2,516, and the collector having acted under § 2,516, in imposing the 20 *per cent.*, the language of the protest fairly referred the collector to the 10 *per cent.* clause of § 2,516. A protest is a commercial document, usually made in the hurry of business, entitled to a liberal interpretation, and not requiring technical precision, while at the same time it must show fairly that the objection afterwards made at the trial was in the mind of the party and was brought to the knowledge of the collector, so as to secure to the Government the practical advantage which the statute was designed to secure. (*Swanston v. Morton*, 1 *Curtis' C. C. R.*, 294; *Kriesler v. Morton*, *Id.*, 413; *Burgess v. Converse*, 2 *Id.*, 216.)

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The case of *Steegman v. Maxwell*, (3 *Blatchf. C. C. R.*, 365,) is nearer like the present case than any one I have been able to find. The plaintiffs imported articles known in commerce as "thread laces," composed of linen and cotton. The collector exacted 25 *per cent.* duty on them, as "cotton laces" under schedule D of the Act of July 30th, 1846, (9 *U. S. Stat. at Large*, 46.) "Thread laces" was named in Schedule E, which was a 20 *per cent.* Schedule. The protest was against the payment of the 25 *per cent.*, and claimed that the "thread laces" were liable to a duty of only 20 *per cent.* The Court held that the protest was a notice to the collector, adequately distinct and specific, of the grounds of objection to the payment demanded and satisfied the provisions of the statute. The protest did not say that the ground was that the article was provided for by name as "thread laces," in Schedule E; but it named the 20 *per cent.* and protested against the 25 *per cent.* Schedule E immediately followed Schedule D, in the same Act. In the present case the protest names the 10 *per cent.* and protests against the 20. The only suggestion against it is that it does not say that hay is not an article manufactured in whole or in part and that it is a raw or unmanufactured article. But these provisions are in the same section. In the case above cited it was expressly held that the statute was complied with, although the protest did not designate the particular Schedule and name under which the importation should be ranked.

The principle of the foregoing views is sanctioned by the Supreme Court in *Converse v. Burgess*, (18 *Howard*, 413,) where it is said, in regard to the protest Act of 1845: "We are not, therefore, disposed to exact any nice precision, nor to apply any strict rule of construction upon the notices required under this statute. It is sufficient if the importer indicates distinctly and definitely the source of his complaint and his design to make it the foundation for a claim against the Government." The protest in this case must be held to have been sufficient.

2. At the close of the evidence the defendant asked the

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Court to direct a verdict for the defendant, on the ground that the undisputed evidence showed that hay was a manufactured article and by the law subject to a duty of 20 *per cent. ad valorem*. The motion was denied and the defendant excepted, and the case was submitted to the jury, which found for the plaintiffs. The defendant contends that a verdict for the defendant should have been directed.

The hay was pressed in bales ready for market, and not chopped up fine. It was mostly Timothy hay used for horse feed. The usual process in regard to the hay is to cut the grass and scatter it by a tedder to enable it to dry, and then rake it up and put it into cocks, and let the cocks remain in the field over night, and the next day open out the cocks to dry and then put it in the barn that day. While in the cocks the hay sweats. After it is put in the barn, it must remain there a month before it is dry enough to be pressed and baled. The grass must be cut while green to make good hay. If left to dry uncut it becomes worthless. When the grass is cut green it contains starch and gluten. After it is cut the heat of the sun and the oxygen in the air convert the starch into sugar before the hay becomes dry.

The defendant contends that, on this evidence, hay is a manufactured article, under § 2,516; that hay is a new article transformed from grass, as much as sugar is from the cane juice or the maple sap, or as salt is from the saline brine; that the heat of the sun and the air and human skill and labor manufacture the grass into hay; and that the verdict for the plaintiffs was not only without evidence but against the evidence.

I am of opinion that nothing that was done or occurred to the grass which became this hay caused it to be other than a raw or unmanufactured article, or to be an article manufactured in whole or in part, under § 2,516; that the jury were justified in finding the verdict they did; that the direction to find a verdict for the defendant would have been erroneous; that a verdict for the defendant would have been erroneous; and

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that it would have been proper to direct a verdict for the plaintiffs.

If hay is a raw article it is liable to only 10 *per cent.* duty. Many articles are properly called raw which have undergone some manipulation. Cotton is picked from the bolls, and cleaned by ginning, and baled. Yet it is raw cotton in the bale. Wheat is cut, and the grains are threshed out, and then subjected to a cleaning machine, and then bagged. Yet it is raw wheat in the bag. So with other grains. The cotton and the grains undergo such change and preparation as exposure to light, and natural or artificial heat, and air, and the manipulation they receive, produce or allow, be it more or less. Yet neither the cotton nor the grains would be said to be manufactured. Salt and sugar are new articles. Cotton and grains are the same articles they were when on the plant with its roots in the earth. So hay is the same article it was when it was stalks of grass with roots in the earth. It is dried, to be sure. But the drying and any conversion of starch into sugar are mere incidents of the necessary cutting to enable it to be stored for food in latitudes where grass cannot be found all the year round. Where it can be so found no hay is stored. Dried apples would not be called a manufactured article, though the apple is peeled and cored and sliced and dried by exposure to the sun and manipulation. The substance of dried apples is still apples. The substance of dried grass or hay is still grass. Change of name and manipulation do not necessarily constitute manufacture, within the meaning of § 2,516. Each case must be decided according to its own circumstances. The verdict of the jury in this case was a correct one, under the foregoing views, and the motion for a new trial is denied.

Kelly & MacRae, for the plaintiffs.

Martin I. Townsend, (*District Attorney*), for the defendant.

Fisher v. Meyer.

MORTON C. FISHER

vs.

MORITZ MEYER AND OTHERS.

In this case, after a verdict against two of the defendants for \$181,000, they applied for a stay of proceedings during the time allowed for making a case, and till further order. The applicants being in active business, the Court granted the application on their giving a bond, with two satisfactory sureties, in the sum of \$200,000, conditioned for the payment to the plaintiff of any judgment which might be rendered against them in this suit, or for the satisfaction of the judgment.

(Before SHIPMAN, J., Southern District of New York, February 1st, 1882.)

SHIPMAN, J. The motion of the defendants Meyer and Adler for a stay of proceedings during the time allowed for making a case, and till further order, is not opposed by the plaintiff, but he insists that it should be granted upon terms, *i. e.*, inasmuch as the plaintiff has now no security, that security should be given for the payment of the judgment, if one is rendered.

The verdict amounts to a very large sum, *viz.*, about \$181,000. The defendants are probably now of ample means to pay all their liabilities, but they are in active business, and whether they will be able to pay their debts at the expiration of some months, in case judgment is entered against them, depends upon contingencies which cannot now be ascertained and made certain. They are now able to give security and no serious hardship will be imposed thereby. If no security is given, a large claim is placed at some hazard. In the case of so large a verdict against parties who are subject to the vicissitudes of business, I think that the plaintiff is entitled to security.

The motion of the defendants for a stay is granted, provided they shall give bond, with two sureties, to the satisfac-

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tion of the Court, in the sum of two hundred thousand dollars, conditioned for the payment to the plaintiff of any judgment which may be rendered against them in this suit, or for the satisfaction of said judgment.

In case a writ of error shall be taken to the Supreme Court, this bond can be vacated, and the bond required by section 1,000, upon writs of error, will be given.

Luther R. Marsh, for the plaintiff.

Joseph H. Choate and *Francis N. Bangs*, for the defendants.

JACOB E. BUERK

vs.

WILLIAM IMHAEUSER AND CHARLES KEINATH. IN EQUITY.

A creditor's bill on a money decree alleged that the defendant had or had had property, without specifying any in particular. It prayed a discovery of property. It contained interrogatories making more specific inquiries, and required the defendants to answer such interrogatories as by the note thereunder written they should be required to answer, but there was no note thereunder written. The answer denied generally that the defendant had any property, or that any was held in trust for him, or that he had conveyed away any since the decree, or before, in view of it, to defeat it. On exceptions for insufficiency, the answer was held sufficient.

(Before WHEELER, J., Southern District of New York, February 2d, 1882.)

WHEELER, J. This cause has now been heard on exceptions to the answer for insufficiency. The bill states the recovery of judgments by decree against the defendants for the payment of money; that execution cannot be satisfied for want of property to be found; and that the defendants have or have had property, without specifying any in particular.

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It prays a discovery of their property in hand or held in trust for them. The interrogatories make more specific inquiries. The answer denies generally that the defendant answering has any property in his hands, or that any is held in trust for him, or that he has conveyed away any since the decree, at all, or before, in view of it, to defeat it. The Rules in Equity require defendants to answer only such interrogatories as they are specifically required by note to answer. This bill, accordingly, required the defendants to answer such interrogatories as by the note thereunder written they should be required to answer. There is no note thereunder written ; therefore, there were no interrogatories to be specifically answered. They were only required to answer the stating part of the bill. This the defendant answering has done as specifically as he is by the bill charged. No ground is known for making a defendant give a particular account of all the property he has ever had, or deny specifically having had particular property, upon such general charge as to having had property before, which cannot be found now to satisfy judgments. At least the particular property sought to be reached should be pointed out before anything more than a general answer should be compelled.

The exceptions are overruled.

William C. Hauff, for the plaintiff.

Arthur V. Briesen, for the defendant.

Benedict v. Williams.

ERASTUS D. BENEDIOT*vs.***EPHRAIM WILLIAMS AND FRANK E. KERNOCHAN. IN EQUITY.**

W. contracted with K., that K. should conduct a litigation on behalf of W., as counsel, and receive $\frac{1}{4}$ of the avails thereof for so doing. K. contracted with M. and H., that they should assist K. in the litigation, and share equally with him in the $\frac{1}{4}$. The litigation was conducted by them with the knowledge of W. until he received a sum as its avails. M. assigned his share of the avails to B. B. sued W. and K. in a State Court of New York to recover such share. The suit was removed into this Court. B. filed a bill in equity in this Court setting up the above facts. It was demurred to on the grounds (1) that there was no privity of contract between W. and M., or between W. and B.; (2) that W. was only liable to K.; and (3) that the remedy of B. was at law: *Held*, that the demurrer must be overruled.

The distinctions between legal and equitable procedure being abolished in the State Courts of New York, and the right of B. being a purely equitable right, he can, in this Court, proceed in equity.

(Before WHEELER, J., Southern District of New York, February 2d, 1882.)

WHEELER, J. This cause has been heard on demurrer to the bill. It was commenced in the State Court and removed to this Court. The bill shows that the defendant Williams, a citizen of Connecticut, made a contract with the defendant Kernochan, a citizen of Massachusetts, by the terms of which the latter was to conduct litigation in behalf of the former against the Kansas Pacific Railway Company, as counsel, and to receive one-fourth part of the avails thereof for so doing; that, by a contract between Kernochan and Edwin R. Meade and Henry E. Knox, the two latter were to assist in the conduct of the litigation, and to share equally with the former in the one-fourth part of the avails; that the litigation was conducted by them with the knowledge of Williams, and proceeded until the sum of twenty-seven thousand five hundred dollars was received from it, as the avails of it, by him;

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that Meade sold and assigned his share of these avails to the orator, a citizen of New York; that Knox has been fully settled with; and that Meade's share has not been paid over.

The principal grounds of demurrer assigned are that there was no privity of contract between either Williams and Meade, or Williams and the orator; that Williams is only liable to Kernochan, who may be liable over to Meade or to the orator; and that the orator's remedy, if he has any, is at law. The want of privity relied upon, however, is not material. It may be that Williams had only to pay Kernochan, as he agreed to, but, if so, he has not paid to Kernochan Meade's share. That share, if payable to Kernochan, was payable to him for Meade, and Meade would have the right to proceed for it against both; against Kernochan as his trustee, and against Williams as a debtor to his trustee for him. This right he could sell and assign, as the bill alleges he did sell and assign it to the orator; and, when it was so sold and assigned to the orator, he became vested with the right, also, in some manner to enforce it.

It is understood that the distinctions between legal and equitable procedure are done away with in the State Courts from which the case was removed; and that there the remedy is to be sought by the real owner of a cause of action, in his own name. In this Court these distinctions are kept up, although the proceedings at law conform to those in the Courts of the State. At common law, a mere chose in action was not assignable at all, although it was assignable in equity; and, hence, an assignee of a chose in action could not maintain an action at law upon it in his own name, but could in the name of the assignor, for his own benefit; or he could proceed in equity to recover it, and, if he did, he must proceed in his own name. The orator took the only mode that was open to him in the State Court. Had the proceedings remained there his rights would have been wrought out by the appropriate methods there provided. But, when the proceedings were removed into this Court they were neither removed from a Court of law, or the law side of a Court, to

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the law side of this Court; nor from a Court of equity, or from the equity side of a Court, to the equity side of this Court; but they were removed from that Court as it was, where remedies are administered without this distinction, to this Court, where the distinction is observed; and the removal was necessarily to that side of this Court where the appropriate relief, if due, could be obtained. The orator is merely the assignee of a chose in action, which accrued to Meade, or to Kernochan for Meade; the proceedings are in his own name; and he can go forward with such proceedings only on the equity side of the Court. His right is a purely equitable one, and strictly cognizable in his own name in a Court of equity only, or only where equitable remedies are administered; and the remedy is none the less equitable because it might not be so classed in the State Court.

The demurrers are overruled, with leave to the defendants to answer over within thirty days, on payment of costs of demurrer.

William A. Beach, for the plaintiff.

Edward M. Shepard, for the defendants.

HARVEY MELLEN

vs.

THE TOWN OF LANSING.

By § 1 of the Act of the Legislature of New York, passed April 5th, 1871, (*Laws of New York*, 1871, vol. 1, chap. 298, p. 586,) the New York and Oswego Midland Railroad Company was authorized to extend and construct its road from the city of Auburn, or from any point on said road easterly or southerly from said city, "upon such route and location and through such counties as the Board of Directors of said company shall deem most feasible

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and favorable for the construction of said railroad, to any point on Lake Erie or the Niagara river." It was also provided, that any town "in any county through or near which said railroad or its branches may be located" might aid the construction of the said railroad and its branches and extensions, by the issue and sale of its bonds, which were to be issued and executed by commissioners to be appointed by the county judge of the county in which the town was situated. In November, 1871, the Board of Directors of the company passed a resolution determining "that the construction and extension of the said railroad westerly commence at and from the village of Cortland in the said county of Cortland, and thence to Lake Erie or the Niagara river." In October, 1871, commissioners were appointed for the town of Lansing, in Tompkins county, by the county judge of that county. In December, 1871, maps were filed in the office of the clerk of that county, locating parts of the "Auburn branch" of the road through the town of Lansing, and the road was made through that town to and through the adjoining town in another county, and on, for 26 miles in all, to a point in a farming community, unconnected with any other road, and began to run in the fall of 1872. In January, 1872, and afterwards, bonds of the town of Lansing were issued to the company, to the amount of \$75,000, and it received in exchange a certificate for 750 shares, of \$100 each, of the stock of the company: *Held*, that the "western extension" had nothing to do with the Auburn branch; that the resolution of the company was insufficient to authorize the issuing of any bonds by said town; that the said maps did not locate any part of the "western extension;" that there was no power in any town to issue any bonds until all the counties through which the road was to pass had been designated by the directors; and that the absence of such location was fatal to the bonds even in the hands of a *bona fide* holder of them, although the town had paid same coupons on the bonds and had retained the certificate of stock.

(Before BLATCHFORD, J., Northern District of New York, February 8d, 1882.)

BLATCHFORD, J. This suit is brought on coupons cut from bonds purporting to have been issued by the town of Lansing, in Tompkins county, New York, and bearing date December 1st, 1871. The coupons sued on are 47 in number, falling due September 1st, 1879, cut from 47 bonds, the principal of which bonds amounts to \$38,000, the coupons amounting to \$1,330. It was tried once before this Court and a jury, and the plaintiff had a verdict, under the direction of the Court, for \$1,457 59, being the amount of the coupons and interest thereon. The defendant moved for a new trial, on a bill of exceptions, containing exceptions taken at the

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trial. The Court, in August, 1881, granted a new trial. (19 *Blatchf. C. C. R.*, 512.) The new trial has been had before the Court without a jury.

The first question is as to the statute authority for the issuing of the bonds by the town. By § 1 of the Act of April 5th, 1871, (*Laws of New York*, 1871, vol. 1, chap. 298, p. 586,) it is provided as follows: "The New York and Oswego Midland Railroad Company are hereby authorized and empowered to extend and construct their railroad from the city of Auburn, or from any point on said road easterly or southerly from said city, upon such route and location and through such counties as the board of directors of said company shall deem most feasible and favorable for the construction of said railroad, to any point on Lake Erie or the Niagara river." Then follow provisions for constructing other branches. Then follows this: "and any town, village or city in any county, through or near which said railroad or its branches may be located, except such counties, towns and cities as are excepted from the provisions of the general bonding law, may aid or facilitate the construction of the said New York and Oswego Midland Railroad and its branches and extensions, by the issue and sale of its bonds in the manner provided for" in the said Act of 1866 and the Acts "amendatory of and supplementary thereto." The Act of 1866, referred to, is the Act of April 5th, 1866, (*Laws of New York*, 1866, vol. 1, chap. 398, p. 874.) It provides for the appointment by the county judge of the county in which the town is situated, of not more than three commissioners to carry into effect the purposes of the Act. The commissioners are to execute the bonds under their hands and seals, and to issue them. When issued lawfully they become the obligations of the town. All the statutes then speak of them as bonds issued by the town.

The bonds in the present case state on their face that they are obligations of the town, and that they are issued under the provisions of the said Act of 1866, and the several Acts amendatory thereof and supplementary thereto, especially the

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said Act of 1871. The bonds purport to be attested by the hands and seals of three persons who style themselves therein "duly appointed commissioners of the said town of Lansing;" and the bonds state that they have caused each of the annexed coupons to be signed by one of their number.

The board of directors of the company, on the 16th of November, 1871, passed the following resolution: "Whereas, the New York and Oswego Midland Railroad Company had for its original object the construction of a railway from the city of New York to the city of Oswego; and, whereas, since the organization of said railroad company, it has become desirable to extend their said railroad to Lake Erie or the Niagara river; and, whereas, the Legislature of the State of New York did, by chapter 298 of the laws of 1871, authorize and empower the said New York and Oswego Midland Railroad Company to build and extend their said railroad from the city of Auburn, or from any point easterly or southerly of said city, to any point on Lake Erie or the Niagara river; and, whereas, the said railroad company and its board of directors have decided to begin such extension and construction of said railroad westerly at and from the village of Cortland, in the county of Cortland, and westerly to Lake Erie or the Niagara river: Therefore, be it resolved, that the board of directors of said railroad company hereby determine that the construction and extension of the said railroad westerly commence at and from the village of Cortland, in the said county of Cortland, and thence to Lake Erie or the Niagara river." On the same 16th of November, 1871, the board of directors of said company passed the following resolution: "Resolved, that the said New York and Oswego Midland Railroad Company, for the purpose of obtaining money and materials necessary to extend their said railroad from the village of Cortland to Lake Erie or the Niagara river, hereby authorizes and directs its president and treasurer to borrow money to an amount not exceeding twenty-five thousand dollars per mile in length of the track of the said railroad, so as aforesaid to be extended and constructed, and, to secure the repayment thereof, to issue its first

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mortgage bonds, to be made payable in gold coin of the United States, and to be of such denomination, and after such manner and form, and to such trustees, as the said president may determine upon and deem best for the interests of the said company."

On the 21st of October, 1871, the county judge of Tompkins county signed a paper appointing as commissioners of said town, to carry into effect the purposes of the said Act of 1866 and the Acts amendatory thereof, "in accordance with the provisions of the said Acts," the three persons who afterwards executed the bonds as commissioners. The commissioners took the oath of office as such on the 1st of November, 1871.

Some 20 years prior to the year 1872, a road bed 16 miles long, called the "Murdock Line," intended for a railroad, had been graded. That road bed ran from a place called Osmun's, in the town of Lansing, northward, to the north line of Lansing, which is the south line of the county of Cayuga, and of the town of Genoa in that county, and then northward through Genoa and the town of Venice into the town of Scipio, all in Cayuga county. The grading of that road bed had become grassed over and the culverts were decayed. Some part of it was ready for ties and ballasting. On the 1st of January, 1871, the executive committee of the railroad company purchased the Murdock line, with its franchises, right of way and road bed. During the summer and fall of 1871 surveys were made by the company for a line of road to run from Freeville, in the town of Dryden, Tompkins county, the town next south of Lansing, to the south end of the Murdock line at Osmun's in the town of Lansing, a distance of 10 miles. As a result of this acquisition and of these surveys the bonding proceedings were commenced and the resolutions of November 16th, 1871, were passed.

On the 13th of December, 1871, there was filed in the office of the clerk of the county of Tompkins a map, called "Map No. 1," containing this inscription: "Map and Profile of a part of the Auburn branch of the New York

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and Oswego Midland Railroad, as located in and through a part of the county of Tompkins, New York." This location covers 10 miles in length from Freeville to the Murdock line at Osmun's. On the 22d of December, 1871, there was filed in the same office a map, called "Map No. 2," containing the same inscription as "Map No. 1." This location is continuous with the preceding, and covers the Murdock line from Osmun's to the north line of the town of Lansing, that being the north line of Tompkins county, and the south line of Cayuga county. On the 23d of December, 1871, there was filed in the office of the clerk of the county of Cayuga a map, called "Map 1," containing this inscription: "Map and Profile of a part of the Auburn branch of the New York and Oswego Midland Railroad, as located in and through a part of the county of Cayuga, New York." This location is continuous with the preceding, and covers the Murdock line from the south line of Genoa, through Genoa and Venice, to the south line of Scipio. On the 30th of May, 1872, there was filed in the last named office a map, called "Map 2," containing the same inscription as "Map 1." This location is continuous with the preceding, and covers the Murdock line from the south line of Scipio to the Merrifield road in Scipio, which was the north end of the Murdock line. The grading and making of the road from Freeville north through the town of Lansing was begun in December, 1871. There was a railroad already built and running from Cortland to Freeville west from Cortland, which belonged to the Utica, Ithaca and Elmira Railroad Company. Under some arrangement between that company and the Midland Company, the latter began, in the fall of 1872, to run its own cars from Cortland to Freeville, and so on to Scipio, its own road from Freeville to Scipio, 26 miles, having been completed to the north end of the Murdock line. The terminus, in Scipio was 11 miles from Auburn, in a farming community, and has never connected there with any other railroad. In resuscitating the Murdock line, the Midland Company put ties and ballast and rails on the whole length of it, and built some culverts and some bridges.

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The commissioners issued the bonds of the town and delivered them to Charles P. Wood, the assistant treasurer of the Midland Company. None of the bonds were issued before January 31st, 1872. On that day \$15,000 were issued. Afterwards \$60,000 were issued. In exchange for them the commissioners received a certificate for 750 shares of the stock of the Midland Company, of \$100 each, in the name of the town.

On the 29th of January, 1873, the following proceedings took place at a meeting of the board of directors of the Midland Company: "The president presented the contract made by the executive committee with Charles P. Wood, of Auburn, dated January 1st, 1871, for the road bed and franchises known as the 'Murdock Line.' On being read and discussed, Mr. Merchant offered the following: Resolved, that the contract made by D. C. Littlejohn, J. W. Merchant, John R. Clarke, Cheney Ames and William Foster, as the executive committee, and Charles P. Wood, of Auburn, for the purchase of the franchises, right of way and road bed known as the 'Murdock Line,' be and the same hereby is approved, ratified and confirmed. Resolved, that the action of the president in locating and constructing the western extension of this company's road over and upon the said 'Murdock Line' be and the same is hereby approved. Unanimously adopted." The persons named were all or a majority of the executive committee.

The commissioners were appointed before the company passed the resolutions of November 16th, 1871, and before any part of the western extension was located. It is contended for the defendant that there was no power to institute the bonding proceedings before the company had so located the whole of the branch road that it would pass through the county of Tompkins, or, at least, that there was no power to issue any bonds before such location; and that there was no such location before the bonds in this case were issued.

Under the Act of 1871 the company is authorized to make its extension or branch to any point on Lake Erie or the Niagara river, either from Auburn or from some point on its

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road easterly or southerly from Auburn, "upon such route and location and through such counties as the board of directors of said company shall deem most feasible and favorable for the construction of said railroad." The eastern starting point must be fixed by the company, and so must the route and location, and the counties through which said extension or branch is to pass, and the western terminus. No county is named. No town is named. Any town in any county through or near which the railroad or its branch may be located, except as defined, may issue and sell its bonds in aid, in the manner provided for in the prior Acts referred to. By § 3 of the Act of May 15th, 1867, (*Laws of New York*, 1867, chap. 917, p. 2,291,) as amended by § 4 of the Act of March 31st, 1869, (*Id.*, 1869, chap. 84, p. 142,) the company was authorized "to construct a branch railroad from the line of the said railroad at any point in the counties of Chenango or Madison, through the counties of Chenango, Madison, Onondaga, Cortland, Cayuga, to the city of Auburn, in the county of Cayuga, whenever, in the judgment of the directors, the same shall be for the interest of said corporation." Then the same power is given to the towns along the line of the said branch road, or interested in the construction thereof, "in any county through which said railroad shall run," to subscribe stock and issue bonds in aid, as is given by the said Acts of 1866 and 1867. The branch so mentioned in the Acts of 1867 and 1869 is a branch to Auburn. It is not to pass through Tompkins county. No location of it could give any power to the town of Lansing to issue any bonds. The western extension, provided for by the Act of 1871, might, under that Act, have been ordered by the company to start from Auburn, as its eastern terminus, and thus have been a continuation of the said branch to Auburn. As it was, the western extension was ordered by the company, by the resolution of November 16th, 1871, to begin at the village of Cortland. That extension had nothing to do with the branch to Auburn, or the Auburn branch. The said resolution is, in terms, confined to the extension authorized by the Act of 1871.

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The resolution merely fixed the eastern point. It fixed no route, no location, no counties through which the branch should pass, no western terminus. It was no location of the branch through the county of Tompkins. It was wholly insufficient, therefore, to authorize the issuing of any bonds by the town of Lansing.

The said maps are relied on as being a location before the bonds were issued. But each of them purports on its face to be a location of a part of "the Auburn branch," that is, the branch to Auburn, which was not to go through Tompkins county. No one of the maps purports to be a location of any part of the western extension.

Moreover, there is an inherent defect, in the fact that the company never, by any action of its directors, or otherwise, designated all the counties through which the road was to pass. Under the Act of 1871, the whole extension or branch must be located before the bonds of any town can be issued. It is not enough that a location be made through a particular county. So that even though the maps filed could be regarded as a location of so much of the western extension as was to pass through Tompkins county, there would be no authority for issuing the bonds until the whole extension or branch should be located. The board of directors must, in some way, adopt an entire route as feasible and favorable before the town bonds can be issued. This seems to have been the view of the Court of Appeals of New York, in *The People v. Morgan*, (55 N. Y., 587.) The absence of such location, under the Act of 1871, is as fatal to the bonds, even in the hands of a *bona fide* holder, as if there were no statute. As was said in the decision in this case granting a new trial: "It required special legislative authority to enable the town to issue bonds in aid of the railroad. Even without what is on the face of these bonds, every person taking them or their coupons is referred to the source of authority to issue them, in some statute. A *bona fide* purchaser of them is thus referred equally with every other taker. There may be no informality, or irregularity, or fraud, or excess of author-

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ity in an authorized agent, capable of operating to the prejudice of a *bona fide* holder, but there must be some statute providing for the constitution of authorized agents. Every one is bound to enquire and take notice as to whether there is in fact such a statute. If there is not, there is a total want of jurisdiction and authority in county judge and in commissioners." (*Marsh v. Fulton County*, 10 *Wall.*, 676.)

The action of the company by its resolution of January 29th, 1873, in approving the purchase of the Murdock line, and what is called "the action of the president in locating and constructing the western extension of this company's road over and upon the said Murdock Line," can have no effect. There is nothing to show that the western extension was ever located over and upon the Murdock line, and such a location was not the required location of the whole branch.

The commissioners paid all of the first coupons on the bonds and nearly all of the second and third, receiving the money to do so from the supervisor or the collector of the town. The commissioners also received and have retained the certificate of stock. While these acts may be a ratification of steps in regard to which merely irregularity is claimed, they cannot avail to prevent the town from setting up a total want of power to issue the bonds.

The case is in a worse predicament for the plaintiff than when it was before this Court previously. Then it was supposed that the Murdock line and its extension to Freeville might be a part of a western extension beginning at Auburn, as authorized by the Act of 1871. But the present proof shows that this is not so.

There must be a judgment for the defendant, with costs, and a like judgment in the Thomas suit.

James R. Cox, for the plaintiff.

Harlow L. Comstock, for the defendant.

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In this case a service rendered by one steamer to another steamer, in towing her into port, after she had broken her steam machinery at sea, was held to be a salvage service.

Notwithstanding a written agreement made at sea between the masters of the two steamers, that the disabled steamer should pay £3,000 for the service, but which agreement contained the words "but leave it to the Court to prove the said agreement," this Court awarded as a salvage compensation, on a *quantum meruit*, \$5,500, giving to the owners of the towing steamer \$4,125, to her master \$150, and dividing the remaining \$1,225 among her master, officers, and crew in proportion to their respective wages although the owners of the towing steamer had sued on the agreement alone, and not for salvage for owners, master and crew.

The District Court had awarded \$3,750, of which the owners of the towing steamer were to have \$2,250, her master \$150, and her master, officers and crew \$1,350, and, as both parties appealed to this Court, this Court awarded to the libellants costs in the District Court, because the claimant had made no tender, and awarded no costs in this Court to either party.

(Before BLATCHFORD, J., Southern District of New York, February 7th, 1882.)

THIS was a libel *in rem*, filed in the District Court. After a decree for the libellants by that Court, both parties appealed to this Court. This Court found the following facts: "The screw steamship Leipsic, of about 2,000 tons burthen, one of the regular line of steamers of the North German Lloyd, plying between Bremerhaven and Baltimore, left the latter port, bound for the former, at 2 P. M. on the 4th of September, 1879, with a general cargo and twelve steerage passengers. She passed Cape Henry on the 5th at 4.45 A. M. and proceeded to sea. On the 6th, while the weather was fine, the wind northerly, and the ship running at about 10 knots, that portion of her propeller shaft known as her "first transmission shaft" broke. This accident deprived her of the power of propulsion by steam. She was then in the Gulf Stream, in latitude 37° 58' north, and longitude 68° 43' west, and about 320 miles from Sandy Hook. Her sails were all

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set and she was immediately hove to, in order to disconnect her screw-shaft from the remainder of the shafting between the screw-shaft and the point of the fracture, so that the screw-shaft could revolve freely when the ship was in motion. This was done by dropping down that portion of the shaft between the fracture and the screw-shaft. Then, when the vessel was in motion, the screw-shaft revolved freely in its bearings. The ship was then put under sail on a west-north-west course, intending to reach the nearest port on the Atlantic coast of the United States. She was in all respects, except as to the injury to her machinery, staunch and strong, well manned, equipped and provisioned. She continued under sail till the 13th, when the libellants' ship took her in tow. The Leipsic made about 25 miles from 2 p. m. on the 6th to noon on the 7th. The next 24 hours she made about 10 miles, the next 24 hours 41 miles, the next 24 hours 38 miles, the next 24 hours 52 miles, the next 24 hours 50 miles, bringing her down to noon of the 12th. From that time to noon on the 13th it was nearly calm, and the current carried her 20 miles northeasterly. On the 9th, at 1.30 p. m., she was passed by an English steamer, which made an offer of assistance, but it was declined by the captain of the Leipsic, on the ground that he did not need assistance. During the days the Leipsic was under sail she sighted several steamers, but she made no signals for assistance. On the 12th, her captain, the wind having died away, had decided that it was necessary for him to reach a port quicker than he could do so under sail; that his only means of so doing was to be towed in by a steamer; and that the saving of time thereby was an advantage to the ship and her owners from a business point of view. For that purpose, when he went below on the night of the 12th, he ordered rocket signals to be thrown up whenever a steamer should pass. One did pass at a distance of 5 or 6 miles, but failed to heave to or answer the signals. About noon of the 12th, the Leipsic had spoken a barque bound for the Delaware Breakwater, and asked her to report the steamer as being there with a broken shaft. About 8 or 9 o'clock on the

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morning of the 13th, the steamer Gresham, bound from Newport, England, to Baltimore, Maryland, in ballast, overtook the barque which had been previously spoken by the Leipsic, and was informed by the barque that there was a steamer to the eastward with a broken shaft, giving her supposed latitude and longitude. The Gresham was immediately put about and proceeded in the direction indicated, which was nearly opposite to her former course. At about noon on the 13th, the Gresham, having proceeded 40 miles from the point where she was spoken by the barque, appeared in sight, and the Leipsic signalled her that she had a broken shaft. The Gresham came up to her, and, when within hailing distance, her captain asked the Leipsic if she wanted a tow, and the reply was that she did. The captain of the Gresham then went on board of the Leipsic and the latter showed the former the position of the ship on the chart, $39^{\circ} 28'$ north latitude, and $71^{\circ} 25'$ west longitude. The reckoning of both ships agreed. Measurements were made on the chart, and Sandy Hook was found to be distant 125 miles and to be the nearest port. The captain of the Gresham was then asked what he would tow the Leipsic to Sandy Hook for. The two captains differ as to the price that was named, one testifying that it was £6,000 and the other that it was £4,000. The captain of the Leipsic told the captain of the Gresham that if he did not come down any further, the ship was in very good sailing order, he had all his square sails set, and that he could help himself in any weather with his ship under sail. During the negotiation another steamer hove in sight, about 5 miles off, and within signalling distance, but she was not signalled, and night was coming on, and the captain of the Gresham insisted that he was first on the ground. The captain of the Leipsic said to the captain of the Gresham that there was a steamer near by which could give him equal assistance. Finally an arrangement was concluded as set forth in the following paper, signed by both captains, on board of the Leipsic: "Lat. $39^{\circ} 30'$ N., Long. $71^{\circ} 25'$ W., Sept. 13th, 1879. It is this day agreed between Captain F. Pfeiffer, of the S. S. Leipzig, and Captain

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Gibb, of the S. S. Gresham, to tow the said steamer Leipzig to Sandy Hook for the sum of three thousand pounds, (£3,000,) but leave it to the Court to prove the said agreement." The words, "but leave it to the Court to prove the said agreement" were added before the agreement was signed. The master of the Leipsic refused to make the agreement except upon that condition, because he thought the sum named too high. He is a German, but he spoke English, and the conversation was in English. The master of the Leipsic asked to be towed to New York, saying that he would make his repairs there. The master of the Gresham told him it would be out of his course, but that the Delaware Breakwater was in his way, but he would take him there or to Sandy Hook as he pleased, and the latter place was agreed on. The weather was good and the sea was smooth. The wind was very light. The Gresham took the Leipsic in tow by two hawsers, furnished by the latter. They got under way soon after the agreement was signed, in the afternoon of the 13th, and passed Sandy Hook about 3 o'clock in the afternoon of the 14th, and proceeded about 6 miles up the Bay, where the hawsers of the Leipsic were transferred to a tug, which towed her to Hoboken. The Gresham waited in the Lower Bay of New York a short time, for some trifling repairs to her machinery, (such repairs, however, having no connection with the service rendered to the Leipsic,) and then proceeded to Baltimore. She arrived at the mouth of Chesapeake Bay at 9 A. M. on the 16th. She had calculated to arrive there on the morning of the 14th. She was a freighting steamer, of 1,092 tons net measurement. She was under charter to proceed to Baltimore, and there take on board a cargo of grain for a port of delivery in Great Britain or Ireland, or on the continent, between Bordeaux and Hamburg, both inclusive, but excluding Rouen, according to orders to be given on signing bills of lading. By the charter she was required to be at Baltimore not later than the 25th of September. The freight earned by her on her outward voyage from Baltimore was about \$13,750. The agreed value of the Leipsic is \$90,000

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and that of her cargo \$160,945. The amount of her freight on that voyage was \$13,757 37. The value of the Gresham is \$90,000. The Leipsic was expected to make a round trip at that season every 6 weeks. By keeping her turn on her return trip she would presumably carry some 250 steerage passengers in addition to her cargo. The Leipsic at the time had 6 months' provisions on board. The captain of the Leipsic had commanded 3 steamers of the North German Lloyd, and up to the time of the trial in the District Court remained in its employ. He was an experienced master. The service was rendered without accident. It was not attended with any special difficulty or danger. The weather was at first fair, and soon after they started the wind became fresher, and both vessels set all sail, and then they made for a time about 7 knots. The following night it became rainy and squally, and, the wind getting around to the southwest, they proceeded under steam alone. The Gresham sustained no damage to her machinery in consequence of the towage, and suffered no loss of employment by reason of the delay. The Leipsic paid \$150 to the tug which towed her from the place where the Gresham left her to her dock in Hoboken. This was on Sunday and there was no other tug there."

Lorenzo Ulo, for the libellants.

William D. Shipman, for the claimant.

BLATCHFORD, J. The District Court awarded \$3,750 to the owners, master and crew of the Gresham, of which $\frac{2}{5}$ was to go to the owners of the Gresham, and $\frac{2}{5}$ to her master and crew, the master to have $\frac{1}{10}$ of the $\frac{2}{5}$, and the officers and crew, including the master, to have the remainder, in proportion to the rates of their respective wages. This gave to the owners, \$2,250; master, \$150; master, officers and crew, \$1,350. The libel was filed by the owners alone, on the agreement, and not as in a cause of salvage, for owners, master, and crew. The Court ordered the \$1,500 to remain in

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the registry to await an application for it by the master, officers and crew. The libellants have appealed to this Court because the District Court set aside the contract and did not allow the £3,000. The claimant has appealed on the ground that too much was allowed.

The District Court held that the agreement was made subject to the approval of the Court "as to the amount therein named, £3,000, as the amount to be paid for the towage service;" that the amount suggested by the agreement was very greatly in excess of the amount which the Court would award for the same service; and that, under the circumstances, the service was a salvage service.

It is contended for the libellants, that what the parties agreed to leave to the Court was, not to approve the sum of £3,000, but to approve the agreement, that is, to inquire into the circumstances under which the agreement was made; and that otherwise their position in Court would be as if no agreement were made. There was no disagreement between the parties as to what service was to be rendered or as to the place to which the Leipsic was to be towed. The Gresham was to tow the Leipsic, and was to tow her to Sandy Hook. The only dispute was as to the compensation. The captain of the Gresham wanted more than £3,000. The captain of the Leipsic insisted on less than £4,000. The captain of the Gresham came down to £3,000. The captain of the Leipsic refused to make the agreement unless the added words should be added, because he thought £3,000 too high. Under these circumstances the words "prove the said agreement" can mean nothing except "approve the said agreement for £3,000, as to its amount." That being so, the Court is at liberty to inquire whether the £3,000 is a sum which would be awarded if there were no agreement.

On the facts of this case, I think this was a salvage service. Unable to use her steam machinery, it not appearing that it could be repaired at sea, having rejected offered assistance from a steamer, neglecting to signal passing steamers, keeping this up until the 12th, ordering rocket signals to

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steamers that night, hailing the barque, on the 12th, to report her with a broken shaft, the Leipsic induced the Gresham to go back 40 miles to find her. She was drifting northeasterly in the current of the Gulf Stream, which was a direction in which she did not want to go. She was under sail for 7 days. In 6 days she had sailed but 216 miles. She was still 125 miles from Sandy Hook and approaching the coast, near the equinoctial season. Within the rule laid down in *The Princess Alice*, (3 *W. Rob.*, 138,) there was here, certainly, something more than employment to expedite a voyage, something more than accelerating the progress of the Leipsic. She was to be taken to a port to which she was not destined, to repair her disabled machinery. In *The Reward*, (1 *W. Rob.*, 174,) it was said: "Mere towage service is confined to vessels that have received no injury or damage," and "mere towage reward is payable in those cases only where the vessel receiving the service is in the same condition she would ordinarily be in without having encountered any damage or accident." The law, as laid down in *The Princess Alice*, was approved by the Privy Council in *The Strathnaver*, (*L. R.*, 1 *Appeal Cases*, 58.) The cases of *The Reward* and *The Princess Alice* were cases of assistance by steamtugs to sailing vessels. In *The Jubilee*, (42 *Law Times Rep.*, *N. S.*, 594,) a steamer which carried fore and aft sails only, and was not rigged for proceeding under sail alone, had broken the main shaft of her propeller. She put up signals of distress, and was towed by another steamer 40 miles into a port to which she was not bound. It was urged that she was making fair progress towards a safe port by means of her sails, under no circumstances of danger. The question arose directly whether the service was salvage or towage, because the towed steamer had paid to the other a sum for the service, and the crew of the towing steamer put in a claim for a share in the money, as salvage to be distributed. The owners desired to retain the whole, as towage money only. Sir Robert Phillimore held that the case was one of salvage and not of towage only, and gave to the crew a share of the money. Citing the case of *The Princess Alice*,

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he said: "I think, in this case, the circumstances show that something more was required than expedition, and something more than mere acceleration of progress. Here was a vessel lying with her mainshaft broken. The great difficulty of a screw steamer is invariably when her shaft is broken. In this case she put up two flags for assistance. I am satisfied that the principle is laid down in many cases that under these circumstances flags are put up on the ship for the purpose of obtaining salvage service. The service, therefore, in this case was one of a salvage character." In the present case the Leipsic did what was equivalent to putting up flags for assistance or signals of distress, by sending by the barque the message she did, and by ordering rocket signals to steamers on the night of the 12th, and by her signal to the Gresham when the latter came in sight. The present case is not at all like that of *The Emily B. Souder*, (15 *Blatch. C. C. R.*, 185.) In that case it was held that there was mere expedition by towage, in order to deliver passengers sooner at the port to which the towed and the towing steamer were both of them bound; and the master of the towing steamer neither did nor said anything at the time to indicate that he regarded the case as one of salvage. In the present case, asking even £3,000 for towing a distance of 125 miles was a clear indication of a claim to a salvage service.

The case is one of a *quantum meruit* for salvage. The value of the Leipsic, cargo and freight was over \$264,000. The value of the Gresham was \$90,000. In regard to the Leipsic, there are these facts: she had lost the use of her steam-power; with the sails she had, and such winds as she had had, she would, at her prior rate of sailing, have been between 3 and 4 days in reaching Sandy Hook; she was in the Gulf Stream, drifting northeasterly when it was calm; she was in good condition except as to her steam-power; she had tried sailing and had determined to abandon it and was seeking assistance from steamers; delay had become serious; and her captain took the services of the Gresham though he knew it would be under a claim for £3,000, rather than let the Gre-

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sham go and trust to the other steamer in sight, or to some other resource. In regard to the Gresham, she put back 40 miles, and went out of her way, to a port to which she was not bound; she was delayed in all 48 hours; she had a charter to begin at Baltimore the 25th, which she might have lost; and the service was, in fact, not difficult or dangerous.

I think the £3,000 is entirely too much. At the same time I think the \$3,750 is not enough. I award the sum of \$5,500. Of this the Gresham is to have $\frac{3}{4}$ or \$4,125. This is peculiarly a case where her owners ought to have a large share. Of the remaining \$1,375, the master of the Gresham is to have \$150, and the rest is to be divided among her master, officers and crew, in proportion to the rates of their respective wages.

The District Court awarded costs in that Court to the libellants, as the claimant had made no tender. This was correct. As both parties have appealed, and each has had partial success, no costs in this Court are allowed to either party.

THE PEOPLE OF THE STATE OF NEW YORK

vs.

THE COMPAGNIE GÉNÉRALE TRANSATLANTIQUE.

The Act of the Legislature of New York, passed May 31st, 1881, (*Laws of New York*, 1881, chap. 432, p. 590,) imposing a duty of \$1 for each alien passenger arriving at the port of New York from a foreign port, and appropriating the money to "the execution of the inspection laws of the State of New York" by the Commissioners of Emigration, is in conflict with the exclusive power of Congress, under the Constitution of the United States, to regulate commerce. The "inspection laws" referred to are the provisions of the Act of the Legislature of New York, passed May 28th, 1881, (*Laws of New York*, 1881, chap. 427, p. 585,) for inspecting the persons and effects of all persons arriving by vessel at the port of New York from a foreign country.

The Act of May 31st, 1881, is not valid as a statute laying an impost, or a duty on imports, for executing inspection laws, under Article 1, section 10, of the

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Constitution of the United States, because the Act of May 28th, 1881, is not an inspection law.

What are "inspection laws," defined.

Although, by section 10, of Article 1, of the Constitution of the United States, State inspection laws are made subject to the revision and control of Congress, this Court has authority to decide whether a particular law is an inspection law or not.

(Before BLATCHFORD, J., Southern District of New York, February 9th, 1882.)

BLATCHFORD, J. This suit was commenced in the Court of Common Pleas for the city and county of New York, and was removed into this Court. The complaint was put in in the State Court. It alleges that the defendant is and was, at the times thereafter mentioned, a corporation, formed under the laws of France, and owner of the vessels thereafter named; that the defendant, by vessels from a foreign port, brought to the port of New York alien passengers, for whom a tax has not heretofore been paid, by the vessels, on the dates, from the ports and to the number stated in the complaint, being in June, July and August, 1881, by 9 vessels, on 16 voyages, all from Havre or Marseilles, the number of alien passengers being, in all, 6,214; that the master, owner, agent and consignees of such vessel each and all failed and neglected to pay or cause to be paid to the chamberlain of the city of New York, within 24 hours after the arrival of each of said vessels at the port of New York, or at any time, the sum of \$1 for each and every of said passengers so brought as aforesaid, nor has any part thereof been paid; and that there is due to the plaintiffs from the defendant, by reason of the premises, the sum of \$7,767 50, debt and penalty, and interest thereon from the day after the entry of each vessel at the port of New York, for the tax and penalty imposed by law respectively, for which sum, with interest, the plaintiffs demand judgment, with costs. The defendant has put in, in this Court, a demurrer to the complaint, which states, as the ground of demurrer, that it appears upon the face of the complaint that it does not state facts sufficient to constitute a cause of action. The parties, by their attorneys, have stipu-

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lated in writing that this action "is brought and prosecuted under and pursuant to an Act of the Legislature of the State of New York, passed May 31st, 1881, and known as chapter 432 of the laws of 1881;" and that the demurrer is based upon the claim that the said Act "is repugnant to various provisions of the Constitution of the United States, (particularly Article 1, section 8, and subdivision 2 of section 10,) and also to the Revised Statutes of the United States, and also to the provisions of the Treaties now existing between the United States and France and other countries." The stipulation states that its intent is "to remove any question as to the right of the defendant to present and urge all such questions with the same force and effect as if the demurrer assigned various causes, separately setting up each and every objection that may be based upon the Constitution of the United States or of the State of New York, or upon any existing treaties with foreign powers, or upon any alleged want of power on the part of the State to enact such a statute as that now sought to be enforced, or of the plaintiffs to bring and maintain this action."

The Act of May 31st, 1881, (*Laws of New York*, 1881, chap. 432, p. 590,) is as follows: "§ 1. There shall be levied and collected a duty of one dollar for each and every alien passenger who shall come by vessel from a foreign port to the port of New York, for whom a tax has not heretofore been paid, the same to be paid to the chamberlain of the city of New York, by the master, owner, agent or consignee of every such vessel, within twenty-four hours after the entry thereof into the port of New York. § 2. It shall be the duty of the master or acting master of every such vessel, within twenty-four hours after its arrival at the port of New York, to report under oath, to the mayor of the city of New York, the names, ages, sex, place of birth and citizenship of each and every passenger on such vessel, and in default of such report every passenger shall be presumed to be an alien arriving at the port of New York for the first time. And in default of every payment to the chamberlain of the city of New

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York, there shall be levied and collected of the master, owner, agent or consignee of every such vessel, a penalty of twenty-five cents for each and every alien passenger, in addition to the duty heretofore imposed. § 3. It shall be the duty of the chamberlain of the city of New York to pay over, from time to time, to the commissioners of emigration, all such sums of money as may be necessary for the execution of the inspection laws of the State of New York with the execution of which the commissioners of emigration now are or may hereafter be charged by law, and to take the vouchers of the commissioners of emigration for all such payments. And it shall be the duty of the said chamberlain to pay over annually, on the first of January in each year, to the Treasury of the United States, the net produce of all the duties collected and received by him under this Act, after the payments to the commissioners of emigration aforesaid, and take the receipt of the Secretary of the Treasury therefor. § 4. The commissioners of emigration shall institute suits in the name of the people of the State of New York, for the collection of all moneys due, or which may grow due, under this Act, the same to be paid, when collected, to the chamberlain of the city of New York, to be applied by him pursuant to the terms of this Act. § 5. Section one shall not apply to any passenger whose passage ticket was actually issued and paid for prior to the time this Act takes effect, but every ticket shall be presumed to have been issued after this Act takes effect, in the absence of evidence showing the contrary. § 6. This Act shall take effect immediately."

Three days prior to the passage of the said Act, and on the 28th of May, 1881, (*Laws of New York*, 1881, chap. 427, p. 585,) an Act was passed as follows: "§ 1. The commissioners of emigration are hereby empowered and directed to inspect the persons and effects of all persons arriving by vessel at the port of New York from any foreign country, as far as may be necessary to ascertain who, among them, are habitual criminals or pauper lunatics, idiots or imbeciles, or deaf, dumb, blind, infirm or orphan persons, without means

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or capacity to support themselves, and subject to become a public charge, and whether their persons or effects are affected with any infectious or contagious disease, and whether their effects contain any criminal implements or contrivances. § 2. On discovering any such objectionable persons or effects, the said the commissioners of emigration and its inspectors are further empowered to take such persons into their care or custody, and to detain or destroy such effects, if necessary for the public welfare, and keep such persons under proper treatment, and provide for their transportation and support as long as they may be a necessary public charge. The commissioners of emigration shall, in case of habitual criminals, and may, in other cases where necessary to prevent such persons from continuing a public charge, retransport such person or persons to the foreign port from which they came. § 3. The commissioners of emigration are further empowered to board any incoming vessel from foreign ports arriving at the port of New York, by its agents and inspectors, who shall have such powers as may be necessary to the effectual execution of this Act, and any person who shall resist them in the execution of their lawful function shall be guilty of a misdemeanor and may be arrested by the officer resisted, and, upon conviction, may be sentenced to a term not exceeding six months in the penitentiary, or to pay a fine of one hundred dollars, or both. § 4. This Act shall take effect immediately."

These provisions were enacted with an endeavor to avoid the grounds on which former legislation had been held void as repugnant to the Constitution of the United States. The provisions of part 1, chapter 14, title 4 of the Revised Statutes of New York, which authorized the recovery from the master of every vessel arriving in the port of New York from a foreign port, of a sum of money for each passenger, and appropriated the money to the use of the marine hospital, were held void in *The Passenger Cases*, (7 How., 283,) in January, 1849. After that various amendments of the law were made, which came before the Supreme Court in *Henderson v. The Mayor*, (2 Otto, 259,) in 1875, and were held

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void. This legislation required a bond for each passenger landed by a vessel from a foreign port, to indemnify the commissioners of emigration and every municipality in the State against any expense for the relief or support of the passenger for 4 years, but the owner or consignee of the vessel could commute for the bond, and be released from giving it, by paying \$1 50 for each passenger, within 24 hours after landing him. If the bond was not given nor the sum paid within the 24 hours, a penalty of \$500 for each passenger was incurred, which was made a lien on the vessel, collectible by attachment at the suit of the commissioners of emigration. The statute applied to every passenger, and not merely to every alien passenger. It applied to every passenger by a vessel from a foreign port, landed at the port of New York. The Court held that the statute amounted to a requirement of the payment of the \$1 50; that it was, in its purpose and effect, a law imposing a tax on the owner of the vessel for the privilege of landing in New York passengers transported from foreign countries; that, in taxing every passenger, it taxed a citizen of France, landing from an English vessel, for the support of English paupers landing at the same time from the same vessel; that a law prescribing the terms on which vessels shall engage in transporting passengers from European ports to ports of the United States is a regulation of commerce with foreign nations; that Congress alone could regulate such commerce; and that a State could not, under any power supposed to belong to it, and called police power, enact such legislation as that then under consideration. The Court expressly reserved the question as to how far, in the absence of legislation by Congress, a State could, by appropriate legislation, protect itself against *actual* paupers, vagrants, criminals and diseased persons, arriving in its territory from foreign countries. A portion of the legislation of New York then under consideration concerned persons who should, on inspection, be found to belong to those classes, but the Court acted on and held void that part of the statute which applied to all passengers alike, and that part alone.

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The Act of May 31st, 1881, differs from the prior statute only in levying a duty of \$1 for each alien passenger instead of \$1 50 for each passenger; and it may, perhaps, be limited to an alien who arrives for the first time. But it applies to such aliens who come as travellers for pleasure, and have means, and intend to go back, and to such aliens who come intending to remain, and have means, as well as to such aliens who are of the classes mentioned in § 1 of the Act of May 28th, 1881. It compels the owner of the vessel to pay \$1 for each of the alien passengers embraced in it, for the privilege of landing him. The tax is expressly imposed for having the passenger come by the vessel from a foreign port to the port of New York. The new statute is as liable to the objections stated by the Court in the Henderson case as was the statute in that case.

But it is contended that the provisions of § 3 of the Act of May 31st, 1881, make the statute valid, as one laying an impost or a duty on imports for executing its inspection laws, under this provision of Article 1, section 10, of the Constitution of the United States: "No State shall, without the consent of Congress, lay any imposts or duties on imports or exports, except what may be absolutely necessary for executing its inspection laws; and the net produce of all duties and imposts laid by any State on imports or exports, shall be for the use of the Treasury of the United States; and all such laws shall be subject to the revision and control of the Congress." The Act of May 28th, 1881, is the only so called inspection law of the State of New York cited as one with the execution of which the commissioners of emigration are charged by law. The money received from the \$1 tax for each alien passenger arriving for the first time is to be expended, as far as necessary, in executing the Act of May 28th.

The question arises, therefore, whether the Act of May 28th is an inspection law, within the meaning of Article 1, section 10. Inspection laws were known when the Constitution was framed in 1787, and what were inspection laws was well understood. They had reference solely to merchandise.

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Their object was to improve the quality of articles and fit them for exportation or domestic use. (*Gibbons v. Ogden*, 9 Wheat., 1 and 203; 1 *Kent's Comm.*, 439; *Story on the Constitution*, § 1,017.) In No. 44 of The Federalist, Article 1, section 10, of the Constitution, is commented on, and it is said that the manner in which the restraint on the power of the States over imports and exports is there qualified, that is, in regard to inspection laws, "seems well calculated at once to secure to the States a reasonable discretion in providing for the conveniency of their imports and exports, and to the United States a reasonable check against the abuse of discretion." In Burrill's Law Dictionary, "inspection" is defined thus: "Official view or examination of commodities or manufactures, to ascertain their quality, under some statute requiring it." In Bouvier's Law Dictionary, this is the definition: "The examination of certain articles made by law subject to such examination, so that they may be declared fit for commerce." In *Clintsman v. Northrop*, (8 Cowen, 45,) the inspection laws of New York are said "to be laws to protect the community, so far as they apply to domestic sales, from frauds and impositions, and, in relation to articles designed for exportation, to preserve the character and reputation of the State in foreign markets." By the Constitution of New York of 1846, (*Article 5, section 8*,) all offices for "inspecting any merchandise, produce, manufacture or commodity whatever" were abolished.

As the term "inspection laws," in the section under consideration, refers only to laws for inspecting articles of merchandise, this shows that the terms "imports" and "exports" in the same section refer only to articles of merchandise. Persons are not imports or exports or articles to be inspected, under the section. To pass a statute directing persons to be inspected, to ascertain their condition as to character, or pecuniary means, or physical characteristics, and then another statute calling the first one an inspection law, does not make it an inspection law. It was not, and is not, and can never be an inspection law, in the sense of the Constitution. Nor can

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passengers arriving in the United States be imports or exports, in the sense of the Constitution. In *Brown v. The State of Maryland*, (12 Wheaton, 419, 437,) the section referred to was under consideration, and it was said by the Court: "What, then, is the meaning of the words 'imposts or duties on imports or exports'? An impost, or duty on imports, is a custom or a tax levied on articles brought into a country, and is most usually secured before the importer is allowed to exercise his rights of ownership over them, because evasions of the law can be prevented more certainly by executing it while the articles are in its custody. It would not, however, be less an impost or duty on the articles, if it were to be levied on them after they were landed. The policy and consequent practice of levying or securing the duty before or on entering the port does not limit the power to that state of things, nor, consequently, the prohibition, unless the true meaning of the clause so confines it. What, then, are 'imports'? The lexicons inform us they are 'things imported.' If we appeal to usage for the meaning of the word, we shall receive the same answer. They are the articles themselves which are brought into the country. 'A duty on imports,' then, is not merely a duty on the act of importation, but is a duty on the thing imported. It is not, taken in its literal sense, confined to a duty levied while the article is entering the country, but extends to a duty levied after it has entered the country. The succeeding words of the sentence, which limit the prohibition, show the extent in which it was understood. The limitation is, 'except what may be absolutely necessary for executing its inspection laws.' Now, the inspection laws, so far as they act upon articles for exportation, are generally executed on land, before the article is put on board the vessel; so far as they act upon importations, they are generally executed upon articles which are landed. The tax or duty of inspection, then, is a tax which is frequently, if not always, paid for service performed on land, while the article is in the bosom of the country. Yet this tax is an exception to the prohibition on the States to lay duties on

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imports or exports. The exception was made because the tax would otherwise have been within the prohibition." These observations are persuasive to show that persons are not imports or exports, or the subjects of inspection laws, within section 10 of Article 1. The word "imports" and the word "exports" must have equal extent and scope. The former can have no greater than the latter. The suggestion that persons departing from the United States by vessel could properly be said to be exported, or to be exports, under any circumstances, even when re-transported by public authority, is not one which commends itself to the general understanding. If not exports they cannot be imports. The fact that the importation of persons is referred to in section 9 of Article 1 has no effect to include persons within the word "imports," where that word is used. The clause referred to prevents Congress from prohibiting, prior to 1808, "the emigration or importation of such persons" as any of the States then existing should think proper to admit. So far as this section referred to the involuntary arrival of persons it had reference to persons brought in to become slaves and articles of merchandise.

There is nothing authoritative in *The Passenger Cases*, (7 *How.*, 283,) or in any other decision of the Supreme Court, which conflicts with the foregoing views. The new statute of New York being void under the decision in the Henderson case, no authority upholding it as a law laying a duty on imports, to execute an inspection law, can be derived from section 10 of Article 1. In *Railroad Co. v. Husen*, (5 *Otto*, 465, 472,) the principle of the Henderson case was affirmed and applied, as a principle which forbids a State from burdening foreign commerce under the cover of exercising its police powers. It is such a burden to tax *all* alien passengers arriving by vessel for the first time; and the fact of examining or inspecting the persons of such passengers to see if they are good or bad, poor or rich, sane or lunatic, diseased or well, does not make the tax a tax to execute an inspection law. Under this guise, any law which required examination of any person

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or thing, and which used the word "inspection," could be thereby made an inspection law, and the restraint of the Constitution could be frittered away, so long as the duties laid did not exceed what was necessary to execute the particular law.

But there is, moreover, on the face of the Act of May 28th, sufficient evidence that it cannot be regarded as an inspection law. The Acts of May 28th and May 31st cannot either of them derive any greater force from the fact that they are two Acts than the enactments in the two would have if they were all in one and the same Act. The Act of May 28th goes beyond the inspection and the ascertainment of the facts prescribed, and authorizes the commissioners to take the objectionable persons into their care or custody and provide for the transportation and support of such persons "so long as they may be a necessary public charge." Some of the objectionable persons are defined to be "infirm or orphan persons, without means or capacity to support themselves, and subject to become a public charge." This is an eleemosynary system for supporting paupers, it may be for their lives. Able-bodied aliens arriving here for the first time, with means, in health, not among the classes called "objectionable" in the Act, are to have a tax of \$1 laid for each of them, to support such system. This is not an inspection law. It is a direct interference with the exclusive power of Congress to regulate commerce with foreign nations.

It is urged for the plaintiffs, that, inasmuch as section 10 of Article 1 declares that the State inspection law shall be subject to the revision and control of Congress this Court has no jurisdiction to revise or control the action of the State in enacting or administering the law. If the law is an inspection law, it is, as such, subject to the revision and control of Congress. But this fact cannot deprive the Court of its power of adjudging, in a proper suit, whether the law is an inspection law at all, or whether it is a law of another character.

It results from the foregoing considerations, that the de-

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murrer is sustained and judgment is ordered for the defendant, with costs.

Lewis Sanders and George N. Sanders, for the plaintiffs.

Frederic R. Coudert, for the defendant.

JOHN CARRIER

vs.

THE TOWN OF SHAWANGUNK.

An Act authorizing the commissioners of a town to borrow money and issue its bonds provided that the power conferred by the statute should only be exercised on the condition that the consent should first be obtained, in writing, of tax-payers appearing on the last assessment roll, representing a majority of the taxable property of the town, proof of which should be by the acknowledgment or proof thereof filed in the town and county clerk's offices and annexed to a copy of the assessment roll. The bonds of the town were issued, payable to bearer, and reciting that they were issued in pursuance of the Act. The plaintiff sued the town on some of the bonds, and at the trial proved that he obtained the bonds from a bank, and that its attorney, before the bank purchased them, examined a certified copy of the consent and assessment roll and ascertained therefrom that a majority of the persons on the roll had consented, and that the bank then bought the bonds and paid value for them, without notice of any defence. The defendant then offered in evidence a certified copy of the consent roll of the town, and a certified copy of the assessment roll, to show that the consent of a majority in value of the tax-payers was not obtained. The Court excluded the evidence: *Held*, no error.

(Before SHIPMAN, J., Southern District of New York, February 9th, 1882.)

SHIPMAN, J. This is an action at law, to recover the amount due upon sundry bonds for \$2,400, issued by the town of Shawangunk and payable to bearer. The bonds recited that they were issued in pursuance of the Act which is

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hereafter mentioned and by duly appointed commissioners. The second section of chapter 880 of the Session laws of New York, of 1866, (*p.* 2,074,) provided, that it should be lawful for the commissioners (appointed by the county judge upon the application of twelve freeholders, residents of the town,) to borrow, on the faith and credit of the town, such sum of money as the tax-paying inhabitants of the town should fix upon by their assent in writing, not exceeding a specified percentage of the assessed valuation of the property of the town for the year 1865, "provided, however, that the powers and authority conferred by this section shall only be exercised upon the condition that the consent shall first be obtained in writing of such number of the tax-payers of such town, their heirs or legal representatives, appearing upon the last assessment roll for the year 1865, as shall represent a majority of the taxable property of such town, proof of which shall be by the acknowledgment or proof thereof, as required for deeds of real estate, filed in the town and county clerk's office of the respective counties, and annexed to a copy of the assessment roll of the town for 1865."

For the purpose of showing that the plaintiff, whether a purchaser for value or not, had the title and rights of a *bona fide* holder, because he was the successor of the Dime Savings Bank, which was a purchaser for value, before maturity, and without notice of any claim of non-liability on the part of the town, the plaintiff proved, by the attorney of the bank, that, before the purchase and before maturity, he investigated whether the consent of the town to the issue of the bonds had been obtained, as prescribed by the Act. Before the examination, he had never heard of any claim on the part of the town, or its officers, that the bonds were invalid. He examined a certified copy of the consent and assessment rolls of the town, and ascertained that the majority of the persons upon the assessment list had signed the petition or consent to the bonding of the town, and that the consents represented a majority of the property of the town, and that these facts had been certified to by the proper officers. The witness tes-

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tified: "I carefully added up and reviewed the additions already added up, proved the figures, and found them correct. I counted the names for myself, and I read the certificate. It was the county clerk's of Ulster county. * * * I ascertained that all the names on the consent roll were on the assessment roll and checked them off, and added up the amount of the property." The result of the investigation was reported to the Bank, which thereupon bought a large amount of the bonds for ninety *per cent.* of their par value. The certified copy was delivered to the Bank, and was thereafter mislaid and lost.

It was not claimed by the defendant that the Bank had any actual notice of any alleged invalidity of the bonds, but the defendant, after the plaintiff had rested, offered a certified copy of the consent roll of the town, in pursuance of which the bonds were authorized to be issued, together with a certified copy of the assessment roll of the town for the year 1865, to show that the consent of the majority in value of the tax-payers was not obtained, and insisted "that the Bank must stand or fall by the roll as it in fact was, not by any mistaken interpretation of it by its attorney; and that it was not a *bona fide* holder, without notice, because it had undertaken to investigate the matter, and did not rely on the face of the security." The Court excluded the evidence, to which ruling the defendant excepted, and, a verdict having been subsequently directed for the plaintiff, the defendant filed a bill of exceptions and a motion for a new trial. The question in regard to the exclusion of the certified copies of the consent and assessment rolls for the purpose for which they were offered, was the only one which was argued by the defendant.

It will be observed, that these rolls were not offered, either upon cross-examination of the attorney or as independent evidence, to show that he had actual notice of any defect in the number of consents, or that he would have had notice if he had exercised reasonable diligence, but they were offered upon the alleged ground that, inasmuch as the Bank's attorney had examined certified copies, it, therefore, could not be

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a *bona fide* purchaser, if a comparison of the consent roll with the assessment roll would show that the consent of a majority in value had not been obtained, although diligent scrutiny, at the time of the purchase, did not disclose this alleged fact. The defendant's proposition was, that the purchaser, before maturity, of municipal bonds payable to bearer, is not a *bona fide* holder, if he undertakes to investigate the validity of the bonds which he proposes to buy, and investigation would have revealed to him a defect, although it was not disclosed by diligent examination, and that such purchaser is charged with notice of all that a complex record might show, although it is not claimed that he had notice of any defect in the bonds, and it is clear that diligent scrutiny of the copies of the public records which were furnished to him did not disclose any suggestion of such defect. No such artificial rule in regard to notice has been established. It is true, that purchasers of municipal bonds are charged with notice of the laws of the State which authorized the issue, and of a want of power in the municipality or its officers to execute or issue the bonds. In this case, it is fairly to be gathered from the statute, that the commissioners were invested with power to decide whether the proper number of tax-payers had consented, and whether, therefore, the condition precedent had been complied with, and their recitals in the bonds, when held by a *bona fide* purchaser, are conclusive. (*Coloma v. Eaves*, 92 U. S., 484; *Humboldt v. Long*, 92 U. S., 642; *Walnut v. Wade*, 103 U. S., 683.) Knowledge, by the purchaser of municipal bonds before maturity, of their invalidity, when there are no marks of infirmity on the face of the instrument, and there is no want of power in the municipality or its officers to execute and issue the bonds, is a question of fact. It being admitted that the purchaser before maturity, for value, had no actual notice or suspicion of any defect, and the bonds, in substance, reciting compliance with the condition precedent which was required by the statute, the arbitrary rule claimed by the defendant, which declares that he did have constructive notice of a defect, does not exist.

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The motion for a new trial is denied, and the stay of proceedings is vacated.

Charles C. Leeds and *Charles H. Winfield*, for the plaintiffs.

D. M. De Witt, for the defendant.

BENNETT B. SCHNEIDER

vs.

FRANK H. LOVELL AND ORVILLE D. LOVELL. IN EQUITY.

Re-issued letters patent No. 7,511, granted to Bennett B. Schneider, February 13th, 1877, for an "improvement in shade-holders for lamps," the original patent, No. 182,973, having been granted to Carl Votti, as inventor, October 3d, 1876, do not describe the shape or size of the parts, or the proportion of the parts of the shade, or the principle which is to govern the construction of the shade as to size and proportions, and there is no infringement of the patent by a shade which is not of the form and dimensions and size and height and proportions of the shade shown in the drawings of the patent.

(Before BLATCHFORD, J., Southern District of New York, February 10th, 1882.)

BLATCHFORD, J. This suit is brought on re-issued letters patent No. 7,511, granted to the plaintiff, February 13th, 1877, for an "improvement in shade-holders for lamps," the original patent, No. 182,973, having been granted to Carl Votti, as inventor, October 3d, 1876. The specification of the re-issue says: "My invention relates to lamps, and it consists in a transparent shade-holder, or holder of a material allowing the passage of light, and shade or globe so arranged that an ordinary lamp burner can be used without a chimney, as will be hereinafter more fully set forth. In the annexed drawing, figure 1 is a vertical section of my invention. Fig. 2 is a plan view of the shade-holder. A represents an ordi-

nary lamp burner, provided with a circumferential flange, *a*, for the support of the cone *b*, and which, ordinarily, also serves to support the chimney or cylinder. This flange is provided with suitable perforations, through which air is admitted both inside and outside of the cone. Instead of using the flange *a* for the support of the ordinary chimney, I place on the same my shade-holder, B, which is made of glass or other suitable transparent material, or material that will allow of the passage of light, and which is provided with a tubular extension or socket, *c*, that fits over the cone *b*, leaving an air space between its inner surface and the outer surface of said cone. From said socket extends a broad disk-shaped flange, *d*, which is provided with a rim, *e*, and which serves to support and retain the shade, C. The flange, *d*, is perfectly closed, so that no air will pass to the flame except what is admitted through the perforations in the burner flange, *a*, and by these means I am enabled to produce a bright flame without the use of an ordinary chimney or cylinder. The advantages of this arrangement will be apparent, since it allows of keeping the burner clean and of trimming the wick without difficulty, and the annoyance of broken chimneys is avoided. It will be seen, that with the shade-holder and shade arranged as shown and described, the ordinary burner will perform the required functions without the use of a chimney. I am well aware that transparent shade-holders are of themselves not new; hence, I do not claim such, broadly, as being my invention." The claims of the re-issue are as follows: "1. In a lamp having a burner, the combination of a shade-holder made of material that will admit of the passage of light, and a shade or globe, arranged and constructed substantially as described, whereby the burner performs the required functions without the use of a chimney, as set forth. 2. The shade-holder, B, constructed of material that will admit of the passage of light, and provided with a downwardly extending socket, *c*, and disk-shaped flange, *d*, with rim, *e*, in combination with a globe or shade, C, and burner, A, of a lamp, as and for the purposes herein set forth. 3. The combination,

in a lamp, of the burner, A, having perforated flange, *a*, and cone, *b*, the shade-holder, B, with central socket, *c*, and a shade or globe, C, substantially as and for the purposes herein set forth."

One of the defences set up in the answer is, that in the specification of the re-issue there is not given, as required by the statute, a description of the invention, and of the process of making, constructing, and using it, in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and use the same, nor is there explained in or by said specification the principle of the alleged invention, and the best mode in which said Votti has contemplated applying that principle, so as to distinguish it from other inventions, and that, therefore, the patent is void.

In the specification nothing is said as to the shape or size of the parts, or proportion of the parts, of the shade, C. Nothing is said about it except to call it a globe or shade, and to designate it as C, by a letter of reference to the drawings. Nothing is said as to the diameter of the contraction at the narrowest part of it near its top, as compared with the diameter of the socket *c* of the shade-holder: and nothing as to its height or as to the degree of flare of the shade-holder. These things are shown by the evidence to be material in constructing an arrangement of the kind which will give as good a light as with the use of a chimney. The object of the arrangement is stated in the specification to be to use an ordinary burner without a chimney, and to dispense with the ordinary chimney. This can only mean that as good a light is to be produced without as with a chimney. The meaning of the words "a bright flame," in their context, is, as bright a flame as the chimney will produce. The meaning of the expression, that "the ordinary burner will perform the required functions without the use of a chimney," is, that the ordinary burner will give as much light without the use of a chimney. This is to be done by having "the shade-holder and shade arranged as shown and described," yet the features of construc-

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tion, and shape, and size, and proportions of the shade, are not set forth. So, too, in claim 1, "a shade or globe arranged and constructed substantially as described," is spoken of, yet nothing is described as to the construction of the shade. It is true that, by looking at C in the drawings, a shade of a certain form is shown. But the drawings are not said to be on a scale. Looking at the drawings and making a shade from them gives but one form of shade, at most, and there is no statement of the principle which is to govern the construction of the shade as to size and proportions. It is shown that a shade made, as nearly as can be ascertained, of the form and proportions shown in the drawings will cause the burner to give light to some degree, but by no means to the same degree as the ordinary chimney will with the same burner. It is not the shade of the drawings that has been made and sold by the plaintiff under the patent, nor have the defendants made or sold the shade of the drawings. To reach the shades of either the plaintiff or the defendants required experiment, adaptation, and invention beyond anything shown in the drawings. Construing the patent as covering a shade of the form, and dimensions, and size, and height, and proportions shown in the drawings, no such shade has been made or sold by the defendants, and so there has been no infringement. This is the most favorable view which can be taken of the patent.

The bill is dismissed, with costs.

Gifford & Gifford, for the plaintiff.

J. P. Fitch, for the defendants.

Hart v. Thayer.

WILLIAM H. HART, JR.

vs.

HIRAM H. THAYER. IN EQUITY.

Re-issued letters patent, No. 7,909, granted to William H. Hart, Jr., October 9th, 1877, for an "improvement in neck-ties," the original patent, No. 159,921, having been granted to him February 16th, 1875, are not infringed by a pin constructed according to the description in letters patent No. 206,673, granted to Albert M. Smith and Hiram H. Thayer, April 23d, 1878.

If the re-issue claims more than the original, so as to cover the defendant's pin, it covers new matter, not found in the original, and is for an invention not shown in the original.


(Before BLATCHFORD, J., Southern District of New York, February 18th, 1882.)

BLATCHFORD, J. This suit is brought on re-issued letters patent, No. 7,909, granted to the plaintiff October 9th, 1877, for an "improvement in neck-ties," the original patent, No. 159,921, having been granted to him February 16th, 1875. The specification of the re-issue is as follows, reading what is outside of brackets and what is inside of brackets, omitting what is in italics: "Figure 1 is a face view of the device embodying my invention. Fig. 2 is a side view thereof, partly in section. Fig. 3 is a side view, enlarged, of a detached part. Similar letters of reference indicate corresponding parts in the several figures. In the class of neck-ties wherein the front bow, which is made long and lies on the chest, is held in position by a band which passes around the neck, it is necessary to secure said band in some manner, to prevent displacement of the tie. For this purpose pins have been sewed to the shields or supporting plates of the ties and the neck bands engaged therewith; but this is objectionable, since the pin soon loosens and is lost. Again, the cost of thus attaching the pin is a matter of considerable moment. My invention is designed to remedy these defects;

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and consists in securing the pins to the shields by metallic fastenings, whereby the pins are firmly retained in place, longer service is rendered thereby, and there is a cheapness in the product. Referring to the drawings, A represents a shield or supporting-plate for a neck-tie, which consists of a long bow or knot, *a*, constituting the front portion, and a band, *b*, which passes around the neck, the two parts being shown in dotted lines. To the bottom portion of the shield or plate I secure a pin, B, which projects downwardly, so that the band *b* may be attached thereto, in order that the band will not disengage from the neck and release the tie. I secure the pin to the shield by metallic rivets, [or projections,] C, which readily clinch on the shields and firmly connect the two parts. These rivets [or projections are attached to the pin in any suitable manner, and they may be parts of the pin itself; or they may be separate pieces of metal fastened to it. Thus they] may be passed through the flattened body of the pin *and the shield* and headed, or [they may be] punched out of the said [body.] *body*, [The metallic rivet or projection is passed through the shield,] and [is] bent over [and] *or* clinched [upon the opposite side.] *on the shield*. It will be seen that the connection of the pin and shield is firm and [durable.] *durable*. [Whereas] *I overcome loosening of the pin due to outting of the threads, [formerly] which heretofore, in use, [passing] have been passed through openings in the pin, [were cut by their edges, or rotted away from corrosion of the pin through] or rotting of said thread consequent to perspiration, [and the pin was soon lost or loosened.] corroding the pin*. Again, as the work can be performed by machinery, instead of stitching or sewing by hand, labor is materially reduced, whereby there is [a] great saving in the [cost of production.] *product*. [I do not claim any particular method of attaching the metal fastenings to the pin, since any of the well-known methods of attaching metals together may be employed, either cohesion by welding or soldering, or forming both pin and fastenings out of one piece of metal, or adhesion and pressure by making one metal inclose the

other.]" Reading in the foregoing what is outside of brackets, including what is in italics, and omitting what is inside of brackets, gives the text of the original specification. The claims of the re-issue are as follows: " 1. The pin B and neck-tie shield A, in combination with the metallic fastening C, substantially as and for the purpose set forth. 2. The pin B, formed with the fastening C, in combination with the neck-tie shield A, substantially as and for the purpose set forth. 3. A metallic fastening or metallic fastenings, C, attached to and projecting from the pin B, substantially as and for the purpose set forth." The original patent had only two claims. The first was the same as claim 1 of the re-issue. The second was the same as claim 2 of the re-issue, with the words "punched out" inserted between "the" and "fastening."

It is claimed that the defendant has infringed claim 2 of the re-issue by making and selling neck-tie shields with pins such as are described in letters patent No. 206,673, granted to Albert M. Smith and Hiram H. Thayer, April 23d, 1878. The pin is of metal, pointed at one end. In its length are two bends, which are nearly at right angles to the length of the body. One bend is farther from the point than the other bend is from the opposite end. Each bend is made by two right angled deflections of the body of the pin. From the bend near the end farthest from the point, the body of the pin proceeds on in a line not continuous with the line of the pin the other side of said bend, but parallel therewith. The other bend is so made as to bring back the line of the pin between said bend and the point to the line of the pin the other side of the first-named bend. The shape of the pin, with the two bends, is this:  The pin is attached to the shield by passing it through two holes in the shield, one hole at each bend, so that the two ends of the pin are on one side of the shield and the middle part or body is on the other side of it. The bends are abrupt or short, and form shoulders, which bear in the holes and keep the pin from moving or slipping back and forth. The pin, after it is in the

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shield, is flattened, especially at the unpointed end, so that it will lie more closely and firmly to the shield and not project from its surface. The pin is put into the shield and fastened by springing its ends together sufficiently to put them through the holes made for them in the shield, and then springing the pin back again. The claim of the patentee is to the combination of the shield with the pin constructed and arranged to operate substantially as and for the purpose thus set forth.

The original patent, No. 159,921, speaks of only two ways of forming the fastenings of the pin. One is to have metallic rivets passing through the body of the pin and headed. The other is to have the rivets punched out of the body of the pin and bent over or clinched on the shield. The first claim of that patent is for the combination of three things—the shield, the pin and the separate rivet fastening. The second claim is for a combination of the shield and the pin having rivets punched out of its body. But, with either form of fastening, the entire pin, when in place, is on one side of the shield, and the bent over or clinched or headed ends of the fastenings are on the other side of the shield. The body of the pin is straight and continuous, aside from the supplementary fastenings. In the defendant's pin the body is not straight and there are no supplementary fastenings. The body of the pin, by being bent, fastens itself. Manifestly, the effort in the specification of the re-issue is to enlarge the scope of the patent beyond what is warranted by the original. The re-issue says that the projections may be "parts of the pin itself." No way is shown in the original of making the projections parts of the pin itself except by puncturing them out of its body. That means partly detaching part of the body and letting it form a pin or projection, to be bent down and clinched on the other side of the shield. The defendant's bends are parts of the pin itself, but they are not projections *from* the body, as in the plaintiff's pin, but are projections *of* the whole body, in its devious path. The second claim of the re-issue, if construed to mean anything more than the second claim of the original, so as to cover the defendant's pin, covers

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new matter not found in the original, and is for an invention not shown in the original. That defence is set up in the answer. The only pin with a fastening forming part of its body, described or shown in the original, is a pin with a fastening punched out of its body. A pin formed with a fastening which is part of the pin itself is a form of description ingeniously devised to cover a punched-out fastening, and also such bent fastenings as those in the defendant's pin. But the claim cannot be construed to cover any fastening but a punched-out fastening or one that is its equivalent. The defendant's bent fastenings are not equivalents. They are an invention in a new direction, not based on the plaintiff's idea. As against the plaintiff's pin the defendant's is patentable and not an infringement of claim 2 of the plaintiff's re-issue. The radical difference between the two pins is that the principle of fastening is different in the two, the defendant's pin dispensing with all fastenings that are separate from the pin itself or that are partly detached parts of the body, as fastening devices, separate from the whole body. As an incident of the difference in structure, and illustrating it, no two portions of the defendant's pin on opposite sides of the shield are directly opposite to each other. The parts do not form the jaws of a clamp, as in the plaintiff's. The shield is held by virtue of the strength of the cross section of the pin and not by the clamping action of two directly opposite parts.

The bill is dismissed, with costs.

F. H. Betts and *J. Van Santvoord*, for the plaintiff.

J. P. Fitch, for the defendant.

LIZZIE BRETT AND ANOTHER, ADMINISTRATORS OF HENRY
A. WELLS

vs.

WALTER C. QUINTARD, ADMINISTRATOR OF ELBRIDGE BROWN.

Claim 5 of re-issued letters patent No. 2,942, granted May 19th, 1868, to Eliza Wells, administratrix of Henry A. Wells, for "improvements in machinery for making hat bodies of fur," is not infringed by the Gill machine.

Under the decisions in regard to this patent, in *Burr v. Duryee*, (1 *Wall.*, 531,) and in *Gill v. Wells*, (22 *Wall.*, 1,) the Wells machine and the Gill machine contain two radically different vehicles for the transmission of fur.

(Before SHIPMAN, J., Connecticut, February 13th, 1882.)

SHIPMAN J. This is a bill in equity, originally in favor of Eliza Wells, as administratrix of the estate of Henry A. Wells, to restrain Elbridge Brown from the infringement, by the use of the "Gill machine," of re-issued letters patent of May 19th, 1868, No. 2,942, for "improvements in machinery for making hat bodies of fur," commonly known as the "hat-body patent." Since the commencement of the suit, the plaintiff and defendant have both died. The present plaintiffs are the administratrix and the administrator of the estate of Henry A. Wells. The defendant is the administrator of the estate of Elbridge Brown.

Under the decree, as directed to be modified, and the pleadings in the case, as directed to be amended, the hearing was confined to the question of the infringement by the defendant's intestate of the fifth and sixth claims of re-issue No. 2,942. I assume that the plaintiffs proved the user of the Gill machine by the defendant's intestate.

The state of the art relating to the manufacture of hat bodies of fur, the characteristics of the Wells invention, the original Wells patent and its re-issues, the first four claims of the last re-issue, the mode of construction of his machine,

and the general appearance and the different parts of the Gill machine are described either in *Burr v. Duryee*, (1 Wall., 531,) or in *Gill v. Wells*, (22 Wall., 1.)

The manufacture of hat bodies by the deposition of fur thrown from a picker upon an exhausted revolving cone was old at the date of the Wells invention. It is said in *Burr v. Duryee*, that "the aim and object of both Wells and Boyden was to construct an automatic machine which would distribute the fur on the cones so that the hat might be thicker in certain portions than on others. This was the defect of former machines, which each proposed to remedy. * * * The great and peculiar characteristic of the Wells invention is a tunnel or chamber, constructed as described. Instead of the picker, he used a rotating brush to distribute the fur from the feed aprons and throw it forward into the chamber which conducted it to the cones. The hinged hood and flap were devices to distribute the material in unequal quantities, to accomplish the object of making the hat thicker in one part than another." The chamber or tunnel is, as is said by the patentee in his original patent, "gradually changed in form towards the outlet, where it assumes a shape nearly corresponding to a vertical section passing through the axis of the cone, but narrower, for the purpose of concentrating and directing the fur thrown by the brush on to the cone." The cone is in front of the delivery aperture of the chamber.

The fifth and sixth claims of re-issue No. 2,942 are as follows: "5. The combination of the feed-apron, on which the fur fibres can be placed in separate batches, each in quantity sufficient to make one hat-body, the rotating brush or picker, substantially as described, the rotating pervious cone, provided with an exhausting mechanism, and the devices for guiding the fur fibres, substantially as described, the combination having the mode of operation specified, and for the purpose set forth. 6. In combination with the pervious cone, provided with an exhausting mechanism, substantially as described, the covering cloth wet with hot water, substantially as and for the purpose specified."

The fifth claim was for the combination of the feed-apron, rotating brush or picker, rotating pervious cone provided with an exhausting mechanism, and the trunk or tunnel with its hinged hood and flap, made substantially as described. It implies that the sides of the trunk are to be united at their edges, and that the trunk is a unit, and not a collection of separate devices; but the mere fact that the sides were taken apart would not defeat the charge of infringement. The engraving on page 11 of the 22d of Wallace shows the Gill machine, except that the deflectors, which, it is said, regulate the deposit of fur upon the band of the hat, are not shown. These deflectors consist of blocks of wood fastened to the interior wall of the Gill case near the bottom, the upper end of the blocks being inwardly and downwardly inclined, and forming, in the language of the plaintiffs' expert, "an annular deflector which surrounds the cone at a prescribed distance from its base."

In considering the question of infringement of the fifth claim, first, upon the theory that the different guiding devices of the Gill machine are the four sides of the Wells trunk, when taken apart, it cannot be denied that the various parts of the Gill mechanism perform the office of guiding the fur into the case to a point or points where it can be influenced by the exhaust mechanism, and that the deflectors of the Gill machine perform the office of concentrating the fur upon the different parts of the cone where it is desired that the thicker portions of the hat shall be formed; and it may, also, be conceded, that the extensible plate of the Gill machine, which receives the fur from the rotating brush, performs the office of the top plate of the Wells trunk, with its hood, and in substantially the same way.

The plaintiffs insist that the annular ledges near the bottom of the Gill case are the equivalent of the hinged flap upon the end of the bottom plate of the Wells machine. This similarity relates only to the end of the bottom plate. It is not claimed that the Gill machine has that portion of the

bottom plate of the Wells machine which is between the picker and the hinged flap.

It is next claimed that the side guides of the two machines are the same. The side pieces of the Wells trunk converge, as they approach the cone, both horizontally and vertically, and guide the fur in a direction towards the side of the cone; and it is admitted that this convergence may be essential in the form in which the Wells machine is organized, as shown in the patent; but it is claimed that the side guides of the Gill machine are connected with the top of the case, and that the case, with its converging walls, forms a continuation of these guides down to the annular deflector inside of the case; and that the "Gill case" is, in one respect, a "tunnel," which confines the fur-bearing current and prevents the lateral escape of the fur from the influence of the exhaust current, and, in that respect, performs, as to the vertical downward current of fur, the function which the side guides in the Wells machine perform as to the horizontal current of fur in that machine.

The decisions of the Supreme Court in regard to the Wells invention and re-issue restrict the invention, as secured by the patent, within narrow limits, as compared with those which were placed upon the patent at the earlier trials. Bearing in mind the limitations which were put upon the re-issue by the Supreme Court, and that the characteristic of the invention is the trunk, with its hood and flap, constructed substantially as shown in the drawings, I am of opinion that the attempt to make the side boards of the Gill trough and the walls of the Gill case to be substantially the same thing with the side pieces of the Wells trunk, cannot be successful. In view of these limitations, the aid of fancy is now required to convert the annular ledges upon the lower part of the Gill case into the hinged flap of the Wells trunk. This equivalence cannot be found except upon the view which is stated by the plaintiffs' expert to be the one which he entertains, and which is, that the end of the lower plate in the Wells machine "is present in any machine where there is a guide so related to the

cone and to the devices by which the fur-bearing currents are set in motion that it governs the quantity of fur supplied to the lower part of the side of the cone, and acts in conjunction with a non-fur-bearing current which is admitted to the perforations at the base of the cone."

Neither are the trough and the walls of the hopper and the ledges at the bottom of the wall, taken together, the equivalent of the trunk of the Wells patent. It is true, that each structure accomplishes the same result of conveying fur to the cone; so as to make a graduated hat body; but the two conduits are not constructed in the same way. The plan of operation in these two sets of devices is not the same. In the Wells machine, all the sides of the trunk co-operate with each other to confine the fur-bearing current, to guide it in a horizontal direction towards the vertical section of the cone, and to deliver it in a shape which conforms to that of such section. In the Gill machine, the bottom plate and the side guides guide the stream of fur to the upper part of a case or hopper of large dimensions, as compared with the cone, and then, the course of the fur being changed by the powerful exhaust current, it falls upon all sides of the cone which is placed at the bottom of the hopper. There is a guiding and directing operation by the plates and deflectors of each machine, but the Wells machine guides directly to the cone, while in the Gill machine the current of fur is conveyed in a trough, open at the top, to the upper part of a hopper, and, thence, restrained and deflected by the converging walls of the hopper, it is drawn to the cone by the exhaust. These differences are not merely formal, but make two radically different vehicles for the transmission of fur, and the reason for this dissimilarity of construction is because the respective methods by which the fur is driven to the cone are not alike. In each machine, the blast and exhaust currents co-operate. It is impossible for me to say, in view of the history of the litigation in regard to these two machines, that the blast current in the Gill machine does not aid the exhaust current in directing the fibres to the cone. But, I am of opinion, that, after

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the fur is blown into the hopper, the influence of the exhaust current, in directing the fur to the cone, is the predominant influence, and this difference in the mode of operation of the two machines compels a difference of construction.

Upon the question of the infringement of the sixth claim, there was naturally a disagreement between counsel upon the question whether the case was to be entirely retried. The counsel for the plaintiffs, supposing that the user, and the manner of user, of the wet cloth by the defendant's intestate had been sufficiently proved before Judge Woodruff, made no formal proof of the manner in which the bat was taken from the cone, but simply introduced expert testimony that such use was an infringement. I shall assume that the method of removing the bat from the cone which is described by Professor Trowbridge, the defendant's expert, on page 7 of the printed testimony, was the method pursued by the defendant's intestate. If so, there was infringement of the sixth claim. If the defendant asserts that this was not the method which was practiced, he will be at liberty, upon verified petition, to open the case and introduce proofs to that effect.

Let there be a decree for the plaintiffs, for an accounting in respect to the sixth claim.

E. N. Dickerson, for the plaintiffs.

John H. Perry and *Henry T. Blake*, for the defendant.

DAVID HOSTETTER AND GEORGE W. SMITH

v.

SAMUEL R. ADAMS AND OTHERS. IN EQUITY.

A label on a bottle upheld as a trade-mark, in connection with the size, color, shape and material of the bottle, and held to have been infringed.

The general effect to the eye of an ordinary person acquainted with the plaintiffs' bottle and label, and never having seen the defendants' label, and not expecting to see it, was, on seeing the defendants', to be misled into thinking it was what he had known as the plaintiffs'.

The differences which he would see on having his attention called to them were not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiffs' bottle and label and having no knowledge of another.

(Before BLATCHFORD, J., Southern District of New York, February 18th, 1882.)

BLATCHFORD, J. The bill alleges that the plaintiffs are, and for 27 years or more have been, partners, doing business as Hostetter & Smith, and during that time engaged in making and selling a medicine known as "Hostetter's Celebrated Stomach Bitters"; that they have the sole ownership of the good will, labels or trade-marks of said bitters; that said bitters have acquired a reputation as a safe and valuable medicine; that, in order to designate said bitters as of their own compounding, and as genuine, and to prevent fraud by having spurious bitters sold as and for the genuine, they from the beginning devised certain labels, tokens or trade-marks, and a certain manner of putting up said bitters, placing them upon the market in a style different from that in use by manufacturers or dealers in like articles, and that they have adhered to said style up to the present time; that said bitters are placed by them in square bottles, of uniform size, known as No. 6, containing about one and a-half pints, and having blown therein the name "Dr. J. Hostetter's Stomach Bitters," and upon

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these bottles they cause to be pasted labels or trade-marks, and the bottles then have revenue stamps put on them, and are packed in square boxes, each box containing a dozen bottles, and so boxed are sold to dealers; that the defendants are making and selling a spurious and inferior article of bitters, prepared in imitation of and intended to be sold as and for the genuine Hostetter's Celebrated Stomach Bitters of the plaintiffs' own manufacture, and calculated to deceive the public and consumers, and to enable the defendants to reap the profits of the reputation of the genuine bitters, and to injure the reputation and sale of them; that, with like intent, the defendants have printed a false label or trade-mark, in imitation of, and closely resembling, one of the plaintiffs' labels, said false label being well calculated to mislead and deceive customers and consumers of the genuine bitters; and that the defendants use the bottles of the plaintiffs, from which the genuine bitters have been used, and pack them in the same manner, in cases of the same shape, one dozen bottles in each case, in which manner they are sold. The bill prays for an injunction restraining the defendants from using said spurious label and for other proper relief. The case has been heard on pleadings and proofs.

The plaintiffs' bottle is of dark glass, and has a four-sided body, the sides being of equal size and the faces rectangular. On one side is an engraved label with a white body. This label is substantially as long and as wide as the face of the bottle. Near the top, in four lines, in black, are the words, "Hostetter's Celebrated Stomach Bitters," one word in each line. The third and fourth lines have letters of the same size and character, larger than the letters in the first and second lines. The letters in the first line are larger than those in the second line, and of a different character from them and from those in the third and fourth lines. The letters in the first line and those in the fourth line each of them form a curve, the convexity of which is upward. The second and the third lines are horizontal. The letters in the first, third and fourth lines are shaded. Underneath the fourth line is a horse without

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harness, vaulting in the air, towards the left, with his hind feet on the ground and his fore feet in the air, mounted on his bare-back by a naked man, with a helmet on, and a flying robe over his right arm, and in his two hands a spear with which he is striking at a dragon below him, on his left. The open mouth of the dragon is near the left knee of the rider and the point of the spear is just above that knee. The body of the dragon passes under the horse and his tail comes around the right hind leg of the horse and nearly reaches the body again. In a fore paw of the dragon near the end of his tail appears to be a piece broken off from the head of the spear. The horse has a flying mane and a sweeping tail. The horse, man and dragon are dark on a white ground. Below them is a shield commencing at a little below the middle of the length of the label. The shield has a dark ground. On it are letters printed in white. There are 16 lines of letters. Lines 1, 2, 4, 7, 8, 9, 10, 12, 13, 14 and 15 are the same size of type. The reading of the 16 lines, divided into lines, is this: 1 "The best evidence of the merit of an article is" 2 "the disposition to produce counterfeits" 3 "and we regard it as" 4 "the strongest testimony to the value of" 5 "Hostetter's" 6 "Celebrated Stomach Bitters" 7 "that attempts of that description have" 8 "been frequent. A due consideration of" 9 "the public welfare has induced us to" 10 "obtain a fine engraving of which" 11 "this is a fac simile" 12 "and to append our note of" 13 "hand which cannot be" 14 "counterfeited without" 15 "the perpetration" 16 "of a felony." The word "and" and the word "as" in line 3 are smaller than the other letters. The words "we regard it" in line 3, and also lines 5, 6, 11 and 16, are on a black ground, darker than the rest of the ground, and the letters are somewhat larger than the rest. All the letters in the shield are capitals. The line of the top of the shield consists of two curves of equal length starting from an apex in the middle of the width and concave upwards, and having a uniform sweep, and alike, and rising each to a point as high as the starting point, and each then falling off by a short concave upwards curve to a point. Then the two sides of the

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shield sweep around downward by equal curves to the centre of the width of the label and the lower point of the shield, completing the outline of the shield. The space on each side between the outer edge of the shield and a border around the label and a horizontal line running across at the lower point of the shield is filled in with engraved work, of waving irregular figures. Underneath the shield, in a parallelogram, is a promissory note for one cent, payable to bearer, on demand, signed "Hostetter & Smith." In the middle of the width of the upper part of the note is a small circle, having in it the head and bust of an aged man with a long white beard. There is a border around the whole label.

The defendants' bottle is of the same size, color, shape and material as the plaintiffs', and many of the defendants' bottles are old bottles of the plaintiffs' with the name "Hostetter" blown in the glass. The side which has that name on it is covered by the defendants' label. The defendants buy such old bottles when empty, which the plaintiffs have sold in the market with bitters in. On one side is an engraved label with a white body. This label is substantially as long and as wide as the face of the bottle, and is of the same size as the plaintiffs' label. Near the top, in four lines, in black, are the words "Clayton & Russell's Celebrated Stomach Bitters," one word in each line. The third and fourth lines have letters of the same size and character, larger than the letters in the first and second lines. The letters in the first line are larger than those in the second line, and of a different character from them and from those in the third and fourth lines. The letters in the first line and those in the fourth line each of them form a curve, the convexity of which is upward. The second and third lines are horizontal. The letters in the first, third and fourth lines are shaded. The appearance presented by those four lines as to the size and character and shading of the letters in the corresponding lines, and as to ornamentation in flourishes and dashes, is identical with the appearance presented by the corresponding four lines in the plaintiffs' label as to the same particulars, except the difference resulting from

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substituting the words "Clayton & Russell's" for the word "Hostetter's." Underneath the fourth line is a horse, with harness and caparison and saddle upon him, vaulting in the air, towards the right, with his hind feet on the ground and his fore feet in the air, mounted by a man with clothing on his trunk and feet, and a helmet with wings on his head, and in his right hand a spear with which he is striking at a scorpion on the ground in front of him. The horse has a sweeping tail. The horse, man and scorpion are dark on a white ground. They and the four lines above them occupy respectively the same space up and down as the corresponding parts in the plaintiffs' label. Below them, commencing at the same point as in the plaintiff's, is a shield, which has a dark ground, with letters printed on it in white. There are 15 lines. The lines are all the same size of type, and the size of type in line 1 in the plaintiffs'. The reading of the 15 lines, divided into lines, is this: 1 "The bitters of Clayton & Russell will be" 2 "found a highly aromatic liquid and en-" 3 "tirely free from injurious substances." 4 "One wineglassful taken three times" 5 "a day before meals will be a swift" 6 "and certain cure for dyspepsia a" 7 "mild and safe invigorant for delica-" 8 "te females a good tonic preparation" 9 "for ordinary family purposes, a" 10 "powerful recuperant after the" 11 "frame has been reduced by" 12 "sickness an excellent app-" 13 "etizer and an agreeable" 14 "and wholesome" 15 "stimulant." All the letters in the shield are capitals. The line of the top of the shield is made up of four curves and corresponds in all respects with the line of the top of the shield in the plaintiffs'. The shield is the same size and shape as the plaintiffs' and has a corresponding space on each side, filled in with engraved work, waving in character, though larger in detail than in the plaintiffs'. The lower point of the shield comes down to the same point as in the plaintiffs'. Underneath the shield, in a parallelogram, are the words: "Venders do not require a Liquor Dealer's License, being a Medicinal Compound." There is a border around the whole label, of about the same width as in the plaintiffs',

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though of a different character. There is a narrow space of white in the defendants' all around the lower parallelogram, and the side lines of white are carried up on each side to the top of the shield, and then continue down around the outer edges of the shield, differing in these respects from the plaintiffs'. The words beginning with "One wineglassful" to the end at "stimulant" are found in a label of gold letters printed on a bronzed ground, which is on another face of the plaintiffs' bottle.

It is shown that there are no such persons as Clayton & Russell; and that the defendants' label was prepared from the plaintiffs', by intentionally making the parts in it which are like corresponding parts in the plaintiffs' to be so like. It is plain that it is a copy from the plaintiffs' by design. Variations are made of such a character as to be capable of discernment and description. But the general effect to the eye of an ordinary person acquainted with the plaintiffs' bottle and label, and never having seen the defendants' label and not expecting to see it, must be, on seeing the defendants', to be misled into thinking it is what he has known as the plaintiffs'. The size, color and shape of the bottle, the four lines of letters at the top of the label being as to the three lower ones identical and as to the upper one differing only in the name, the general effect of the horse and his rider, the size and shape and color of the shield, the white letters in it and their size and arrangement in lines contracting in length towards the lower point of the shield, the whole in black on a white ground, and the border, give an affirmative resemblance calculated to deceive an ordinary observer and purchaser, having no cause to use more than ordinary caution, and make him believe he has before him something which he has before seen on the plaintiffs' bottle and expects to find on the bottle he is looking at. The differences which he would see on having his attention called to them are not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiffs' bottle and label and having no

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knowledge of another. The testimony to the above effect is of great strength.

The plaintiffs have no exclusive right to make the bitters. Their trade-mark is not in the words "Celebrated Stomach Bitters," nor have they any exclusive right to a bottle of the size, shape and color of the one which they use. But the entire style of their bottle and label, of which those words form a part, is, in connection with the other particulars above mentioned in which the defendants' bottle and label are like theirs, the mark of their trade. (*Williams v. Johnson*, 2 *Bosworth*, 1; *McLean v. Fleming*, 6 *Otto*, 245; *Frese v. Bachof*, 14 *Blatchf. C. C. R.*, 432; *Colman v. Crump*, 70 *N. Y.*, 573; *Morgan's Sons Co. v. Troxell*, 23 *Hun*, 632, and *Cox's Manual*, Case 674; *Sawyer v. Horn*, *Id.*, Case 667; *Mitchell v. Henry*, 15 *Ch. Div.*, 181.)

The evidence as to transactions after the filing of the bill is admissible. It comes in not to show infringement but to characterize the practical use of the subject-matter of the suit. The objection as to the recalling of witnesses is overruled.

The plaintiffs are entitled to an injunction and to a reference to a master to take an account of profits and to the costs of the suit.

A. H. Clarke, W. W. Goodrich and J. Watson, for the plaintiffs.

W. H. Arnoux and A. Dutcher, for the defendants.

Ives & Miller v. The Hartford Spring and Axle Co.

IVES & MILLER

vs.

THE HARTFORD SPRING AND AXLE COMPANY. IN EQUITY.

Re-issued letters patent, No. 8,179, granted May 20th, 1879, to Ives & Miller, as assignees of Welcome C. Tucker, for an improvement in wagon hubs, the original patent having been granted September 10th, 1867, and letters patent granted to Willis E. Miller, February 12th, 1878, for an improvement in carriage axles, are not infringed by carriage axles made under letters patent granted to Ellsworth D. Ives, June 10th, 1879, and November 2d, 1880.

Unless the general language of said re-issue is construed in accordance with the state of the art and with the limitations of the original patent in regard to the form of the flanges, the re-issue is broader than the invention, and includes devices different from those which were intended to be the subject of the original patent.

(Before SHIPMAN, J., Connecticut, February 18th, 1882.)

SHIPMAN, J. This is a bill in equity to restrain the defendant from the alleged infringement of re-issued letters patent, No. 8,179, issued May 20th, 1879, to the plaintiffs, as assignees of Welcome C. Tucker, for an improvement in wagon hubs, and also from the infringement of letters patent granted to Willis E. Miller, February 12th, 1878, for an improvement in carriage axles. The original Tucker patent was issued on September 10th, 1867. The defendant is manufacturing carriage axles under letters patent granted to Ellsworth D. Ives on June 10th, 1879, and on November 2d, 1880.

The invention of Tucker, as secured by his original patent, related to an improvement in wagon hubs made of iron or other suitable metal. It consisted, in the language of the specification, "in connecting the hub with the axle by cup flanges, and securing the hub on the axle with a cup-flanged nut, in such manner that the bearing of the axle shall be entirely closed at both ends, to retain the oil and exclude dust and dirt." The improvement also included "an arrangement of

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adjustable collars for securing the wheel to the hub by a firm attachment." The construction of the flanges upon the hub and axle is described with sufficient accuracy in the second claim of the re-issue, which is hereafter quoted. The claims were as follows: "1. The cup flanges *c c*, on the back and front ends of the wagon hub *B*, upon which are fitted the corresponding flanges *a* on the axle *A*, and *n* on the nut *d*, as herein shown and described. 2. In combination with the above I claim the stationary collar *m* and the adjustable collar *m'* on the hub *B*, combined and arranged as and for the purpose specified." The flanges and the collars were distinct improvements. It was feared that the language of the first claim limited the cup flanges to those on the hub *B*, and thus improperly limited the invention to a combination of flanges and collars. A re-issue was obtained, in which the claims were as follows: "1. The axle-arm, on which the wheel takes its bearing, with the shoulder at its inner end, and the flange projecting forward from the shoulder parallel with and concentric to the arm, all made as a part of the axle, combined with the box fitting said arm and constructed to enter beneath said flange, and with a concentric recess corresponding to and so as to inclose said flange at the shoulder of the axle-arm, substantially as described. 2. The combination of the box constructed with a cup-shaped flange at the outer and inner ends, the axle with a cup-shaped flange at the shoulder, and so as to be inclosed by the cup-shaped flange on the box, the nut constructed with a cup-shaped flange, the corresponding cup-shaped flange on the box, inclosing the flange of the nut, a stationary collar, *m*, and adjustable collar, *m'*, and so as to inclose the wood centre of the wheel, substantially as described." Infringement of the first claim only is alleged.

It will be perceived, that, in the claims of the re-issue, the word "box" is substituted for the word "hub" in the claims of the original patent. Axle-boxes are "bushings for hubs. Their duty is to take the wear incident to revolving on the spindle of the axle." (*Knight's Mechanical Dictionary*.) The original specification described an iron hub. The plaintiffs

now desire to avail themselves of the distinction between hub and box, and to claim that the Tucker invention consisted, in part, in a peculiar construction of box, as distinguished from the same construction in a wooden hub inclosing a straight iron tube or box. In my opinion, the re-issue does not make a box, as distinguished from a hub, a characteristic feature of the invention.

In the next place, the flanges at the outer end of the hub disappear from the first claim of the re-issue. It is said by the plaintiffs that the application of the flanges to both ends of the hub is a mere duplication of the invention, and that this mode of construction, while practicable when applied to a hub which had adjustable collars, could not be used in connection with the ordinary methods of fastening the wheel to the hub. I assume that this change does not introduce the device of new matter into the re-issue.

It will be perceived, from this statement, that the invention, as secured by the original patent, was a narrow one. An examination into the state of the art shows that the actual invention was also a very narrow one, and that, unless the general language of the re-issue is construed in accordance with the state of the art and with the limitations of the original patent in regard to the form of the flanges, the re-issue will be broader than the invention, and will include devices quite different from those which were intended to be the subject of the original patent.

Interfitting or intermeshing flanges and recesses upon an axle and hub were not only old, but the flanges and recesses of Tucker were old at the date of his invention. They are found in the patent to R. W. McClelland, of October 12th, 1858; but, in his axle, the wheel bears wholly upon the flanges at each end of the hub, whereas, in the Tucker axle, "the box fits the axle-arm throughout its entire length."

In the patent to John W. Crannell, of July 15th, 1862, the flanges and recesses are the same as in the Tucker patent. The differences in construction are that the recess, which in the Tucker device is at the end of the so-called "box," is, in

the Crannell axle, on the end of the wooden hub outside of the iron lining, and the flanged collar is not an integral part of the axle, but is secured to it. In the Tucker re-issue, the latter difference is pointed out in the clause, (referring to the arm, shoulder and flange,) "all made as a part of the axle."

The invention of Tucker, so far as it relates to the flanges, consisted in putting the cup-shaped recess of Crannell upon an iron hub or box, instead of upon a wooden hub, and in making the axle arm and its flange in one piece instead of in separate pieces. The character and extent of the invention is clearly shown in the following extract from the decision of the Acting Commissioner of Patents upon the plaintiffs' appeal from the Board of Examiners' rejection of the application for a re-issue. "Applicant's claims are as follows: *First*. The combination of the axle-arm on which the wheel takes its bearing, shoulder at the inner end of said arm, a flange projecting forward from the shoulder, parallel with and concentric to the axle, a box fitting said arm and extending beneath said flange at the shoulder, and a concentric recess in the box to receive said flange, formed by a concentric flange extending from the rear end of the box, over, and so as to inclose, said flange, at the shoulder of the axle-arm, substantially as described. * * * One of the references, the patent of John W. Crannell, of July 15th, 1862, for an improved axle, shows and describes a structure so nearly like applicant's in form and operation, as covered by his first and second claims, that the differences can be described by the mention alone of the superiority of applicant's device in the matter of mechanical construction. As the Board of Examiners-in-Chief in their decision remark, 'Crannell's' patent is much the closer anticipation, having the same configuration of flanges for the same precautionary purpose. Applicant's device is, however, mechanically superior as a whole, in that his hub, axle, shoulder and nut, with their entering flanges, are all made of similar material, admitting of machine fitting, and thus enabling the present application to dispense with the packing which Crannell, with his fitting of wood upon iron, is obliged to resort to. If these superior mechanical qualities constitute

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a patentable invention, it cannot receive protection by the present first and second claims, which do not rest upon those qualities, but cover a structure not only like Crannell's but which, in terms, also include the patent of McClelland, No. 21,766, of October 12th, 1858." The first claim of the re-issue was thereupon substituted for the rejected first claim, and the application was granted.

The plaintiffs' re-issue rests upon the superior mechanical method in which the patentee constructed Crannell's hub, axle and shoulder, with their flanges and recesses. It is limited to the cup-shaped flanges and recesses of the original patent, and cannot be enlarged to take in any shape of concentric flange on the shoulder, and a correspondingly shaped concentric recess in the hub, to inclose the flange, although the device has all the other requisites described in the first claim.

The defendant's device has a conical or concave recess in the shoulder or collar on the axle and a corresponding convex or conical projection on the box or hub. Its flanges and recesses are not cup-shaped. The Crannell intermeshing flanges contain four angles. The defendant's device contains but two, and is a simpler piece of mechanism.

The Miller patent is for an improvement on the Tucker axle. The claim is for "the combination of an axle-arm the collar of which is constructed with a flange projecting forward parallel with the axis, and a box constructed with a groove corresponding to said flange, and so as to extend over the said collar, with an annular recess between the said collar and the box, substantially as described." The defendant has a groove between the collar and the box. If the Miller claim is to be construed as the addition of the annular recess to the Tucker device there is no infringement. If the claim is for the device as broadly as it is described, the invention was anticipated by the McClelland axle.

Let the bill be dismissed.

John Kimberly Beach, for the plaintiffs.

William E. Simonds, for the defendant.

Robinson v. The New York Central and Hudson River Railroad Company.

THOMAS ROBINSON

v8.

THE NEW YORK CENTRAL AND HUDSON RIVER RAILROAD
COMPANY.

R., a passenger on a railroad car, was injured by the explosion of the boiler of the locomotive used to push the train, and sued the railroad company for negligence. At the trial he rested by proving the explosion. The employees of the defendant testified to due care in managing the boiler at the time of the explosion, that the boiler had recently been repaired and tested and found safe, and that the explosion resulted from a hidden flaw in the iron of the boiler, which could not be seen. The jury were instructed that they might infer negligence, upon the theory that the explosion would not have taken place unless the boiler had been in a defective condition, or unless there had been some omission or mismanagement on the part of those in charge of it at the time: *Held*, no error.

The jury were also instructed, that it was incumbent on the defendant, as a passenger carrier, to see to it, by every test recognized as necessary by experts, that the boiler was in a safe condition, but that it was not liable for a defect which could not be discovered by such tests: *Held*, no error.

As the testimony to rebut the presumption of negligence proceeded from persons who would be guilty of a criminal fault unless they vindicated themselves from such presumption, a question of credibility was presented for the jury, and they might disregard such testimony.

(Before WALLACE, J., Northern District of New York, February 18th, 1882.)

WALLACE, J. The plaintiff, while upon one of the defendant's cars, as a passenger, in June, 1878, was injured by the explosion of the boiler of the defendant's locomotive, which was being used to push the train out of the yard, and brought this action on the ground of negligence, to recover for his injuries. Upon the issue of negligence the plaintiff rested his case by proving the explosion. The defendant produced its employees, who testified to the exercise of due care in the management of the boiler at the time of the explosion, and who also testified that the boiler had been recently over-

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hauled, repaired and tested and found safe, and that the explosion resulted from a hidden flaw in the iron of the boiler, which could not be seen.

The jury were instructed, that they might infer negligence, upon the theory that the explosion would not have taken place unless the boiler had been in a defective condition, or unless there had been some omission or mismanagement on the part of those in charge of it at the time. They were also instructed, that it was incumbent upon the defendant, as a passenger carrier, to see to it by every test recognized as necessary by experts, that the boiler was in a safe condition, but that the defendant was not liable for a defect which could not be discovered by such tests.

The first instruction is not criticised. It is elementary, that, in actions for negligence, if the plaintiff proves he has been injured by an act of the defendant, of such a nature that, in similar cases, where due care has been taken, no injury is known to ensue, he raises a presumption against the defendant which the latter must rebut.

The other instructions were strictly correct. The jury were not told that the defendant was required to adopt every test known to experts to ascertain the safe condition of the boiler. If this instruction had been given, according to some of the authorities, it would not have been erroneous. It has been frequently declared that the carrier of passengers contracts for their safety as far as human care and foresight can go, (*Stokes v. Saltonstall*, 13 *Peters*, 181; *Penn. Co. v. Roy*, 102 *U. S.*, 451,) and must adopt all the precautions which have been practically tested and are known to be of value, and employ all the skill which is possessed by men whose services it is practicable for the carrier to secure. (*Smith v. N. Y. & H. R. R. Co.*, 19 *N. Y.*, 127.) But the instruction was, that the defendant was not exculpated if the defect could have been discovered by the application of all tests recognized by experts as necessary. It surely would not express the true extent of the carrier's liability to say that the carrier is exonerated if the defect could not be discovered by the ap-

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plication of some of the tests which experts recognize as necessary. If there was any test recognized as necessary which was not applied, the carrier failed to comply with its obligation. Of course, it was not the suggestion of the instruction that it is the duty of the carrier to adopt all such speculative and theoretical precautions as might be thought necessary by experts; and the instructions are not impugned upon this ground. The precautions referred to were those recognized as necessary by men of practical experience in the testing of steam boilers.

The more doubtful question presented by the motion for a new trial is, whether the jury were justified in disregarding the evidence given by the defendant to overthrow the presumption established by the fact of the explosion. It is, doubtless, the general rule, that, where unimpeached witnesses testify distinctly and positively to facts which are uncontradicted, their testimony suffices to overcome a mere presumption. But when, as here, the testimony proceeds from persons who would be guilty of a criminal fault unless they vindicated themselves from the presumption arising from the transaction, a question of credibility is presented for the jury. (*Elwood v. The Western Union Tel. Co.*, 45 N. Y., 549.) The Court might not feel concluded by this consideration on a motion for a new trial, but it would not feel at liberty to set aside the verdict unless so clearly convinced that the witnesses were entitled to full credit, as to be satisfied that the jury were controlled by their prejudices rather than by their impartial judgment. This is not such a case. Although the witnesses who tested the boiler claimed to have made an adequate and thorough test, when it appeared that this consisted simply in firing up the engine, when the repairs on the boiler were made, until the gauge indicated the steam pressure attained in ordinary use, a fair inference arose adverse to the theory of a very careful experiment.

The motion for a new trial is denied.

Amasa J. Parker and *Edwin Countryman*, for the plaintiff.

Matthew Hale, for the defendant.

The Albany City National Bank v. Maher.

THE ALBANY CITY NATIONAL BANK

vs.

WILLIAM J. MAHER, RECEIVER OF TAXES OF THE CITY OF
ALBANY. IN EQUITY.

The Act of the Legislature of New York, (*Chap. 271, Laws of 1881, p. 382,*) purporting to validate certain assessments on shareholders in National and State banks in the city of Albany, is void, because it denies the shareholders a right to be heard, and makes a legislative assessment of a tax upon them without apportionment or equality, as between them and the general class out of which they are selected, or as between themselves.

No tender of any sum for a tax is necessary in the case of a void assessment.

The shareholders having a right to sue the bank if it pays the tax or withholds their dividends, the bank can sue to enjoin the collection of the tax.

(Before WALLACE, J., Northern District of New York, February 18th, 1882.)

WALLACE, J. It was decided upon the motion for a preliminary injunction herein, (19 *Blatchf. C. C. R.*, 175,) that the assessment against the shareholders of the complainant was void because the assessors did not comply with the provisions of the statute intended to afford taxpayers an opportunity for the examination and correction of their assessments, which were a condition precedent to the legality of the assessments. Since that decision an Act of the Legislature has been passed designed to cure the invalidity of the assessment and that Act is now relied upon as a defence to the action. (*Chap. 271, Laws of 1881, p. 382.*) That Act declares, that the amounts of all assessments attempted to be levied, and taxes imposed, upon the shareholders in National and State Banks in the city of Albany, during the year 1880, as the same now appear of record in the assessment roll of the sixth ward in said city, and now in the hands of the receiver of taxes therein, are hereby assessed and levied upon such shareholders whose names now appear in said assessment

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roll as assessed upon their bank shares. It further declares, that the time limited for any party aggrieved to procure a writ of *certiorari* to review such assessment upon the ground that it is unequal, in that the assessment has been made at a higher proportionate valuation than other property on the same roll by the same officers, and that the petitioner is or will be injured by such alleged unequal assessment, pursuant to chapter 269 of the Laws of 1880, shall not be deemed to have expired until fifteen days after the Act becomes a law.

With great reluctance this Act must be declared in excess of the legislative power. The almost unlimited power of the Legislature over taxation has always been acknowledged by the Courts, but this Act is an unprecedented exercise of that power. It will not be contended that the Legislature can sanction retroactively such proceedings in the assessment of a tax as it could not have sanctioned in advance. This assessment was void because the persons subjected to it were deprived of notice and thereby lost the opportunity to be relieved, in whole or in part from the payment of the tax. The curative Act perpetuates the vice which was originally fatal to the assessment. It denies to the shareholders the right to be heard. It does indeed permit a review by *certiorari*, but the shareholders are limited to a review upon the single ground that the assessment is at a higher proportionate valuation than other property on the same roll by the same officers. They are not allowed to challenge the assessment upon the ground of overvaluation generally, or to show that they should have been allowed deductions which the laws of the State allow to other taxpayers, or to show that they were not in fact the owners of the property for which they were assessed. It is, in effect, a legislative assessment of a tax upon a body of individuals selected out of a general class, without apportionment or equality as between them and the general class, or as between themselves, and without giving them any opportunity to be heard. The Legislature cannot impose the whole burden of the State, or of a single taxing district, upon a portion of the property owners of the district.

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“It is of the very essence of taxation that it be levied with equality and uniformity and, to this end, that there should be some system of apportionment.” (*Cooley's Const. Limitations*, 495.) This assessment derives no support from the fact that the tax was originally levied upon all other property holders by a system of apportionment which secured uniformity and equality, because these shareholders were excluded from the benefits of that system and are still excluded. They are singled out and each assessed an arbitrary sum, upon the assumption that each is taxable for a given amount of property and that such sum represents his share of the common burden, while they are denied the right given to all others, of obtaining the deductions and corrections allowed by the general system of assessment. As is said in *Stuart v. Palmer*, (74 N. Y., 183,) “it matters not, upon the question of the constitutionality of such a law, that the assessment has in fact been fairly apportioned. The constitutional validity of the law is to be tested, not by what has been done under it, but by what may, by its authority, be done.” (*Earl, J.*, p. 188.) It may be that the tax assessed against the shareholders of complainant is no more onerous than they were required to bear, but this fact does not affect the question of legislative power and cannot give validity to the Act.

Entertaining these views, it is unnecessary to discuss the other objections which have been urged to the original assessment and to the invalidity of the curative Act.

As the original assessment was void and has not been validated, there was no necessity for a tender, on the part of the shareholders, of such sum as might be equitably due on account of their taxes. The cases in which a tender has been required were those where there was an excessive, as distinguished from a void, assessment. (*National Bank v. Kimball*, 103 U. S., 732; *Cummings v. Natl. Bank*, 101 U. S., 153.)

It is urged as a reason for denying the relief claimed, that the proofs fail to show that the shareholders of complainant have any intention to institute suits against the complainant

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if it pays the tax or withholds their dividends. It suffices, however, that they have the right to sue the bank. The complainant is placed in a position where it is subjected to the contingency of a multiplicity of suits by the several shareholders, on the one hand, if it recognizes the validity of the tax and withholds the dividends, and by the city authorities, on the other hand, if it refuses to do so.

A decree is ordered restraining the defendant from all proceedings to enforce the tax as against the complainant.

Amasa J. Parker, for the plaintiff.

Rufus W. Peckham, for the defendant.

JOHN B. MCCALL vs. THE TOWN OF HANCOCK.

The plaintiff purchased coupons from municipal bonds, at the suggestion of those who formerly owned them, with a view to collecting them in this Court, when it was supposed a recovery could not be obtained upon them in the State Courts. The former owners guaranteed the collection of the coupons. The plaintiff was protected from costs if he was defeated, and he was not to pay for the coupons until two years and a half after the time of the purchase: *Held*, that he could maintain a suit against the town on the coupons, being the owner of them, and that his intent in acquiring them was immaterial.

This Court held, in *Foots v. Town of Hancock*, (15 Blatchf. C. C. R., 343,) that a *bona fide* holder of coupons from bonds issued by the town of Hancock could recover on them notwithstanding the irregularities which took place in the issuing of the bonds. Afterwards, the Court of Appeals of New York, in *Cagwin v. Town of Hancock*, (84 N. Y., 532,) decided to the contrary: *Held*, that that decision of the State Court not having been made at the time the bonds were issued, and before the rights of purchasers had arisen, this Court was not bound to follow it.

The case of *Town of Venice v. Murdock*, (92 U. S., 494,) is controlling upon this Court in reference to the bonds of the town of Hancock, those bonds hav-

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ing been issued under a statute which authorized the commissioners of the town to issue the bonds only on the assent of a majority of the taxables, and which declared that the fact that such majority had been obtained should be "proved" by the affidavit of one of the assessors of the town.

The plaintiff is entitled to judgment although he failed to show that the requisite number of taxables had assented to the issuing of the bonds.

(Before WALLACE, J., Northern District of New York, February 18th, 1882.)

WALLACE, J. The evidence shows, what so frequently appears in actions upon coupons and municipal bonds, that the plaintiff purchased the coupons at the suggestion of those who formerly owned them, with a view to collecting them in this Court, when it was supposed a recovery could not be obtained upon them in the State Courts. By the terms of the purchase, the former owners guaranty the collection of the coupons. The plaintiff is protected from costs if he is defeated, and it may be conjectured, from the fact that he is not to pay for the coupons until two years and a half after the time of purchase, that it was intended by the parties he should not pay for them at all, if, in the meantime, the suit which he should bring should be decided adversely to him. Nevertheless, under the repeated decisions of this Court, as the plaintiff is the owner of the coupons, he can maintain this action, and his intent in acquiring them is immaterial. (*McDonald v. Smalley*, 1 *Peters*, 620; *Barney v. Baltimore City*, 6 *Wall.*, 280; *Osborne v. Brooklyn City R. R. Co.*, 5 *Blatchf. C. C. R.*, 366.) He is the real party in interest and that suffices. (*Allen v. Brown*, 44 *N. Y.*, 228.)

It has heretofore been held by this Court, that a *bona fide* holder of these coupons is entitled to recover thereon notwithstanding the irregularities which took place in the issuing of the bonds. (*Foote v. Town of Hancock*, 15 *Blatchf. C. C. R.*, 343.) Since that decision the Court of Appeals has decided to the contrary, (*Cagwin v. Town of Hancock*, 84 *N. Y.*, 532,) and it is now insisted that this Court should yield to that decision and follow it, as the construction of a State statute by the highest Court of the State. If that decision had been pronounced at the time the bonds were issued from

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which these coupons were cut, and before the rights of purchasers had arisen, the duty of this Court would be plain. It would follow the decision, although not convinced by the reasoning upon which it was predicated. But research of counsel has failed to find a case in which the Supreme Court has adjudged municipal bonds issued under a State statute to be invalid in the hands of *bona fide* holders, simply because the highest Court of the State has so determined after the rights of such holders had intervened. Sometimes that tribunal has placed itself upon the ground that such questions relate to commercial securities and belong to the domain of general jurisprudence, in which the Court will follow its own convictions, as in *Township of Pine Grove v. Talcott*, (19 Wall., 666,) and *Town of Venice v. Murdock*, (92 U. S., 494,) and in other cases on the ground that prior adjudications of the State Courts upon similar statutes were in conflict with the later decisions.

Whether these adjudications are a departure from the doctrine established by the earlier decisions of that Court, of which *Green v. Lessee of Neal*, (6 Peters, 291,) is an illustration, is not for this Court to inquire, because its duty is plain, to conform its judgments to the views of its superior tribunal, as they are now entertained by that body. It has, indeed, been repeatedly said by the Supreme Court, in actions upon such bonds, that, where there has been a fixed and settled construction by the State Courts, it would be unseemly to depart from that construction; but this was said in cases where such construction had been settled before the bonds were issued. (See *Township of Elmwood v. Marcy*, 92 U. S., 289.) On the other hand, as in *Fairfield v. County of Gallatin*, (100 U. S., 47,) the Court has not hesitated to reverse its own rulings adverse to the validity of such bonds, in order to follow later decisions of the State Court sustaining their validity.

The case of *Town of Venice v. Murdock*, (92 U. S., 494,) must be accepted as controlling upon this Court in the disposition of the present case, both because it is one of the most recent expositions of the views of the Supreme Court upon

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the general questions involved, and because it is a precedent directly in point. There, the validity of the bonds, issued under a statute of this State very similar to the statute under which the bonds in suit were issued, was the question under consideration. That statute authorized the supervisor of the town and the railroad commissioners to borrow money and execute bonds for the town, in aid of a railroad company. It provided, however, that they should have no power to do so until the written assent of two-thirds of the taxables of the town should have been obtained and filed in the clerk's office of the county, together with the affidavit of such supervisor or commissioners, or any two of them, to the effect, that the persons assenting comprised two-thirds of the taxables. Assents were filed, together with the requisite affidavits, and the bonds were issued, but it was not shown, upon the trial, that two-thirds of the taxables had, in fact, assented. Notwithstanding the decision of the Court of Appeals of this State, that, under this statute, the *onus* was on the bondholder to show, in a suit against the town, that two-thirds of the taxables had assented, (*Starin v. Town of Genoa*, 23 N. Y., 439,) and notwithstanding the decision of the same Court upon a very similar statute, in *Gould v. Town of Sterling*, (23 N. Y., 456,) the Supreme Court held that the Act constituted the supervisor and commissioners a tribunal to determine whether the requisite assents had been obtained, and that their decision, as evinced by making the affidavits and issuing the bonds, was conclusive in favor of a *bona fide* holder.

The bonds in the present case were issued under a statute which authorized commissioners appointed for the town to borrow money and execute bonds for the town in aid of the railroad company. The Act provides that the authority of the commissioners shall only be exercised upon the condition that the assent shall be obtained, of a majority of the taxables, and declares that the fact that such majority has been obtained shall be "proved" by the affidavit of one of the assessors of the town. The Act makes it the duty of the assessors to make such affidavit when the requisite assents shall have

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been obtained. If there is any material difference between this Act and the one considered in *Town of Venice v. Murdock*, it is that here the statute declares the fact of the consents having been obtained "proved" by the affidavit, while in the other such effect could only arise by implication—a difference which it might be supposed would materially fortify the position of the purchasers of the present bonds.

Since these bonds were issued the Court of Appeals has decided, (*Cagwin v. Town of Hancock, ubi supra*), notwithstanding the declaration of the Act that the fact that the requisite assents have been obtained shall be proved by the affidavit, that it is still incumbent on the purchaser to ascertain whether the fact thus proved is true or not. In *Town of Venice v. Murdock*, the Supreme Court held that he was not required to look behind the recital in the bond. This Court cannot follow the Court of Appeals without obviously ignoring the plain and conclusive adjudication of the Supreme Court upon the same question in *Town of Venice v. Murdock*.

It must, therefore, be determined that the plaintiff is entitled to judgment, although he failed to show that the requisite number of taxables had assented to the issuing of the bonds.

Edward B. Thomas, for the plaintiff.

William Gleason, for the defendant.

The United States v. Bartow.

THE UNITED STATES vs. ALEXANDER BARTOW.

Where a motion to quash an indictment is made after plea, and so much time has elapsed since the date of the alleged offence that it is too late to frame a new indictment, the motion must fail unless the indictment discloses defects that would be clearly fatal after verdict.

It is made an offence, by § 5,209 of the Revised Statutes, for a cashier of a national bank to make any false entry in any report or statement of the association, with intent to defraud the association, or to deceive any officer of the association or any agent appointed to examine the affairs of any such association; and an indictment under that section is bad which avers only an intent to deceive the Comptroller of the Currency.

An indictment under that section charged the making a false report of the condition of the bank, and had in it the words, "whereby, by means of a false entry therein by him made." It not being clear that that language would be held insufficient to support a conviction for making a false entry in the report, the question was left to be raised on a motion in arrest of judgment, and a motion to quash was denied.

(Before BENEDICT, J., Southern District of New York, February 18th, 1882.)

BENEDICT, J. This is a motion to quash an indictment framed under § 5,209 of the Revised Statutes, by which statute it is made an offence for any cashier of a national bank to make any false entry in any report or statement of the association, with intent to defraud the association, or to deceive any officer of the association or any agent appointed to examine the affairs of any such association.

The indictment is curiously framed, and, under other circumstances, I should have little hesitation in directing it to be quashed. But, the lapse of time since the date of the alleged offence is such that it is now too late to frame a new indictment. The defendant has long since pleaded to the indictment as it stands, and the motion to quash at this time was permitted only as a matter of favor, to enable the defendant to point out, if he could, defects that would necessarily be fatal on a motion in arrest of judgment. The present motion must, therefore, fail, unless the indictment discloses defects that would clearly be fatal after verdict. Such a defect plainly

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appears in the first, second and third counts, where the only intent charged is an intent to deceive John J. Knox, the Comptroller of the Currency. The intent made by the statute an ingredient of the offence is an intent to defraud the association, or to deceive any officer of the association or any agent appointed to examine the affairs of any such association. The Comptroller of the Currency is not an agent appointed to examine the affairs of a national banking association, within the meaning of this statute. The first, second and third counts of the indictment are, therefore, bad.

The other counts are differently framed in regard to the intent. They are alike in form, and the only objection taken to them is, that the substance of the charge in each is the making a false report of the condition of the bank, whereas the offence created by the statute consists in making a false entry in a report. Upon this ground it is contended that no offence is charged in either of these counts. But, while the wording of the indictment doubtless affords some ground for such a contention, it is not certain that the language employed would be held insufficient to support a conviction for making a false entry in the report. There are the words "whereby, by means of a false entry therein by him made." This language might be held to constitute an imperfect averment that the defendant made a false entry in the report described, and, therefore, sufficient to support a finding that the defendant made a false entry in the report, within the meaning of the statute. Any doubt existing upon such a question, when raised as in this case, should be left to be solved upon the motion in arrest of judgment.

The motion to quash is, therefore, denied.

William P. Fiero, (Assistant District Attorney,) for the United States.

Winchester Britton, for the defendant.

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A motion to quash an indictment, made after plea, cannot prevail unless the insufficiency of the indictment is so palpable that no judgment can be rendered after conviction.

A report of the condition of a national bank, made by its cashier to the Comptroller of the Currency, and verified by his oath, is a declaration, within § 5,392 of the Revised Statutes.

An indictment under that section charged the taking of a false oath to a report to the Comptroller of the Currency, but did not specifically aver that the report was made on the requirement of the Comptroller, or according to a form prescribed by him, but averred that the report was made to the Comptroller, "and verified as aforesaid, as by law required." It not being clear that such averment was not sufficient, after verdict, to warrant judgment on the conviction, a motion to quash the indictment was denied.

(Before BENEDIOT, J., Southern District of New York, February 18th, 1882.)

BENEDIOT, J. This case comes before the court upon a motion to quash made after plea. It cannot, therefore, prevail unless the insufficiency of the indictment is so palpable as to satisfy the mind that no judgment can be rendered in case of conviction.

The offence sought to be charged is the offence created by § 5,392 of the Revised Statutes. The act charged is the verification of a report of the condition of the National Bank of Fishkill, by the accused, as cashier of such association. The method of framing the indictment is far from satisfactory. Still I think it not impossible to consider the language employed sufficient, after verdict, to sustain a finding that the accused took an oath that a report of the condition of the National Bank of Fishkill subscribed by him is true, and wilfully and contrary to his oath stated, in such report, material matter which he did not believe to be true. Such a report is, in my judgment, a declaration, within the meaning of § 5,392.

The laws of the United States (§ 5,211 *Rev. Stat.*), require every National Bank to make to the Comptroller of the Currency not less than five reports during each year, according to

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the form which may be prescribed by him, verified by the oath or affirmation of the president or cashier of the association. In this indictment there is no specific averment that the report in question was made in pursuance of a request or requirement of the Comptroller, or according to a form prescribed by the Comptroller; nor is there any averment that the Comptroller ever requested a report from the National Bank of Fishkill. Because of this omission it is said that no offence is charged, inasmuch as the offence created by § 5,392 can only be committed in a case in which a law of the United States authorizes an oath to be administered. But, the act charged is the taking of the oath. The circumstances under which the oath was taken are introduced to show that the oath was authorized by law. Matter showing that the report which the accused verified by his oath was made in pursuance of a request from the Comptroller of the Currency, and in accordance with a form prescribed by him, would be, therefore, matter of inducement, and inducement does not, in general, require exact certainty. This indictment contains the averment that the report in question was "made to the Comptroller of the Currency and verified as aforesaid, as by law required." I am not prepared to say that authority cannot be found for holding such an averment in regard to such matter sufficient, after verdict, to warrant judgment on the conviction. (See *Rex v. Sainsbury*, 4 T. R., 451; *Regina v. Bidwell*, 1 Den. C. C., 222.)

The motion to quash is, accordingly, denied.

William P. Fiero, (*Assistant District Attorney*), for the United States.

Winchester Britton, for the defendant.

Jennings v. Kibbe.

ABRAHAM G. JENNINGS AND ANOTHER

vs.

HENRY R. KIBBE AND OTHERS. IN EQUITY.

In this suit, brought for the infringement of two letters patent for designs, one for a "lace purling" and the other for a "fringed lace fabric," the plaintiff introduced in evidence the patents and a "nubia" sold by the defendants, but examined no witness as to identity of design. The defendants introduced no testimony. In view of the decision in *Gorham Co. v. White*, (14 *Wallace*, 511,) and of the simple character of the designs of the patents, and of the absence of any testimony on the part of the defendants, the Court compared the nubia with the patents, as to design, and determined the question of identity from such comparison.

(Before BLATCHFORD, J., Southern District of New York, February 20th, 1882.)

BLATCHFORD, J. This suit is brought on two letters patent for designs. One is No. 10,388, granted to Abraham G. Jennings, for 14 years, on January 1st, 1878, for a "design for lace purling." The other is No. 10,448, granted to Warren P. Jennings, for 7 years, on February 12th, 1878, for a "design for a fringed lace fabric." The specification of No. 10,388 says: "Figure 1 represents a photographic illustration of my new lace purling. Fig. 2 is a photographic illustration of the same design, made of coarser thread. This invention relates to a new design for a lace fabric, and consists in providing the pillars thereof with more or less irregular laterally-projecting loops, thereby imparting to the entire fabric a puckered, wavy, purl-like appearance, which is indicated in the photograph. The loops on the pillars are placed close together, to increase the effect." The claim is this: "The design for a lace purling the pillars whereof are provided with irregular laterally-projecting loops, substantially as shown." The specification of No. 10,448 says: "The accompanying photograph illustrates a face view of my new design. This invention relates to a new looped fringe, applied in series to

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lace fabrics. A represents the lace fabric, of usual kind. B B are the disconnected fringes applied thereto. Each fringe, B, is formed with loops at both sides of a central stem or rib, along its entire extent, as shown, thus producing a peculiar full and yet loose effect. The fringes are arranged in series of rows, and suspended from the lace fabric." The claim is this: "The design for a lace fabric, provided with disconnected double looped fringes, B, having loops at both sides of a central stem or rib, substantially as shown."

The answer denies infringement and sets up various defences to both patents. In taking proofs for final hearing, the counsel for the defendants being present, the plaintiffs put in evidence the two patents, and assignments to the plaintiffs, and a "nubia." The counsel for the defendants admitted, on the record of proofs, that the said nubia was purchased from the defendants' firm prior to the commencement of this suit. The plaintiffs then rested their case. The defendants took no testimony. The plaintiffs bring the case now to final hearing on the foregoing evidence, without introducing any witness to show the identity of design between what is found in said nubia and in the plaintiffs' patents. The defendants contend that it is not sufficient for the plaintiffs to show merely the sale of the nubia by the defendants, and to leave the Court to inspect the nubia and compare it with the patents, but that the plaintiffs must produce a witness to testify to identity of design.

In *Gorham Co. v. White*, (14 *Wallace*, 511,) the Supreme Court considered directly the question of identity in regard to a patent for a design. It held that the true test of identity of design is sameness of appearance, in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert; and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. The Court compared, in that case, the design of the patent with the designs on the defendants' articles,

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and arrived at the conclusion, from such comparison, that the designs of the defendant were, in their effect as a whole, notwithstanding variances, substantially the same as the design of the patent, and infringements. In addition to this there was the testimony of witnesses on both sides on the question, and the Court was of opinion, also, that the testimony proved the infringements.

In view of the proper test of identity, as above given, and of the simple character of the designs in the present case, and of the absence of any testimony on the part of the defendants, I am of opinion that the absence of testimony as to identity does not make it improper for the Court, in this case, to compare the defendants' nubia with the patents, as to design, and determine the question of identity from such comparison. It is not intended to imply that the practice can be extended to any other patent than one for a design, or that it ought to be extended to all patents for designs.

On such comparison it is found that the defendants' nubia infringes both of the patents, and a decree in the usual form, in favor of the plaintiffs, with costs, will be entered.

A. V. Briesen, for the plaintiffs.

J. R. Bennett, for the defendants.

DAVID W. BRUCE

vs.

JOHN MARDER AND OTHERS. IN EQUITY.

Letters patent No. 189,865, granted to David W. Bruce, May 27th, 1878, for an improvement in printing types, are valid.

The invention defined, and held to be patentable.

The claim construed by the language of the specification.

(Before WHEELER, J., Southern District of New York, February 22d, 1882.)

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WHEELER, J. This suit is brought upon letters patent No. 139,365, dated May 27th, 1873, granted to the orator for an improvement in printing types. The improvement consists in having types for figures cast two-thirds the width of the body, which is the height of the type, and with correspondingly larger faces, whereby the type can be more readily set, because they can be justified, as printers say, by two of the ordinary three-in-em spaces, and because the print is much more legible. The defences are want of patentability of invention, and want of novelty. The claim in controversy, of the patent, is for: "Figures and fractions in printing type, cast upon a block equal to two-thirds the width of the body of the 'em' or standard type."

If this claim was to stand upon its own terms merely, it would cover only the size of the body of the type on which figures are cast, and not the size of the figures themselves, as cast upon the body, and the patent, as involved here, would have to be considered in that view. But the specification sets forth the old method of casting type for figures, and the indistinctness, on account of smallness of the figures, as one of the disadvantages of that method, and then proceeds: "To obviate this indistinctness, I construct the figures broader, by casting them two-thirds of the width of the body," &c., and refers to the accompanying drawings, which show large-faced figures contrasted with small ones, as a part of the improvement. The claim is to be read in connection with the specification, as if there was added to it the phrase—as specified, or as set forth. Read in that light the claim is for the broader figures, as well as for the broader body of the type.

The claim of lack of patentability rests upon the argument that there can be no invention in merely increasing the size of the types for figures or the width of the body of the type, and none in doing both. At first, it would seem that this argument was well founded, as to the scope of the patent, and sound. But a closer examination of the subject shows that the patent involves more than either of these things, or

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the combination of both. The invention is not merely of an increase of the size of type for figures. Figures in printing are to be used in the same body of type with letters, and the whole are to be justified, in the language of printers; in other words, spaced so as to fill out the lines. By the old method figures were cast on types one-half the width of the body of the line, whatever the size of the type might be; and an increase of the size of the figures made necessary an increase of the size of the whole. The orator invented a method of increasing the size of the figures without increasing the size of the type of the letters and the body of the line; and a method of conveniently justifying the types for figures, by making the width of the body of the type exactly two-thirds of the width of the body of the line, so that they could be justified by two of the ordinary three-in-em spaces, whatever the size of the type of the body of the line might be. This involved finding a new rule of proportion between the sizes of letters and the sizes of figures, and one that not only would give more legible figures, but such as would be more legible without increasing the size of the letters with which they should be printed, and such size of body of type on which to cast the figures that the type could be used conveniently, and economically of space. This required more than mere mechanical skill; it made necessary the creative genius of the inventor. The testimony of practical and largely experienced printers, taken in the case, shows that his method was not known before his invention, that it has been of great utility and gone largely into use since. This shows that he discovered and put to use what others skilled in the art had overlooked; that it was very desirable, when known, and would, very probably, have been found out before, if ordinary skill in that art could have discovered it. On the whole, the presumption of patentability arising from the grant of the patent is not only not overthrown but is well sustained.

The evidence as to prior knowledge and use establishes, fairly enough, that types for figures were cast with the body of the type two-thirds the width of the body of the line,

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before this invention ; and, if that was all of the invention, or if the claim was to be construed according to its own terms, without resort to the specification, so that no more would be patented, the want of real novelty might be made out. But, as before attempted to be shown, the invention involves the increase of the size of figures in proportion to the size of letters, in connection with this size of the body of the type, and the whole of that does not appear with the requisite clearness to have been known or used before.

Let there be a decree that the patent is valid, that the defendants infringe, and for an injunction and an account, according to the prayer of the bill, with costs.

Benjamin F. Lee, for the plaintiff.

H. F. Pultz, for the defendants.

FRANCIS MUNSON

vs.

THE MAYOR, &C., OF THE CITY OF NEW YORK. IN EQUITY.

An interlocutory decree for the plaintiff having been made in this suit, (18 *Blatchf. C. C. R.*, 237,) after a final hearing on proofs, application was now made, on affidavits, to open the decree and admit a new defence of public use of the patented article, purchased from the inventor, for more than two years prior to the application for the patent. But the witness to the use had made conflicting affidavits, and the identical article used was not produced, and the inventor testified that the article purchased from him was not the completed invention. For these reasons the application was denied.

(Before WHEELER, J., Southern District of New York, February 22d, 1882.)

WHEELER, J. This cause has now been heard upon the motion of the defendant to re-open the interlocutory decree for an injunction and account, heretofore made therein, (18

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Blatchf. C. C. R., 237,) and to admit a new defence of public use of the patented bond and coupon registers in controversy, by the Chicago, Burlington and Quincy Railroad Company, for the period of more than two years prior to the application for a patent, which were purchased of the patentee himself. The application is founded upon an affidavit of Amos T. Hall, in which he testifies to such prior use while he was treasurer of that corporation, and affidavits of counsel showing due diligence in discovering this defence. This defence would be meritorious if it could have been seasonably interposed and clearly made out, according to the requirements of the law for defeating a patent. This affidavit, as made, having full effect given to all its statements, would make out such defence. But, since making this affidavit, the same witness has made another, at the request of the plaintiff, so modifying the former as to make it doubtful, upon his own statements taken altogether, whether it was in fact the patented register which he used for that corporation during that time. All the registers which he did use were consumed by the Chicago fire, so that proof of what they actually were would necessarily depend wholly upon oral testimony. In addition to this, the plaintiff makes affidavit that what was used was not the patented invention as perfected, but was a different register, which he made before completing the invention patented. This would make this defence altogether too doubtful in fact to defeat the patent, if it was all in, upon this proof, for consideration, upon hearing in chief; and would fall far short of warranting re-opening the case, if all other requisites for that course were complied with. It is argued for the defendant, however, that the case should, in justice, be opened, to give opportunity to investigate this defence and procure other witnesses if to be found, and to subject these to examination and cross-examination, to develop the facts pertaining to it more fully. This would be very proper in preparing for a hearing in chief while the case was open for that purpose. That time, however, has passed. It is for the interest of all that litigation should in due course cease, and

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that experiments in making proofs should cease. After parties have had a full opportunity to ascertain, take and present all their proofs, and they have been taken, presented, considered, and their weight determined, there is no just ground for opening the case to afford opportunity to explore for further proofs. In applications for a new trial on newly discovered evidence, the evidence offered should, of itself, be such as to make it probable that its introduction would change the result. The authorities are full to this extent, at least.

The motion must be denied.

Royal S. Crane, for the plaintiff.

Frederic H. Betts, for the defendant.

MARY J. SMITH

vs.

THE STANDARD LAUNDRY MACHINERY COMPANY AND OTHERS.
IN EQUITY.

S. granted an exclusive license, in writing, to a company, to make and sell a patented article during the term of a patent, returns of sales to be made monthly, and license fees paid monthly, S. to have a right to terminate the license by a written notice to the company, on the failure to make returns and payments for 3 consecutive months. S. duly served notice of the termination of the license, but the company continued to use the patented invention, and S. brought this suit for infringement. The parties were citizens of the same State. In A.'s answer, the company alleged that the contract was not lawfully terminated, and, also, that it had not sold any of the patented articles, and was not making and selling them: *Held*, that this Court had jurisdiction of the suit.

The case distinguished from *Wilson v. Sandford*, (10 How., 99,) and *Hartell v. Tilghman*, (99 U. S., 547.)

(Before WHEELER, J., Southern District of New York, February 22d, 1882.)

Smith v. The Standard Laundry Machinery Company.

WHEELER, J. There are two of these cases, brought upon numerous patents described in the respective bills of complaint, and they have been heard together upon the bills, answers, replications, and plaintiff's proofs. The plaintiff, by written agreement, dated July 1st, 1874, granted an exclusive license to the Standard Laundry Machinery Company, alone and singly, to manufacture and sell laundry machinery embodying the improvements patented, to the end of the terms of the patents, the company to make return to the plaintiff of all sales made during each month, on the first of the following month, and to pay, as a license fee, on or before the tenth of the following month, a sum equal to eight *per cent.* of the gross sales of power machinery, and four *per cent.* of the gross sales of hand machinery, so sold. There was a clause in the agreement providing that the plaintiff might terminate the license by serving a written notice upon the company, on failure to make the returns and payments for three consecutive months. May 13th, 1879, the plaintiff served notice of termination of the license. The defendants continued to use the patented inventions, and the plaintiff brought these suits for infringements after the notice. The parties are citizens of the same State, so that this Court has no jurisdiction except under the patent laws. The defendants insist that those laws give no jurisdiction to decide upon the construction or continuance of the agreement for a license, and that the question of infringement depends wholly upon the agreement, and rest the case here wholly upon this question of jurisdiction. The contract of license itself provides a mode for its own termination; and the plaintiff's case shows that it was terminated in that mode. The defendants do not rest their cases upon the question whether the contract was terminated or not, but, while they insist that it was not lawfully terminated, answer, "that they have not sold any machines embodying the invention for which the complainant has obtained letters patent, as alleged in the complaint, and that defendants are not now manufacturing and selling the said machines." This raises a question of infringement, arising solely under the patent laws

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of the United States, of which the United States Courts alone have jurisdiction, without reference to citizenship. The decision of the question of the termination of the license might obviate this question of infringement, and it might not; or, rather, it might furnish a mode of determining whether there was any infringement, and it might leave that question to be determined otherwise. If the license was not ended, the acts charged, if done, would not constitute an infringement; if ended, the question would remain, whether the acts were done. The question of infringement would always be in the case, until decision. This is different from *Wilson v. Sandford*, (10 How., 99,) and *Hartell v. Tilghman*, (99 U. S., 547,) relied upon by defendants. In each of those cases, as treated by the Court, there was but one question made between the parties to be decided at all, and that was a question of contract. Neither of those cases seems to control this, and this does seem to involve a controversy of which this Court has jurisdiction.

Let there be a decree for an injunction and an account, according to the prayer of the bill, with costs.

H. G. Atwater, for the plaintiff.

J. Palmer, for the defendants.

CHARLES GODFREY GUNTHER

vs.

THE LIVERPOOL AND LONDON AND GLOBE INSURANCE COMPANY.

A policy of fire insurance on a hotel, owned by the plaintiff, provided that it should be void if the premises should be used so as to increase the risk, within the control of the assured, without the assent of the insurer, or if the assured should keep gasoline or benzine without written permission in the pol-

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icy, and that neither benzine nor gasoline should be stored, used, kept or allowed on the premises, temporarily or permanently, for sale or otherwise, unless with written permission endorsed on the policy, "excepting the use of refined coal, kerosene or other carbon oil, for lights, if the same is drawn and the lamps filled by daylight;" otherwise, the policy to be void. There was written in the policy: "Privilege to use gasoline gas, gasometer, blower and generator being underground, about 60 feet from main building, in vault, no heat employed in process;" and "privilege to keep not exceeding 5 barrels kerosene oil on said premises." There was an oil room in the basement of the hotel, in which materials for lighting were kept. The hotel was run by the wife of W., W. being her agent in its management. It was destroyed by a fire which took in the oil room between sundown and dark, from a light carried in there by servants, by direction of W., for the purpose of drawing oil sent for from a neighboring hotel. The answer set up, as defences, that the conditions of the policy were broken, by keeping or allowing benzine on the premises, and thereby increasing the risk, without consent or permission, but did not otherwise set out any breach by drawing oil after daylight, or by other light. On the trial the defendant gave evidence to show that W. had procured benzine and put it in the oil room for use in lighting the premises, and that this was the same as gasoline, and was what was sent for from the other hotel, and was being drawn and took fire from the light, and caused the loss, and that its presence increased the risk. The evidence also went to show that W. procured the benzine to use at a picnic and not for the purposes of the hotel. The plaintiff gave evidence to show that no benzine was brought there, and that, if there was, it was without the authority or knowledge of the plaintiff, and that kerosene was what was being drawn when the fire took. There was evidence that, in the use of gasoline gas, in apparatus such as is described in the permission, it is usual to store gasoline in the generator. The Court charged the jury that, if the benzine was there and was procured and placed there by W. in the course of his business of managing the hotel for his wife, to whom the plaintiff had committed the use of the premises, and storing it in the oil room would not be within what would be understood and expected to be done in the exercise of the privilege granted to use gasoline, the plaintiff could not recover; but that, if the benzine was not there, or was placed there by W. without the plaintiff's knowledge, for some outside purpose, not connected with the management of the hotel, nor within his authority as agent of his wife for that purpose, or if it was to be understood and expected, from the permission, that the gasoline or benzine might be stored in the oil room, in the usual place for storing such things, and it was so stored there, the plaintiff could recover: *Held*, no error.

The defendant requested the Court to direct a verdict for the defendant on the ground that drawing the oil after daylight was gone, by artificial light, avoided the policy, and to charge the jury that the plaintiff was not entitled to recover if benzine was there and increased the risk. The Court refused to comply with such requests: *Held*, no error.

(Before WHEELER, J., Eastern District of New York, February 23d, 1882.)

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WHEELER, J. This action is brought upon two policies of insurance covering the plaintiff's hotel, stable and bathing houses. The policies contained clauses providing that, if the premises should "be occupied or used so as to increase the risk, by any means whatever within the control of the assured, without the assent" of the company, or, if the assured should "keep * * * gasoline, benzine * * * without written permission in the policies," then, in every such case, the policies should be void, and that * * benzine * * gasoline * * were "not to be stored, used, kept or allowed on the above premises, temporarily or permanently, for sale or otherwise, unless with written permission endorsed on this policy, excepting the use of refined coal, kerosene or other carbon oil, for lights, if the same is drawn and the lamps filled by daylight; otherwise, this policy shall be null and void." There was written in the policy: "Privilege to use gasoline gas, gasometer, blower and generator being underground, about 60 feet from main building, in vault, no heat employed in process;" and "privilege to keep not exceeding 5 barrels kerosene oil on said premises." Gasoline gas apparatus, as described in the permission, was in use when that permission was given, and that use was wholly discontinued, and the permission to keep kerosene oil was given. There was an oil room in the basement of the hotel, in which materials for lighting were kept. The hotel was run by a Mrs. Walker, and Mr. Walker, her husband, was her agent in its management. The property insured was destroyed by fire, which took in the oil room, between sundown and dark, from a light carried in there by servants, by direction of Walker, for the purpose of drawing oil, sent for from a neighboring hotel.

The answer set out the conditions in the policy mentioned, and averred, as defences, that these conditions were broken, by keeping or allowing benzine on the premises, and thereby increasing the risk, without consent or permission, among other things, but did not otherwise set out any breach by drawing oil after daylight, or by other light.

On the trial, the evidence of the defendant tended to

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show, that the day before the fire a half barrel of benzine was procured by Walker to be brought and put into the oil room, for use in lighting the premises, and that this was the same as gasoline, and was what was sent for from the other hotel, and was being drawn and took fire from the light, and caused the loss; and that its presence greatly increased the risk. The evidence also tended to show that Walker procured the benzine for use at a picnic in an adjoining grove the next day, and not for the purposes of the hotel. The plaintiff's evidence tended to show that no benzine was brought there at all, and that, if there was, it was without the authority or knowledge of the plaintiff; and that kerosene was what was being drawn when the fire took. A witness for the defendant stated that, in the use of gasoline gas, in apparatus such as is described in the permission, it is usual to store the gasoline in the gasometer, probably intending to say generator; and this was the only evidence upon the subject, other than that arising from the nature and necessities of the use.

The defendant requested the Court to direct a verdict for the defendant, on the ground that drawing the oil after daylight was gone, by artificial light, avoided the policy; and to charge the jury that the plaintiff was not entitled to recover if benzine was there and increased the risk. The Court, not complying with these requests, charged the jury that, if the benzine was there, and was procured and placed there by Walker in the course of his business of managing the hotel for his wife, to whom the plaintiff had committed the use of the premises, and storing it there in the oil room would not be within what would be understood and expected to be done, in the exercise of the privilege to use gasoline granted, the plaintiff would not be entitled to recover; but that, if the benzine was not there, or was placed there by Walker without the plaintiff's knowledge, for some outside purpose, not connected with the management of the hotel, nor within his authority as agent of his wife for that purpose, or if it was to be understood and expected, from the permission that the gasoline or benzine might be stored in the oil room, in the

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usual place for storing such things, and it was so stored there, the plaintiff would be entitled to recover. The defendant excepted to each of these rulings, and, after verdict, and before judgment, moved for a new trial on account of them, and the cause has now been heard upon this motion.

Defences on account of breaches of conditions in such policies should, according to the general principles of pleading at law, be specially pleaded and set forth. (*Wood on Fire Ins.*, secs. 194, 495.) This was the rule at common law, as to conditions of penal bonds. And this mode of pleading seems to be especially requisite in proceedings under the Code, such as those in this case are. It is said, in argument, that the general allegation that the conditions were broken, in connection with the setting forth of the conditions, was a sufficient compliance with the requirement; and that the introduction of the evidence without objection was a sufficient waiver of it. The first of these propositions would seem to be more sound if the pleader had stopped when he had set out the conditions and stated generally their breach; but he did not do this. After stating the conditions and that they were broken, he went on and specified the particulars in which they were broken, leaving out drawing oil by other than daylight. This would be misleading if that breach was to be relied upon. As it was, the Court got no idea at all that such breach was to be relied upon until the request to direct a verdict on account of it was made. The evidence in respect to it did go in without objection, and, had there been no other ground for its admission, that fact would be deemed a waiver of any more full pleading on this ground; but there were other grounds. The plaintiff was required to prove the loss, and this involved proving the circumstances of the fire; and the proof on this subject went in as a part of those circumstances. There was no opportunity for the plaintiff to object on the ground that it was proving this defence not pleaded, and the failure to object on that ground could be no waiver of it.

The request to charge as to increase of risk by the presence of benzine became immaterial in view of the charge upon

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other points; or, rather, if the charge was correct otherwise, it was more favorable than the request on this subject. The charge, as given, made the mere presence of the benzine a defence, unless it was there within the permission, or by the act of a *quasi* trespasser. A charge according to this request would only have made its presence, if it increased the risk, a defence with the same qualifications. This part of the charge, where it differs from this request, could have done no wrong to the defendant.

As the jury were, by the charge, left to find a verdict for the plaintiff if they should find either that Walker put the benzine into the oil room on his own account outside of the carrying on of the hotel, or that having it there was within the permission, the verdict rests upon the soundness of both of these propositions.

The act of Walker would not avoid the policy unless it can be said to have been in some way done under or by authority from the plaintiff; and then only unless it was such an act as, if done by the plaintiff, would avoid the policy. Mere imprudence or negligence of either would not have that effect. (*Wood on Fire Ins.*, sec. 101.) So, the mere having the benzine there and drawing it by artificial light, without a prohibitory clause in the policy, would not, unless done with such recklessness as to show an intent to destroy or to wilfully expose to destruction, of which there was no evidence. (*Chandler v. Worcester Ins. Co.*, 3 *Cush.*, 328.) They would not, unless these things would avoid the policy, because, by its terms, it was agreed that they should avoid it. The conditions relied upon commence by providing, that, if the risk should be increased by any means within the control of the assured, and continue by providing that, if the assured shall keep so and so, the policy shall be void, showing that the acts stipulated against are the acts of the assured. In the last clause, those words are not inserted, but, as the language is that of the company, and in these cases is to be taken most strongly against it, and in favor of the assured, they may well be considered as carried forward by intention into the other clause.

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(*Wood on Fire Ins.*, sec. 57.) It is hardly to be supposed that the keeping of benzine, mentioned in one clause, was understood to be any different keeping from that mentioned in a previous clause. In this view, the act of Walker entirely outside of the authority of the plaintiff, and of any occupation of the premises under the plaintiff, could not, in any sense, be justly said to be done by the assured. Beyond this, if the last clause was to stand by itself, on its own language, there would remain the question whether such an act as the jury may have found Walker's to be was not an act insured against. No one would probably contend but that it would have been if done by a stranger and trespasser; and probably no one would contend but that the act would have been insured against if Walker had wilfully fired the property; nor but that it would if he had brought the benzine there as a means to fire it with. These acts would have been so because, although he was there and doing some things under authority derived from or under the plaintiff, they would be done in violation of authority, and against his right. They would have caused a loss that he was not responsible for, and against which he was insured. Walker's authority there was included in running the hotel, and when he got outside of that he was outside of what the plaintiff was responsible for, and what he did outside of that was wrongful as to the plaintiff and included in that against which the plaintiff was insured, and not in that which he agreed with the defendant to prevent.

The privilege to use gasoline gas was without limitation or restriction, except as to location of the apparatus and the employment of heat in the process. The defendant argues for a construction of it the same in effect as if it was a privilege to use gasoline only in the apparatus mentioned; but that is not the language. The privilege is to use that gas, and the location of the apparatus for making it only is fixed. The gas could not be made without gasoline or benzine, and the privilege to make it would necessarily include the presence of the things of which it must be made, and these things must be brought to the premises somehow, and kept somewhere for use as

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wanted, and, therefore, it would include the necessary bringing and storing. The privilege was broader than the literal import of the words, but how much broader could not be determined as a matter of law. The question was one of fact, to be determined upon the circumstances and necessities of the case. The defendant's evidence went to show that the apparatus was the place in which the material should be stored. This was proper evidence, and the propriety of it showed that there was a question of fact on which it might have weight, and this question could only be as to whether the material should be stored in the apparatus or elsewhere; and, also, that there was something in the case which might be weighed on the other side of the question, and which this testimony was to meet. If the material was to be stored elsewhere, the proper place where would also involve a question of fact to be determined by the jury. And, if it was within the privilege to store it elsewhere, then the defendant took the risk of the premises, when it might be so stored, with it there. This risk would be no greater or different, whether it was stored there for use in the apparatus, or for use in some other mode on the premises, or not to be used on the premises at all. Other use on the premises might be prohibited, but, if the prohibited use was not made, the keeping for such use would not vitiate the policy, if the keeping it was not prohibited. This case, in this aspect, is like *Citizen's Insurance Co. v. McLaughlin*, (53 Penn., 485,) where the policy granted the privilege of keeping not more than five barrels of benzole in a small shed entirely detached from all the other buildings, situated on the rear end of the lot, about one hundred feet from the main building, and nowhere else on said premises. The buildings insured were a patent leather manufactory; benzole was used in the manufacture, and a workman carried a bucket containing three or four gallons of it into the middle of a room in the factory, and set it down there, and turned away from it, and it took fire from an unknown cause, and communicated the fire to the building, which was consumed, and this was the loss in controversy. The jury found that this was one of the

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risks covered by the policy, and the insured recovered for the loss. In the case under consideration there seemed to be no way but to submit the question as to the extent of the risk taken by this clause, and whether it covered the benzine in the oil room, to the jury, as was done.

The motion for a new trial is overruled, and judgment for the plaintiff on the verdict is ordered.

George H. Forster, for the plaintiff.

William Allen Butler, for the defendant.

JOHN P. LINDSAY vs. LEWIS STEIN. IN EQUITY.

Letters patent, No. 202,735, granted to John P. Lindsay, April 23d, 1878, for an "improvement in sleeve supporters," are valid.

The patented supporter consists of two of the clasps patented to Lindsay by patent No. 156,429, November 3d, 1874, one at each end of a connection either elastic or non-elastic. But the case is not one of a mere double use of the clasp.

Lindsay applied for a patent for the supporter in October, 1874. The application was rejected in November, 1874, and again in January, 1875, and nothing more was done upon it. In April, 1878, a new application was filed, on which the patent was granted: *Held*, that, under § 4,894 of the Revised Statutes, the first application was abandoned, because not prosecuted within two years after its rejection, but the invention was not thereby abandoned, and a second application could be made.

The patent would be invalid if the invention covered by it were in public use or on sale in this country for more than two years before the second application.

The features of Lindsay's invention pointed out, on the question of novelty. The question of the infringement of the patent considered.

(Before BLATCHFORD, J., Southern District of New York, February 24th, 1882.)

BLATCHFORD, J. This suit is brought on letters patent No. 202,735, granted to the plaintiff, April 23d, 1878, for an

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“improvement in sleeve supporters.” Some time in 1873 the plaintiff invented a clasp. He applied for a patent for it on the 31st of August, 1874, and obtained a patent for it, No. 156,429, November 3d, 1874. The specification of that patent speaks of the clasp as one “for stocking supporters or various other articles of wearing apparel.” The clasp is composed of two jawed levers, pivoted together, and a spring arranged between them. The tail of each jaw lever is made concavo-convex in transverse section, the lower lever with its jaw being extended within the upper lever and its jaw. At the place of connection of the two levers the lower one is punched inward on its flanks, so as to form two concavo-convex teats or projections. The spring is shaped or made of wire, and has an eye which is slipped upon the two teats, after which the upper jaw lever is arranged with respect to the spring and the lower jaw lever in proper position, and then is punched inward on its flanks, so as to enter the two teats, and thus the two levers are connected and pivoted together. The levers cover and protect the spring, and, as the specification says, prevent it “from being caught in the stocking or clothing” and from moving laterally or getting out of place. The specification says that each of the jaws may be notched or provided with teeth in its opposite edges, and that, by having the jaw of the lower lever close into the concavity of the jaw of the upper lever, a much better hold of the “material or stocking” will be secured than when the jaws abut together at their edges. The tail of the upper lever has a slotted head, which is projected from the tail in such manner that its flanks, in case the clasp is pressed “against the leg of the wearer,” may bring up against it, “in a manner to prevent” the tail of the lower jaw from being accidentally moved inward so as to open the jaws sufficiently to cause them to let go their hold “on the stocking;” and “the slotted head is also to enable the clasp to be attached to a strap of a stocking supporter.” The claim of No. 156,429 is this: “The clasp composed of the levers provided with the operative spring, pivoted together by means of the indentations, as described,

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and made with concavo-convex jaws and tails, and with the one jaw to close within the concavity of the other, all substantially as specified."

In January or February, 1874, the plaintiff invented the sleeve supporter afterwards patented by No. 202,735. It consisted of two of the clasps described in No. 156,429, one being at each end of a connection either elastic or non-elastic. No. 202,735 describes the supporter as one "for the sleeves of shirts and other garments." It is applied to the sleeve in a direction longitudinal with the arm, "thereby avoiding the compression and consequent interference with the free circulation of the blood incident to that class of supporters which partially or entirely encircle the arm." One clasp grasps a fold of the lower part of the sleeve to be supported, while the other clasp grasps a fold of the upper or supporting portion of the sleeve, the lower portion of the sleeve being drawn up to the desired distance before attaching the second clasp, the intermediate portion between the two clasps being drawn up into folds by that operation. The specification disclaims "a garment supporter consisting of an elastic strap and two tongued plates attached to its ends, the tongues being made to enter holes in the garments, and being afterward clinched down thereon." It also says: "My improved supporter simply grasps the sleeve, and does not go into or through it, and, consequently, in detaching the supporter therefrom, it does not require to be pulled lengthwise, and thereby cause undue strain, which tends to tear the sleeve. Nor does my supporter require cuts or holes to be made in the sleeve to receive it, as is usually the case with garment supporters." The claims of No. 202,735 are two, as follows: "1. The improved method of supporting or shortening the sleeves of shirts and other garments without compression, to avoid interference with the free circulation of the blood of the wearer incidental to the use of encircling bands, by means of a holder, consisting, essentially, of a short piece of elastic or non-elastic webbing, provided at each end with an automatic clasping device applied to the sleeve in the direction of its

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length, substantially as described and shown. 2. As a new article of manufacture, a sleeve supporter consisting of the strip B, provided at its ends with the clamping jaws A A, all combined and adapted for use substantially as described." The plaintiff, after making one of these supporters in January or February, 1874, showed it to other persons and illustrated its use at that time, and used it himself satisfactorily in March or April, 1874. He made a second supporter of the same structure in September, 1874, as a model for an application for a patent. His application was filed in the Patent Office, complete, October 28th, 1874. The specification was sworn to October 20th, 1874. The drawings were substantially the same as those in No. 202,735, and the description was to the same effect. The claim was substantially like claim 2 of No. 202,735. The spring closes the jaws and they are opened by pushing the tails of the jaws towards each other against the action of the spring, the tail of the lower jaw projecting downward. This application was rejected November 9th, 1874, on the ground that it did not involve invention, in view of No. 156,429, and of a patent to Langford and one to Boughton. On December 26th, 1874, amendments were filed. One, to obviate the Boughton patent, disclaimed a supporter consisting of an elastic strap and two hooked plates fixed to its ends, the hooks "being to enter a garment." Another disclaimed either of the clasps separate from the strap. The amendments were considered, and, on January 2d, 1875, the application was again rejected, in view of the same references. Nothing more was done till April, 1878. On the 9th of April, 1878, a new application was filed, complete, with a new petition, oath, specification, drawing and model, and a new fee. The oath was made April 5th, 1878. On the 11th of April, 1878, the application was rejected as being "found to be lacking in patentable novelty, in view of the state of the art," because the clasp was old, as seen in No. 156,429, and because "suspending straps, composed of an elastic band, with a clasp, buckle or other adjusting device on each end, is also old, and, therefore, in the present instance, the alleged inven-

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tion is but the mere substitution of one old clasp in the place of another upon the ends of the strap, and is not deemed an invention." Reference was made, in the letter of rejection, to patent No. 88,984, to Robbins, and to patents to Gibbons, Church and Eames, and Philbrook. On the 11th of April, 1878, after said rejection, amendments were made, making the specification and claims exactly as they are in No. 202,735. The application was rejected again on the 13th of April, 1878, on the same references and on a patent to Sanford, but on the same day the patent was ordered to be issued.

It is contended, for the defendant, that No. 156,429 contains everything that is found in No. 202,735 ; that there was no invention involved in passing from the clasp to the structure with one of the clasps at each end of it ; and that the case is one of mere duplication or double use, or, at least, of merely a new application of the clasp. It is quite apparent, from the evidence, that the clasp was applicable, and was applied, for use, by being attached to one end of a piece of elastic and then fastened to a stocking to hold it up, the other end of the elastic being fastened by a button or other device to another garment above. Large numbers of the clasps were made and sold and used in that way. The plaintiff, almost simultaneously with his invention of the clasp, capable of such separate use, invented the supporter consisting of the two clasps and the connecting strip. The latter invention was completed before he applied for the patent for the former. In that application he might have covered the supporter and also claimed the clasp separately, and one patent might have embraced both. The supporter is not merely a new application of the clasp. It is something more. As a structure, the two clasps with the uniting strip will do what one clasp, or one clasp with an attached webbing, cannot do. It is an article complete in itself, capable of use at any place without any appliance except what it contains, and of being moved from one place to another, without any previous special preparation of the garment to receive it. It involves invention, beyond what the clasp alone indicated.

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The specification of No. 202,735 is criticised, as being obscure and as not pointing out what invention is claimed. The first claim is properly to be construed as a claim to using the structure described, consisting of material with the clasp described, or its substantial equivalent, at each end, when such structure is applied to the sleeve in the direction of its length. There is no valid objection to this claim. The article can be used otherwise than lengthwise of the sleeve. The second claim is for the article, irrespective of the manner in which it is used. The first claim may be unnecessary and there may be little practical difference between the two claims. But the claims sufficiently point out the inventions and they are patentable.

By § 12 of the Act of March 2d, 1861, (12 *U. S. Stat. at Large*, 248,) it was enacted as follows: "All applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and, in default thereof, they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable." By § 32 of the Act of July 8th, 1870, (16 *Id.*, 202,) it was enacted as follows: "All applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and, in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable." This section is substantially reenacted in § 4,894 of the Revised Statutes, approved June 22d, 1874, the only change being that the words "the filing of the petition," in § 32, are altered to the words "the filing of the application," in § 4,894. On comparing § 32 of the Act of 1870 with § 12 of the Act of 1861, it is seen that a material change was made, by the addition, in § 32, of the words, "or upon failure of the applicant to prosecute the same within two years after any action therein." The effect of

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the addition was, that when an applicant for a patent should make an application, and complete it for examination, and the Patent Office should take action upon it, and reject it, and notify him of such action, and he should fail to prosecute it within two years after such rejection, it should be regarded as abandoned, so that it could not be resumed and prosecuted further after the lapse of such two years, unless it should be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. It is not the invention which should be regarded as abandoned, but the application. In the present case the application of October 28th, 1874, was rejected a second time January 2d, 1875. That application was never prosecuted at all after that. More than two years elapsed, and, in December, 1877, the plaintiff employed new attorneys, and gave them a power of attorney, and revoked the power of attorney given to his former attorney. A paper to that effect was filed in the Patent Office December 17th, 1877, in the files of the first application. The new attorneys, with the whole matter before them, advised the plaintiff that he had better make a new application. They did this, unquestionably, because they saw that they could not show to the satisfaction of the Commissioner that the delay beyond two years from January 2d, 1875, was unavoidable. The new application was made, complete, April 9th, 1878.

The defendant contends that the effect of the Act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned application, and the applicant must stand, as to defences in suits on the patent, as if the new application were the first application. Therefore, as applied to the present case, the words "two years prior to his application," in § 4,886 of the Revised Statutes, and the words "two years before his application for a patent," in § 4,920, must mean, two years before April 9th, 1878, so that No. 202,735 will be invalid, if the inventions covered by it were

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in public use or on sale in this country for more than two years before April 9th, 1878. The decisions of the Courts under the statutory provisions before that in § 32 of the Act of 1870, in regard to the continuity of an application once made, can have no application to a case like the present, in view of the express provision of § 32. An application which is to be "regarded as abandoned" must be regarded as abandoned by the Commissioner and the Courts, and, if it is to be regarded as abandoned, it cannot be regarded as subsisting for the purposes of §§ 4,886 and 4,920. The cases of *Singer v. Braunsdorf*, (7 *Blatchf. C. C. R.*, 521,) *Blandy v. Griffith*, (3 *Fisher's Pat. Cases*, 609,) *Howes v. McNeal*, (15 *Blatchf. C. C. R.*, 103,) *Godfrey v. Eames*, (1 *Wallace*, 317,) and *Smith v. Goodyear Dental Vulcanite Co.*, (3 *Otto*, 486,) arose under statutory provisions enacted before the Act of 1870 and can have no application to the present case.

It is argued, for the plaintiff, that, as No. 202,735 was granted on the second application for the same invention that was claimed in the first application, it must be presumed that the Commissioner had before him evidence showing that the delay in prosecuting the first application was unavoidable. This would be so if, in fact, the Commissioner had allowed the first application to be prosecuted further. But he did not. It was the application of April 9th, 1878, that was rejected April 11th, 1878, and granted April 13th, 1878, and No. 202,735 was issued on that application, as appears on its face and by the records of the Patent Office.

The defences of want of novelty and of public use and sale of the invention for more than two years before the application for the patent are urged by the defendant. The latter defence is not set up in the answer, but the plaintiff appears desirous of having it considered under the proofs.

There is no satisfactory evidence that the plaintiff, either by himself or by his agents, allowed his sleeve supporter to be in public use or on sale at any time prior to two years before April 9th, 1878; or that a structure substantially like his was in public use or on sale at any time prior to two years before

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April 9th, 1878. The date of any sale by Taylor Brothers cannot be fixed earlier than January, 1877. There was no sale by Shelby before the last part of 1876. The Thomas transaction was in May, 1876. The evidence as to sales by Rollins does not show, beyond a reasonable doubt, that such sales were made before April 10th, 1876.

Defendant's Exhibits 1 and 2 are arranged to penetrate or pass through at one end one portion of the article to be supported, while at the other end are loops or hooks to pass over or around buttons or some other previously arranged attaching means formed upon the garment. Defendant's Exhibits Nos. 3 and 16 have no hinged jaws and require a further shortening of the garment to allow of attaching or disengaging the wires, and the device is liable to lose its hold and cannot seize the margin of a garment. Defendant's Exhibit No. 21 is the patent to Robbins, No. 88,984, and defendant's Exhibit No. 5 is a garter made according to that patent, in part. They show devices the structure of which is such as to necessitate the penetration of the garment at each end of the webbing, by the devices. The Robbins patent is the only one of the prior patents referred to by the Patent Office, (except No. 156,429,) which has been put in evidence by the defendant. It shows two like devices at each end of a piece of webbing. It is of the date of 1869. But the existence in it of identity between the fastening devices at each end of it does not, in view of the evidence as to the invention by the plaintiff of the clasp and of the supporter, and of the characteristic features of the supporter, show a want of patentability in the invention of the supporter. The Ellis patent, No. 137,539, requires a button at one end of the device. The Cook patent, No. 55,064, has no clamping jaws and no webbing with holding means at each end of it. The Kendall or Vail patent, No. 61,011, has no clamping jaws on each end of a strip of webbing. Defendant's Exhibit No. 22, the Demorest book, is not proved as to its date of publication and is not set up in the answer. Independently of this, it is not clear what the thing shown in it is, or how such thing is to be used. From what can be

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made out it is liable to the same objections as defendant's Exhibit 3, requiring the fabric to be forced into a narrow opening, and requiring increased shortening to free the fabric, and having no clamping jaws. As to the Exhibits Furness and Furness No. 3, no original article actually made more than two years before April 9th, 1878, is produced. The question as to the time when any sleeve supporters of the kind were made and sold rests wholly on the unaided memory of Mr. Furness, and, in view of all the evidence, it must be held that the defence as to the Furness sleeve supporter is not established. Irrespective of this, it is not at all clear that the Furness Exhibits embrace the plaintiff's invention, or will practically accomplish the results which the plaintiff's supporter will accomplish. None of the prior articles or patents anticipate the invention of the plaintiff, and none of the defences considered are established.

It appears that the patented article is one of great utility and has found a ready market, as compared with any prior structures. Under the plaintiff's authority, from 850,000 to 1,150,000 pairs of his supporters have been sold during 1878, 1879 and 1880, and there have been infringements. The article combines these points of advantage—it does not compress the arm; it does not require adjustment of length for arms of different sizes; it does not require previous preparation of the garment, by putting on buttons or making eyelet holes at either end; it can be used to support cuffs and stiff articles on their edges; it can be applied by one hand; it is secured without perforating the garment; it is not pulled off by a slight strain; it does not require to be pulled lengthwise to release its hold. It has superseded older articles and is largely recognized by the public and licensees as a useful invention. All these matters are very persuasive in favor of its patentability. (*Smith v. Goodyear Dental Vulcanite Co.*, 3 Otto, 486, 495.)

The defendant has sold two structures, No. 1 and No. 2. No. 2 is identical with the plaintiff's, in all substantial particulars. It is a sleeve supporter, formed of a short piece of elastic webbing, with a clasp at each end. Each clasp is com-

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posed of two jawed levers, pivoted together, with a spring between them, which closes the jaws automatically, and the jaws are opened by pressing together the tails of the levers. Each jaw has across its end teeth or projections which take into corresponding indentations in the end of the other jaw. This construction is an equivalent construction for the closing of the lower jaw within the upper jaw, as shown in No. 156,429 and in the drawings of No. 202,735. The bending of the fabric, in the one case transversely and in the other case longitudinally, assists in holding it, though it by no means follows that No. 202,735 would not be infringed if the clasps had flush meeting edges in the jaws with a spring, or means of holding them together, sufficiently powerful. No. 1 is a sleeve supporter having at each end of a piece of elastic webbing a clasp made of two jaws of springy metal, the end of each of which is a lip projecting towards the other jaw, one lip shutting inside of the other and the ends of the lips not meeting. There is a slide enclosing the shanks of the two jaws, and the bite is made by sliding the slide towards the lips, which forces the lips together. Sliding the slide in the reverse direction allows the jaws to open, which they do by their springy action, they being set to stand open unless made to shut. They shut against the action of the spring, while in the plaintiff's form the clasp opens against the action of the spring. The form of clasp in No. 1 is substantially the clasp shown in the Ellis patent, No. 137,539, granted April 8th, 1873. But that patent shows that Ellis contemplated the use of only one clasp, and that at the top of a stocking, while above the supporter was to be attached by a button to a waistband. No. 1 has all the points of advantage of the plaintiff's structure. It has an automatic clasp device at each end, consisting of clamping jaws, and the structure as a whole, and in its parts, and in their co-operation to effect the result produced by the whole, is the equivalent of the plaintiff's structure. The change in the springy action, to hold open instead of to hold shut, is immaterial in regard to the action of the structure as a whole. There was nothing in the Ellis clasp by

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itself to indicate the plaintiff's supporter or No. 1, any more than there was anything in the plaintiff's clasp by itself to indicate the plaintiff's supporter or No. 2. On the foregoing considerations it must be held that both No. 1 and No. 2 infringe the second claim of No. 202,735, and there must be a decree to that effect and for an account of profits and damages, with a perpetual injunction, and costs to the plaintiff.

Munson & Philipp, for the plaintiff.

J. B. Staples, for the defendant.

DONNELLEY, GASSETTE & LOYD

vs.

MATTHEW J. IVERS AND JAMES SULLIVAN. IN EQUITY.

The title deposited with a view to a copyright for a book was this: "Over One Thousand Recipes. The Lake-Side Cook Book; A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. Chicago: Donnelley, Loyd and Company, 1878." The book was published with this title page: "The Lake-Side Cook Book No. 1. A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. By N. A. D.," followed by the imprint of the place of publication and the name of the proprietor and the notice of copyright, on the title page: *Held*, that the omission, in the title page of the published book, of the words "Over One Thousand Recipes," and the addition, in it, of the words "No. 1" and "By N. A. D." were immaterial, and that the title published was deposited, in compliance with § 4,956 of the Revised Statutes.

(Before BLATCHFORD, J., Southern District of New York, March 4th, 1882.)

BLATCHFORD, J. On the 19th of April, 1878, Donnelley, Loyd and Company, a copartnership firm, deposited in the office of the Librarian of Congress the title of a book, the title or description whereof was in the following words: "Over

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One Thousand Recipes. The Lake-Side Cook Book ; A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. Chicago: Donnelley, Loyd and Company, 1878," the right whereof they claimed as proprietors in conformity with the laws of the United States respecting copyrights. Whatever right and title the firm acquired in the copyright it subsequently assigned to the plaintiff. The firm and the plaintiff, in publishing the book which it is claimed the copyright applies to, have always published it with the following title page : " The Lake-Side Cook Book No. 1. A Complete Manual of Practical, Economical and Palatable and Healthful Cookery. By N. A. D.," followed by the imprint of the place of publication and the name of the proprietor and the notice of copyright, on the title page. The plaintiff moves for an injunction, before final hearing, to restrain the infringement of the copyright. The defendants have printed and published a book, the body of which is a *verbatim* copy, as to matter and type, of the plaintiff's book, and which has the following title page : " The Home-Made Cook Book ; A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. New York ; M. J. Ives & Co., 86 Nassau Street."

The defendants contend that the copyright is invalid because the words, " Over One Thousand Recipes " are not on the title page of the plaintiff's published book, and are in the title deposited, and because the words " No 1 " and " By N. A. D. " are on said title page and are not in the title deposited. The provision of § 4,952 of the Revised Statutes is, that the exclusive right secured under a copyright is to be enjoyed " upon complying with the provisions of this chapter. " Section 4,953 says that copyrights shall be granted " in the manner hereinafter directed. " There is no investigation or decision by any officer, nor is any grant issued. What is done is to be done by the party desiring the copyright. Nothing is to be done by any officer, except that the librarian of Congress is to give to the proprietor a copy, under seal, of the recorded title, when required. Section 4,956 provides as fol-

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lows: "No person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the librarian of Congress, or deposit in the mail, addressed to the librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book * * * for which he desires a copyright." Section 4,957 provides that "the librarian of Congress shall record the name of such copyright book * * * forthwith, in a book to be kept for that purpose, in the words following:" The form states the fact of the deposit of "the title of a book" on a day named, by a person named, "the title * * * of which is in the following words, to-wit: (here insert the title * * *,) the right whereof he claims as proprietor, in conformity with the laws of the United States respecting copyrights." By § 4,964, damages for the violation of a copyright of a book are made to depend on the fact of the recording of the title of the book, "as provided by this chapter."

It was settled in the case of *Wheaton v. Peters*, (8 *Peters*, 591,) that there can be no exclusive property in a published work except under some Act of Congress; that Congress, when about to vest an exclusive right in an author, has the power to prescribe the conditions on which such right shall be enjoyed; and that no one can avail himself of such right who does not substantially comply with the provisions of the law. It has been held to be necessary to show that the title was deposited before publication; that this is an absolute requirement; and that the Court cannot disregard the requirement. (*Chase v. Sanborn*, 4 *Clifford*, 306.) In *Baker v. Taylor*, (2 *Blatchf. C. C. R.*, 82,) it was held that, under a title deposited in 1846, a printing, on the page following the title page in the book, of a notice that the copyright had been entered in 1847, was fatal to the plaintiff's right. The Court said: "Even though the failure to publish the statutory notice arose from mistake, this Court would have no power to accept the intention of the party, in place of a performance, any more in respect to the insertion of that notice on the proper page, than in respect to the deposit of the title of

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the book." The same principle was applied in *Struve v. Schwedler*, (4 *Blatchf. C. C. R.*, 23.) In *Parkinson v. Lassel*, (3 *Sawyer*, 330,) it was held, in reference to the deposit of the title, that, under §§ 4,952 and 4,956, a person can have no copyright until he has performed that condition.

In the present case a certain title was deposited. That title, *verbatim*, is not the title page of the book afterwards published as the book to which such title appertained. So, too, a book with a certain title page was published, but no *verbatim* copy of such title page was deposited before publication. The title deposited and the title page of the book published contain, in common, the name or designation: "The Lake-Side Cook Book; A Complete Manual of Practical, Economical, Palatable and Healthful Cookery." The words "Over One Thousand Recipes," in the deposited title, are not on the title page of the published book; and it is shown that there are in the book only about 800 recipes. The words "No. 1" and "By N. A. D." are in the title page of the published book and are not in the deposited title. What the statute requires to be deposited is "a printed copy of the title." The language is not "a printed copy of the title page," that is, a printed copy of the page containing the title. Everywhere in the statute, in reference to the thing deposited, it is "the title." What is "the title?" Section 4,957 provides, that, as soon as "the title" is deposited, the librarian of Congress shall "record the name of such copyright book." Therefore, "the title" to be deposited and recorded is "the name" of the book. The record in the librarian's book must undoubtedly contain, as the name, the title deposited. But the question is as to what is a sufficient title or name to be deposited and recorded, when it is seen afterwards what is the title page of the book published after the deposit.

The theory of the copyright statutes is, that every book must have a title or name or designation—something short and convenient by which it may be identified in the speech of the people; that that title or name must appear on it, or in

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it, when published, on a title page or its equivalent ; and that such title or name must have been, before the publication of the book, deposited in the designated office. The copyright to be protected is the copyright in the book. A printed copy of the title of such book is required to be deposited, before publication, only as a designation of the book to be copyrighted. The title is "a mere appendage, which only identifies, and frequently does not in any way describe, the literary composition itself, or represent its character." The title alone is never protected separate from the book which it is used to designate. (*Jollie v. Jaques*, 1 *Blatchf. C. C. R.* 618, 627; *Osgood v. Allen*, 1 *Holmes*, 185, 193.) In determining, therefore, whether this book is protected by a copyright, the inquiry is, whether its title or name was deposited. Its title or name is to be gathered from the title or name now given to it and appearing on its title page. There is nothing connected with its title, on the title page, that is not found in the title deposited, except the words "No. 1" and "By N. A. D." Everything else, the real name and designation of the book, as found on the title page, is in the title deposited. The words not found in the title deposited are immaterial and no part of title or name. The "By N. A. D." is mere surplusage, and neither helps nor harms the title. The "No. 1" appears to have been put in because the same parties, in 1878, copyrighted and published a book called "The Lake-Side Cook Book No. 2." Under the foregoing views, the title of the book was deposited before publication. The presence, in the title deposited, of the words "Over One Thousand Recipes" is immaterial. They are no part of the substantial title. When the title was deposited it may have been intended to put into the book over one thousand recipes. That purpose was afterwards changed. Yet the book was published with the same title substantially. Aside from this, it is sufficient if the title of the published book was deposited, without its being necessary that everything in the paper deposited as a title should be reproduced on the title page of the book afterwards published. The requirement as to the deposit of the

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title having been substantially, in good faith, complied with, (*Myers v. Callaghan*, 5 *Fed. Rep.*, 726, 731, 732,) the objection that the statute as to depositing the title was not observed is not tenable.

There are defects in the bill filed, which must be amended, and, when that is done, the motion for an injunction may be renewed. The defects referred to were pointed out at the hearing.

James Watson, for the plaintiff.

Robertson, Harmon & Cuppia, for the defendants.

THE NEW YORK GRAPE SUGAR COMPANY

vs.

THE AMERICAN GRAPE SUGAR COMPANY AND OTHERS.
IN EQUITY.

It being doubtful whether there was any invention in forming the bottom of a starch tray of sheet metal, it having before been made of wood and lined with metal, a preliminary injunction on a patent for so forming the bottom was refused.

It would seem that the presumption arising from the grant of a patent, especially when not of recent date, ought to be a sufficient ground for granting a preliminary injunction against an infringer who does not attack the patent.

Where a plaintiff had bought a patent and proposed to use it not by manufacturing under it, but by selling licenses, but had not established any license fee, and the defendant was responsible, and serious consequences to him would arise from granting a preliminary injunction, it was refused.

(Before WALLACE, J., Northern District of New York, March 6th, 1882.)

WALLACE, J. The complainant moves for a preliminary injunction to restrain the defendants from infringing four patents owned by the complainant, relating to improvements

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in the apparatus for manufacturing starch. Of these patents the first was issued January 14th, 1868, to John A. Owens, and was re-issued to Thomas A. Jebb and William T. Jebb, May 31st, 1881, for a combination of an agitator and vibrating screen or sieve; the second was issued May 26th, 1868, to John A. Owens, for an improvement in starch trays, which consists in forming the bottoms of sheet metal; the third was issued September 8th, 1868, to J. J. Gilbert, as assignee of Colgate Gilbert, for a bolting sieve vibrated, supported, and fed as described, and the constituent parts thereof; and the fourth was issued to Colgate Gilbert, April 15th, 1873, for an adjustable support to a starch separator. Except as to the second patent the defendants have entirely failed to impugn the right of the complainant to an injunction, if this were a final hearing instead of a motion for a preliminary injunction.

As to the second patent, sufficient appears to raise doubts as to the patentable novelty of the improvement described. It would seem that the employment of sheet metal as a lining for the bottom of a starch tray involves no invention. The bottom had been made of wood, and, undoubtedly, when lined with lead or copper or galvanized iron, would be more durable and more easily cleaned. But it is within common knowledge that such linings had been used analogously in many other vessels made to contain liquids, because of these advantages. Such a lining had also been employed, as described, in the Belgian patent of Heidt, for forming the bottom of a trough or channel used for the deposition of starch, in place of the tray used by Owen. Inasmuch as the Court will not decide doubtful questions as to the complainant's right upon a motion for a preliminary injunction, the motion fails as to this patent.

The other patents are not seriously assailed, and it is not denied that the defendants have appropriated the improvements covered by them and are now employing them in their glucose factories.

An attempt has been made to present the defence of aban-

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donment. It is not claimed that there had been an abandonment before the letters patent were obtained, and the facts disclosed signally fail to show any intention, on the part of the owners of the patents, to abandon or dedicate their rights to the public subsequently. It is not shown that the owners of the patents, prior to the Jebbs, who acquired title in the spring of 1881, had any knowledge that the defendants or others were using the patented improvements. It would seem to be fairly inferable, although not distinctly shown, that the Gilberts, who owned all the patents prior to the purchase by the Jebbs, intended to preclude the public from participation in the use of the patents, and to use them exclusively in their own starch factories. The improvements were surreptitiously appropriated from the Gilberts by Fox & Co., from whom they were also surreptitiously acquired by the Buffalo Grape Sugar Company and these defendants. The history of the process patent throws no light upon that of the apparatus patents.

It is insisted that the complainant has not shown such an exclusive enjoyment by the owners of the patents, and recognition by the public of their rights, as to authorize a preliminary injunction, in the absence of any adjudication upon the patent. If, by the policy of the owners, information as to the practical working of the inventions was withheld from the public, of course there could not be such a recognition and acquiescence as in many of the cases has been held to be necessary. Formerly, the rule undoubtedly was, that a preliminary injunction would not be granted unless the right secured by the patent was forfeited by evidence of an exclusive or recognized enjoyment of the right, or by former adjudications sustaining it. In more recent practice this rule has been relaxed when the validity of the patent is not assailed and the proof of infringement is clear. (*North v. Kershaw*, 4 Blatchf. C. C. R., 70; *The Burleigh Rock Drill Co. v. Lobdell*, 1 Holmes, 450; *Steam Gauge & Lantern Co. v. Miller*, 8 Fed. Rep., 314.) It would seem that the presumption arising from the grant, especially when not of recent

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date, ought to suffice as against a defendant who has appropriated an invention secured to another by letters patent, which are not attacked. It is not necessary, however, to pass definitely upon the point in the present case, because the injunction must be denied upon another ground.

The complainant has recently purchased the patents and proposes to use them not by manufacturing under them but by selling licenses to others. It is expressly alleged, in the moving affidavits, that the complainant does not desire to enjoin the defendants provided they will accept a license and pay damages at the same rate as other licensees. It does not appear that the complainant has as yet established any license fee for the use of the apparatus patents independently of the process patent. The sum which the defendants should pay cannot, therefore, well be determined except by an accounting for profits, and, as they are entirely responsible, when this is had, the complainant can be adequately compensated. Irreparable damage is an indispensable element upon an application for provisional injunction. (*Sanders v. Logan*, 2 *Fisher's Pat. Cas.*, 167; *Morris v. Lowell Mfg. Co.*, 3 *Id.*, 67; *Pullman v. B. & O. R. R. Co.*, 4 *Hughes*, 236.)

On the other hand, the defendants have gradually created and developed an extensive market for glucose and grape sugar, so large that, if their works were stopped, the demand could not be well supplied and serious inconvenience would result. They have not only invested a large capital in their manufacturing business, but they employ a great number of workmen, many of whom would be temporarily cut adrift if an injunction were granted. It is difficult to see how the defendants could remove the patented apparatus without substantially dismantling and re-organizing their works. Under such circumstances, the equitable considerations which appeal to the discretion of the Court, and, within well recognized rules, should lead to the refusal of a preliminary injunction, cannot be ignored.

If the complainant has any reason to doubt the pecuniary ability of the defendants, now, or at any future time, to pay

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any decree that may be obtained in the suit, it may apply for a further order requiring the defendants to enter into a bond with sureties.

Dickerson & Dickerson, for the plaintiff.

Bowen, Rogers & Locke, for the defendants.

CHARLES GODFREY GUNTHER

vs.

THE LIVERPOOL AND LONDON AND GLOBE INSURANCE COMPANY.

In the Second Circuit, actual disbursements necessarily incurred in a suit, in addition to fees paid for exemplifications and copies of papers, under § 983 of the Revised Statutes, are taxed in favor of the prevailing party.

Accordingly, in a suit at law, \$1 paid for serving the summons by which the action was commenced was allowed as a disbursement.

Money paid to a stenographer for a copy of the minutes of the testimony given on the trial was not allowed.

Interest on the verdict from the day it was rendered to the day of rendering judgment was allowed.

(Before BENEDIOT, J., Eastern District of New York, March 7th, 1882.)

BENEDIOT, J. Prior to the enactment of the fee bill of February 26th, 1853, (10 *U. S. Stat. at Large*, 161,) the actual disbursements necessarily incurred and deemed reasonable were allowed in the taxation of costs, in accordance with the provisions in the laws of the State, (2 *R. S.*, 634,) by virtue of the Rules of Court. (See 1 *Blatchf. C. C. R.*, 652.) Such is the law now unless modified by the fee bill of 1853. That fee bill in terms relates to compensation of the officers named, but does contain a provision (*p.* 168, now § 983, *Rev. Stat.*) allowing clerks to include in the judgment fees for exemplifications and copies of papers necessarily obtained for use on

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trial, when taxed by the judge or clerk. This provision has by some been considered as exclusive and to forbid the taxation of any item of disbursement other than fees paid for exemplifications and copies of papers, but in this Circuit a different understanding has prevailed, and actual disbursements necessarily incurred have been taxed. (See *Hussey v. Bradley*, 5 *Blatchf. C. C. R.*, 212; *Dennis v. Eddy*, 12 *Id.*, 195.) The rule for this Circuit, as laid down in the cases referred to, will permit, in this case, the taxation of the item of \$1 paid for serving the summons by which the action was commenced in the State Court. It was a necessary disbursement actually made in the cause, and is now taxable by this Court, by virtue of the Rules of the Court, as it would have been prior to the fee bill of 1853.

The sum paid the stenographers by the plaintiff, to obtain a copy of his minutes of the testimony given on the trial, cannot be taxed, because the employment of a stenographer was not directed by the Court, and there was no consent to the insertion of any part of the stenographer's charges in the bill of costs.

The item of interest on the verdict from the day of the rendition of the verdict to the day of entry of the judgment, amounting to some \$500, may be allowed. The delay was caused by a stay of proceedings during the pending of a motion for a new trial. This delay should not be at the plaintiff's expense. The payment of interest meanwhile might probably be deemed a condition attached to the stay; or, if not, an entry of the judgment as of the date of entering the motion for a new trial might, if necessary to avoid damage to the plaintiff, be permitted; but I consider the item of interest on a verdict within the equity of the statute, (§ 966 *Rev. Stat.*,) and for that reason taxable. (*Nat. Bank v. Mechanics' Nat. Bank*, 94 *U. S.*, 437; see, also, *Dowell v. Griswold*, 5 *Samyer*, 24.)

The clerk will, therefore, allow the item of \$1 paid for serving the summons, will reject the item of cash paid the stenographer, and will allow interest on the amount of the

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verdict from the date of its rendition to the date of entering up the judgment. The sum paid for the copy of the record of the coroner's inquest may also be allowed.

George A. Forster, for the plaintiff.

Butler, Stillman & Hubbard, for the defendant.

CHARLES E. COBURN AND OTHERS

vs.

NICHOLAS SCHROEDER AND OTHERS. IN EQUITY.


A motion in this case by the defendants to have the decree opened to put in evidence additional matters of defence, was denied.

An English provisional specification is not a patent, within § 4,920 of the Revised Statutes.

(Before WHEELER, J., Southern District of New York, March 8th, 1882.)

WHEELER, J. This cause has now been further heard upon motion of the defendants to have the decree opened, (19 *Blatchf. C. C. R.*, 377,) and leave granted to put in, as further defences to the patent, an English provisional specification, left by James Ritchie Butchart, January 22d, 1866, at the office of the Commissioner of Patents in England, with a petition for a patent, and other evidence of prior knowledge and use. The invention is understood to have been made in February, 1866. The introduction of the provisional specification would be unavailing unless it would bring the case within the third division of section 4,920 of the Revised Statutes: "that it had been patented or described in some printed publication prior to his supposed invention or discovery thereof." In *Smith v. Goodyear Dental Vulcanite Company*, (93 *U. S.*, 486,) the invention was found to have been

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made in the spring of 1855, and there was an English provisional specification and patent in evidence. The Court, at page 498, on this subject, said: "Of the English patent of Charles Goodyear, it is enough to say, that, though the provisional specification was filed March 14th, 1855, the completed specification was not until the 11th of September following. It was, therefore, on the last-mentioned date that the invention was patented." This specification is printed in a book entitled, "Specification of Patents," and, as printed in 1866, found in the Astor Library in the city of New York; and it is urged that this would show a sufficient description in a printed publication. If this would be a sufficient printed publication, it would not be printed until the specification had been left for some time at least, and this invention was so soon after that that this publication would not appear to be, and probably was not, made until after the invention. The other new evidence shown consists of affidavits of knowledge and use in England, France and Canada, and at Buffalo, New York. The evidence of such knowledge and use in a foreign country would not, of itself, defeat the patent, or be material. (*Rev. Stat., sec. 4,923.*) The new evidence of use at Buffalo is set forth in the affidavit of John W. Sherwood, to the effect that, in 1856, he there, "personally made large numbers and quantities of said bottomless trays divided into compartments containing two or more inside cells, as above stated, ; that the same were at that time in common use for drug store and other purposes." This evidence, if it was in, and should gain credit to its full extent, would not show a knowledge and use of this invention as patented, as the patent has been construed. An urgent appeal is made for the opening of the decree on account of the alleged change of issue made by the filing of the disclaimer. As the issue was framed, and understood by all parties, evidence of structures of more than two tiers was applicable, and as much so as it would be since two tier structures have been disclaimed; and, apparently,

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the defendants strove to obtain, and introduced, all the evidence they could obtain of prior knowledge and use of structures of more than two tiers, and the plaintiffs strove to meet it. So, there is not only no new issue, but the parties were not in any way misled in supposing that the issue left after the disclaimer was filed was not in the case before. The defendants claimed, and appear to have supposed, that proof of two tier structures would be sufficient to defeat the patent; they also apparently well understood that, *a fortiori*, proof of more than two tier structures would, and to have acted fully upon that understanding. The disclaimer did not broaden the issue but narrowed it. The parties have had a full opportunity to try, and have diligently availed themselves of the opportunity to try, the question which would be open if the case should be again opened. Therefore, the filing the disclaimer does not affect this question. There is no proof of any specific new evidence to be offered, except that of Sherwood, accompanying the motion. It is really an application to prepare the case over again, although it has already been once, apparently, thoroughly prepared and presented. This, although quite frequently thought by losing parties to be desirable, is not by any rule of law or practice allowable.

The motion must be denied.

Andrew J. Todd, for the plaintiffs.

Samuel Greenbaum, for the defendants.

Cross v. McKinnon.

ALONZO T. CROSS

vs.

DUNCAN MCKINNON AND OTHERS. IN EQUITY.

Letters patent No. 199,621, granted to Alonzo T. Cross, January 29th, 1878, for an improvement in fountain pens, are valid.

The principal distinctive feature of the patent is a spring working between the vibrating writing pin and the air-tube, to project the pin and restrain the flow of ink when the pen is not in use, and yield to the pressure of the point of the pin and make room for the flow of ink when the pen is in use. The invention is not anticipated by a pen in which the vibrating point was actuated by a weight instead of a spring.

A claim to the vibrating pin and spring combined with the air-tube, case of the pen and ink-tube, is a valid claim to a combination.

(Before WHEELER, J., Southern District of New York, March 8th, 1882.)

WHEELER, J. The orator has a patent, numbered 199,621, granted January 29th, 1878, for an improvement in fountain pens, the principal distinctive feature of which is a spring working between the vibrating writing pin and the air-tube, to project the pin and restrain the flow of ink when the pen is not in use, and yield to the pressure on the point of the pin and make room for the flow of ink when the pen is in use. The first claim, which is the one in controversy, is of the vibrating pin and spring combined with the air-tube, case of the pen, and ink-tube. The defences to this suit upon the patent are want of novelty in the invention patented and non-infringement. Fountain pens with air-tubes, vibrating points, and other necessary parts were well known at the time of the plaintiff's invention, but none of them had his precise arrangement of a vibrating point worked by a spring connected with an air-tube, as he arranged them. The defendant McKinnon had a patent for one substantially like the plaintiff's except that the vibrating point was actuated by a weight instead of by a spring; in others there were springs,

but which were not connected, and did not operate like the plaintiff's. One ground of want of novelty presented and urged is the equivalency of the weight in McKinnon's patent to the spring in the plaintiff's. That they are equivalents in some operations is well established and known ; but the question on this part of the case is whether they are equivalents in producing the desired result here. The efficiency of the weight is affected by its necessary confinement in a small working space, and by the necessary inclination of the pen from a perpendicular both when in and out of use. Something to act more quickly in the direction of the point of the pen, without regard to its perpendicularity, was necessary, and this was found in the spring, which, in this operation, was more than the equivalent of the weight. Another ground of lack of patentable novelty is an alleged want of working together of the parts mentioned as combined in this claim. This position rests chiefly upon the fact that the air-tube, as such, has nothing to do with the spring ; that it is a mere support to the spring, and, for that purpose, might as well be a solid rod. It is a fact that the air in the tube and the tubular form of that part have nothing whatever to do with the operation of the spring ; but the patent does not rest upon the idea that they do. The presence of the air-tube was necessary in the pen, and the merit of the invention consists in making the further use of this necessary part to sustain the spring where it is wanted. It does combine with the spring for this purpose, and by this invention is made to do two things instead of one. The spring could be attached to something else, but that would make a different pen, and probably not so good an one.

The defence of non-infringement rests upon the fact that the defendants have the spring inside the air-tube instead of outside. This may be an improvement upon the plaintiff's mode of attaching the spring to the tube ; but, if it is, it is none the less an use of his arrangement. They make use of the same parts, for the same purpose, in substantially the same way.

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Let there be a decree for the plaintiff, according to the prayer of the bill.

Edwin H. Brown, for the plaintiff.

Eugene N. Eliot, for the defendants.

JAMES R. DAVIES AND ANOTHER, ADMINISTRATORS OF LOUISA
FLUHME, DECEASED

vs.

FRANCIS S. LATHEOP, RECEIVER OF THE CENTRAL RAILROAD
COMPANY OF NEW JERSEY.

This suit was brought in a State Court of New York, against the receiver of a New Jersey railroad corporation, to recover damages for the death of the intestate of the plaintiffs, caused in New Jersey, by a train on the railroad of the corporation, while it was being operated by the receiver. The complaint alleged a liability under a New York statute and permission given by the said State Court of New York to sue the receiver. The answer alleged the appointment of the defendant as receiver by a Court of New Jersey, and his subsequent appointment by the said State Court of New York as receiver of the property of the corporation situated in New York, and that he operated the road as a New Jersey receiver. Afterwards, the defendant, as a citizen of New Jersey, the plaintiffs being citizens of New York, removed the suit into this Court, the State Court making an order of removal. The case was then tried by a jury in this Court, the plaintiffs being first allowed to amend their complaint by setting up, in addition, as a cause of action, a statute of New Jersey, and the defendant to amend his answer by setting up the order of the New York Court granting leave to sue and alleging that there was no other leave to sue. The Court held that the complaint must be dismissed because it set forth no cause of action against the defendant as a New York receiver, and because there was no leave to sue him as a New Jersey receiver. No order or judgment to that effect having been entered, the plaintiffs moved to remand the cause to the State Court: *Held*, that the removal was proper, when it was made, and that adding in the complaint the allegation as to the New Jersey statute did not affect the jurisdiction of this Court.

(Before BLATCHFORD, J., Southern District of New York, March 9th, 1882.)

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BLATCHFORD, J. This suit was begun in the Supreme Court of New York, in August, 1879. It is brought to recover \$5,000 damages for the death of the intestate of the plaintiffs, caused at South Amboy, in New Jersey, by a train on the railroad of the Central Railroad Company of New Jersey, in June, 1879, while the road was being operated by the defendant, as receiver of the company, through his employees who were running the train. The complaint is manifestly framed on a liability of the defendant, in a Court of New York, under a statute of New York. The complaint alleges that the defendant "is receiver" of the railroad, "a corporation which was doing business in fact under the laws of this State, having its principal office, now the office of said receiver, in said city of New York;" that "he became receiver duly by appointment of Court;" that, "as such receiver" he was, in June, 1879, managing and operating the road; and that, "while so operating said road," he, through his employees engaged in running a train on said road, killed the intestate, by negligence, at South Amboy. The complaint then states that the suit is brought for \$5,000 damages done by such killing to the next of kin of said intestate, a son and her husband; and that the "plaintiffs, as her personal representatives, for the benefit of, and as compensation for injury done to, her next of kin, and under the statute of said State of New York, pray judgment for the full amount, to-wit, said amount of \$5,000 statutory damages, against said defendant, as well as for costs of this action, permission to bring which was given to plaintiffs by order of this Court, August 20th, 1879, or, likewise for the benefit of those indicated by said statute, plaintiffs, as such representatives, pray judgment against said defendant for such relief as to the Court shall seem just." This complaint does not allude to a statute of New Jersey. Though it does not say that the defendant was appointed receiver by a Court of New York, it alleges permission given by the Supreme Court of New York to bring the suit. The suit, as made by the complaint, must be re-

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garded as one brought on a statute of New York against the defendant as a New York receiver.

In August, 1879, the defendant put in, in the State Court, an answer to the complaint, alleging that he was duly appointed receiver of the company by the Court of Chancery of New Jersey, in February, 1877; that two days thereafter he was duly appointed by the Supreme Court of New York receiver of the property of the company situated within the State of New York; that such last appointment was in connection with, and ancillary to, his appointment as receiver by the Court of Chancery of New Jersey; and that, pursuant to his appointment as receiver by the Chancellor of New Jersey, he operated said railroad during June, 1879. He admitted the killing of the intestate at South Amboy, New Jersey, and the existence of said next of kin, and the permission of the New York Court to bring "this action," and denied the alleged negligence.

In October, 1879, the defendant, as a citizen of New Jersey, the plaintiffs being citizens of New York, removed the suit into this Court, the State Court making an order of removal. In January, 1882, the suit came on for trial in this Court, before a jury. The Court, at the trial, allowed the plaintiffs to amend their complaint by inserting at the end thereof, immediately before the prayer for relief, an allegation that the statute of New Jersey in force at the time of the death of the intestate provided as follows, (setting it forth, it being a statute giving, in case of the death of a person by neglect, where he would have had an action for damages for injury if he had lived, an action for damages to his personal representatives, for the benefit of his next of kin, no limit to the amount of damages being specified.) At the same time the defendant was allowed to amend his answer by inserting the order of the New York Court granting leave to sue, and alleging that no other leave to sue was ever granted to the plaintiffs. The leave was "to bring an action in this Court against said Francis S. Lathrop, receiver of the Central Railroad of New Jersey, acting as such within the

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jurisdiction of the Court, for the alleged wrongful killing of said decedent through negligence and carelessness." The defendant was also allowed to amend his answer so as to admit permission to bring "an action" instead of "this action." At the trial, the order of leave made by the New York Court, and the order of the New York Court appointing the defendant receiver of the property of the company "situated within the State of New York," "in connection with and ancillary to his receivership" under his New Jersey appointment, and the fact that the company was a New Jersey corporation, and papers showing the receivership under the New Jersey appointment, were put in evidence, (the Court having excluded the plaintiff's offer to prove the facts stated in the complaint,) and the defendant moved the Court to dismiss the complaint on the grounds that, as to the defendant as a New Jersey receiver, the Court had no jurisdiction of the suit, and that, as to the defendant as a New York receiver, the complaint contained no cause of action. The Court decided that the complaint must be dismissed on those grounds, but no order or judgment to that effect has been entered. The plaintiffs now move to remand the cause to the State Court on the ground that it "does not really and substantially involve a dispute or controversy properly within the jurisdiction of this Court." The question as to the propriety of the removal, or as to remanding the cause, was not presented at the trial.

The plaintiffs contend that, as the defendant was sued as a receiver appointed by the New York Court, by its leave, and in it, he must, though personally a citizen of New Jersey, be regarded, for the purposes of the removal, as a citizen of New York; that the leave granted by the New York Court was to sue in that Court its own officer; and that the suit was not brought against the New Jersey officer.

The defendant contends that the citizenship of the parties personally was different and sufficient to warrant the removal; that, the suit being brought against the defendant as a New York receiver, there was jurisdiction as to the subject-

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matter alleged in the complaint and as to the person of the defendant, and there was diversity of citizenship, and the only defect as to the New York receiver was, that there was no cause of action on the facts alleged in the complaint, even if they were proved; that the duty of the Court, under § 5 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 472,) where it has no jurisdiction of the controversy, is "to dismiss the suit or remand it," and it has already decided to dismiss it; and that the motion is too late, because it was made after the plaintiffs submitted to and invoked the jurisdiction of this Court at the trial.

This case must be first considered in reference to its condition when it was brought and when it was removed into this Court. There was then in force a statute of New York, (*Act of December 13th, 1847, chap. 450; Act of April 7th, 1849, chap. 256; Act of March 16th, 1870, chap. 78,*) providing for suits by the personal representatives of a deceased person to recover damages for his death by wrongful neglect, not exceeding \$5,000. The New Jersey Act set up by said amendment was passed March 3d, 1848, immediately after the first New York Act, and in substantially the same words, not being limited to \$5,000, the amount being limited to \$5,000 by the New York Act of 1849. The New York Act does not in terms require that the wrongful neglect or the death should have occurred within the territorial limits of New York. The original complaint is based on the view that, although the occurrence took place in New Jersey, on a railroad there, damages for the death could be recovered in a New York Court by virtue of the New York statute, from the receiver alleged to have caused the death, he being an appointee of the New York Court, and that Court having granted permission to bring the suit. The case as made by the original complaint had no reference to the New Jersey statute or to an appointment of the defendant as receiver by the New Jersey Court, and of course there was no occasion for the plaintiffs then to allege or show any leave by the New Jersey Court to bring the suit. Accordingly, in his answer,

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the defendant set up that he was appointed receiver of the company by the New Jersey Court; that he was afterwards appointed by the New York Court receiver of the property of the company in New York; that the latter appointment was ancillary to the former; that he was operating the road by virtue of his New Jersey appointment; that the intestate was killed at South Amboy, in New Jersey; and that permission to bring this suit was given by the New York Court. The answer demanded judgment for the dismissal of the complaint.

The cause of action thus shown by the original complaint at the time of the removal involved a subject-matter of which this Court could take jurisdiction. There could be no objection to suing the receiver as a New York receiver, because the Court which appointed him had given leave to sue him. No restriction arising out of the words in the order of permission, "acting as such within the jurisdiction of the Court," as applied to the facts set out in the original complaint, seems to have been supposed to exist. None such is set up in the original answer, and there was a general appearance by the receiver, and a general answer, and no allegation of want of jurisdiction, and an admission that the order gave permission to bring "this action." Then the removal petition was presented, based on diversity of citizenship. The record was filed in this Court November 6th, 1879, by the defendant. The plaintiffs never made any motion to remand, but went to trial.

Was the case a removable one, and within the jurisdiction of this Court, as it stood down to the time the pleadings were amended? The order of the New York Court appointing the defendant receiver appoints him receiver of the property of the company in the State of New York, or which shall come within that State, and of such property only. It gives him the usual powers of receivers, restraining him from selling any of said property without the order of the Court, but allowing him to use the same to operate the railroad and the ferry-boats of the company. It then enjoins all persons from

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taking any proceedings against the company, "or its property within the State of New York, or from obtaining any preference over other creditors as against the same." It then orders that the defendant be deemed receiver of said property "in connection with and ancillary to his receivership under and by virtue of any appointment of himself as receiver by the Court of Chancery of the State of New Jersey." The order of leave made by the New York Court gives permission to the plaintiffs "to bring an action in this Court," for the alleged wrongful killing, that is, in the Supreme Court of New York. But afterwards, on the petition for removal, that Court made the order removing the suit into this Court for trial, and declaring that it would proceed no farther therein. That is equivalent to leave to bring and prosecute the suit in this Court, so far as any objection or restriction by the New York Court is concerned. It left open only the question whether this Court could, by reason of the citizenship of the parties, acquire and retain jurisdiction of the suit. The fact that the defendant was appointed a receiver by the New York Court does not deprive this Court of its jurisdiction derived from the fact of his being a citizen of New Jersey while the plaintiffs are citizens of New York, and from the removal proceedings, when the State Court has thus expressly sanctioned the removal to this Court. Therefore, the removal was regular and proper, when it was made.

Adding to the complaint the allegation as to the New Jersey statute and its provisions did not destroy or alter the cause of action already attempted to be set forth in it against the New York receiver, under the New York statute. This is shown by the fact that, in the order amending the complaint, is found the provision amending the answer, by inserting the order of the New York Court granting leave and alleging that no other leave to sue was granted. At most, under the pleadings, the original cause of action was left untouched, and another one was added. At the trial the suit seems, under the amended pleadings, to have been regarded as a suit under both statutes against both receivers. This

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Court having jurisdiction of it as respected the New York receiver and the cause of action alleged against him under the New York statute, and having jurisdiction by the citizenship of the parties and by reason of the subject-matter and by the permission and order of the New York Court, proceeded, as it had a right to do, to adjudicate as to the merits of such cause of action, and decided against the plaintiffs thereon. It then also decided against any cause of action as respected the New Jersey receiver, for want of jurisdiction, which must have meant that the want of jurisdiction was that there was no leave to sue given by the New Jersey Court, the cause of action having arisen in New Jersey. Absence of such leave took away the jurisdiction of this Court as respected the New Jersey receiver. This is fully decided in *Barton v. Barbour*, (104 U. S., 126,) a recent case in the Supreme Court of the United States. But that is not sufficient cause for remanding the suit. It might have been sufficient cause for striking out any cause of action against the New Jersey receiver, and it was sufficient cause for dismissing the complaint as to the New Jersey receiver. The original alleged cause of action against the New York receiver remained, however; and, if the amendment to the complaint were to be considered as only adding an allegation of a cause of action against the New York receiver, founded on the New Jersey statute, the decision that the complaint, as amended, did not state a cause of action against the New York receiver, was a decision on the merits, as respected a cause of action under either statute, in a suit of which, as before shown, the Court had jurisdiction.

The defendant, while an officer of the New York Court, and sued as such, was a citizen of New Jersey. He was a representative as much as an executor or a trustee is. In fact, he was a trustee. The personal citizenship of the executor or trustee is what is regarded. (*Rice v. Houston*, 13 Wallace, 66; *Knapp v. Railroad Co.*, 20 *Id.*, 117, 123.) The New York Court, by the order of removal, based on the New Jersey citizenship, authorized this Court, as against the New

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York Court, to treat the defendant as a citizen of New Jersey, sued for a recovery of \$5,000 and costs. It confided to him the responsibility of defending the suit, and this Court has a right to deal with his personal citizenship, on the question of removal.

It follows, that the motion to remand must be denied.

B. Loewy, for the plaintiffs.

R. W. DeForest, for the defendant.

THE PROVIDENCE AND STONINGTON STEAMSHIP COMPANY

vs.

THE VIRGINIA FIRE AND MARINE INSURANCE COMPANY.

Under the provisions of the Act of the Legislature of New York, passed May 11th, 1865, (*Laws of New York, 1865, chap. 694, p. 1,408,*) a Virginia insurance corporation deposited, in 1873, with the insurance superintendent of New York, certain bonds. In 1879, it withdrew its agency from New York. In 1881, all its risks outstanding in New York were cancelled. Prior to that the bonds had been attached in New York in a suit brought there by a Rhode Island corporation on a policy of insurance, which suit was removed into this Court. The defendant moved to set aside the levy under the attachment: *Held*, that the motion must be granted.

(Before BLATCHFORD, J., Southern District of New York, March 13th, 1882.)

BLATCHFORD, J. The plaintiff is a Rhode Island corporation. The defendant is a Virginia corporation. This suit is brought to recover \$5,000 on a policy of marine insurance, issued by the defendant to the plaintiff, insuring a steamer against marine perils. It was brought in a Court of the State of New York and removed into this Court. On the bringing of the suit, in September, 1880, the State Court issued an attachment against the property of the defendant, as a foreign

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corporation having property within the State of New York, and it was levied on \$10,000 of United States 4 *per cent.* registered bonds, in the hands of the superintendent of the insurance department of the State of New York, at Albany. The said bonds were deposited with the insurance superintendent by the defendant, in February, 1873, under the provisions of the Act of the Legislature of New York, passed May 11th, 1865, (*Laws of New York*, 1865, chap. 694, p. 1,408.) That Act provides, that, "whenever the existing or future laws of any other State of the United States shall require of insurance companies incorporated by or organized under the laws of this State, and having agencies in such other State, or of the agents thereof, any deposit of securities in such State for the protection of policy holders, or otherwise, or any payment for taxes, fines, penalties, certificates of authority, license fees, or otherwise, greater than the amount required for such purposes from similar companies of other States by the then existing laws of this State, then, and in every such case, all companies of such States establishing, or having heretofore established, an agency or agencies in this State, shall be and are hereby required to make the same deposit for a like purpose in the insurance department of this State, and to pay to the superintendent of said department, for taxes, fines, penalties, certificates of authority, license fees, and otherwise, an amount equal to the amount of such charges and payments imposed by the laws of such State upon the companies of this State and the agents thereof." On the 3d of February, 1866, the Legislature of the State of Virginia passed an Act, (*Laws of Virginia*, 1865-6, chap. 96, p. 206,) the 1st section of which, as amended by an Act passed March 25th, 1871, (*Laws of Virginia*, 1870-1, chap. 194, p. 284,) provided that no insurance company not incorporated under the laws of the State of Virginia should carry on its business in that State without first obtaining a license; and that no such company should receive such license until it should have deposited with the Treasurer of the State certain specified securities, and, among them, bonds of the United States, to an

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amount equal to 5 *per cent.* of its capital stock, the deposit of securities to be in no case of less cash value than \$10,000, and not being required to be of greater cash value than \$50,000. The Act of Virginia, of 1866, provides that the bonds are to be held to pay the liabilities of the insurance company, upon its insurance policies made in favor of any citizen or inhabitant of Virginia, and the Treasurer is directed to apply the interest on the bonds, and the proceeds of the sale of them, to the payment of such liabilities. The Act also provides, that, if the company shall cease to carry on business in Virginia, and its liabilities on its insurance policies, whether fixed or contingent, to the citizens and inhabitants of Virginia, shall have been satisfied or shall have terminated, on satisfactory evidence of that fact to the Treasurer, he "shall deliver" to such company the bonds deposited with him by it, or such of them as remain after paying its liabilities above specified, or, if the company shall reduce the amount of its liabilities, both fixed and contingent, upon its policies of insurance to the citizens and inhabitants of Virginia, below the amount of the bonds in the possession of the Treasurer, he "may deliver" to such company a part of the bonds deposited by it with him, but so that the bonds in his possession shall always be equal to its liabilities upon the insurance policies to citizens and inhabitants of Virginia.

On the 31st of August, 1879, the defendant withdrew its agency from the State of New York. It had outstanding policies of insurance against fire issued to residents and inhabitants of New York, to an amount exceeding \$10,000, from that date until February 15th, 1881, on which day it cancelled all its risks outstanding in New York, and called its policies in. It then applied to the insurance superintendent for the said bonds, but he refused to deliver them because of said attachment. The bonds were so deposited solely to conform to the requirements of the said statute of New York.

The defendant, having appeared and answered, removed the suit into this Court, and now moves to set aside the levy under the attachment. The motion is made with the concur-

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rence of the insurance superintendent. It is plain that the defendant deposited the bonds, under the said statute of New York, because the Act of Virginia required from a New York insurance company a deposit of securities, for the protection of policy holders, which the statutes of New York did not otherwise require from a Virginia insurance company. Prior to the Act of 1865, of New York, there was no law of New York requiring any deposit from a fire or marine insurance company of another State of the United States, nor has there been any since, except what is required under the provisions of the Act of 1865. The deposit required by § 23 of the New York Act of June 25th, 1853, (*Laws of New York*, 1853, *chap.* 466,) is required only from fire insurance companies incorporated or organized under a foreign government, as distinguished from another State of the United States. The enactment by Virginia, of its Acts of 1866 and 1871, brought into operation on the defendant the New York Act of 1865. But the deposit made under that Act of 1865 is made "for a like purpose" with the purpose for which a deposit is made in Virginia, under the Virginia Acts of 1866 and 1871, and for no other or further purpose. That purpose is the purpose of paying the liabilities of the depositing company on its insurance policies to citizens and inhabitants of the State where the deposit is made. When such company ceases to carry on business in such State, and those liabilities no longer exist, the depositing company is entitled to receive back the bonds deposited. They were not deposited for the protection of the plaintiff in this case, nor can they be held, under the said statutes of New York, for its protection, by the insurance superintendent, or applied by him to any liability of the defendant to the plaintiff, aside from any force there may be in the levy under the attachment.

The question is, whether the bonds were subject to such levy, in the hands of the insurance superintendent. The plaintiff contends that the bonds are property of the defendant in this State, and subject to the levy, particularly as they are no longer held for the protection of any citizens, residents

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or inhabitants of this State, holding policies issued by the defendant.

The insurance superintendent is a public officer of the State, created by statute, and charged with the execution of the laws in relation to insurance. No case of acknowledged authority is found which holds that a public officer of a State, charged with a trust, created by a public statute of the State, in respect to funds or securities in his possession, can be made liable in respect to them, by an attachment in favor of a person not claiming under the trust. Decisions in analogous cases, as to persons holding property or funds by authority of a statute or of the law, under a trust imposed in regard to them, are numerous. (*Brooks v. Cook*, 8 *Mass.*, 247; *Colby v. Coates*, 6 *Cush.*, 558; *Columbia Book Co. v. DeGolyer*, 115 *Mass.*, 67, 69; *Harris v. Dennie*, 3 *Peters*, 292; *Buchanan v. Alexander*, 4 *Howard*, 10.) The principle was applied by the Court of Appeals of Virginia, in *Rollo v. Andes Ins. Co.*, (23 *Grattan*, 509,) to a case like the present. The Treasurer of Virginia, under the Virginia Acts of 1866 and 1871, held bonds deposited with him by an Ohio insurance company. It ceased to do business in Virginia, and its liabilities, fixed and contingent, to citizens or residents of Virginia, were satisfied. This occurred about a month after an attachment in a suit brought in Virginia, against the Ohio company, by a citizen of Illinois, had been levied on the bonds in the hands of the Treasurer. The Ohio company and the Treasurer moved to abate the attachment, (1,) because the State, and its officers and agents, were not subject to attachment process; and (2,) because the property of the Ohio company in the State treasury was not liable to attachment at the suit of a non-resident of Virginia, but was held in trust there for the benefit of the Virginia creditors of the company, and, as to any residue after the satisfaction of those claims, in trust to be returned to the company. The Court held unanimously that the Treasurer of the State, having the control and custody of insurance funds and securities under an Act of the Legislature, was not subject to the proceeding by attachment, even

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though the foreign company had satisfied all its liabilities in the State. The Court said: "It is a question that concerns the State. It is certainly not compatible with her sovereignty and dignity to be arraigned before her own tribunals, at the suit of individuals, in any other mode than is prescribed by her statutes. Nor is it consistent with her interests, or the proper administration of public affairs, that her officers shall be arrested in their public duties, and required to answer before the Courts for funds or securities committed to their custody for a specific purpose, under authority of a public law. * * * The Treasurer is required by the statute to retain the securities in the treasury for the special objects contemplated by the Act, until the liabilities of the company are settled or terminated. So long as anything remains to be done, so long as these liabilities continue, he is expressly prohibited from disposing of or surrendering them. And when the Treasurer is satisfied these securities or funds are no longer required to meet any liabilities of the company in the State, he is authorized and required to deliver them to the company. This is the extent of his authority. His power and duty are fixed by the law. Now, whether this does or does not constitute a contract on the part of the State with the insurance company, it is the law for the Treasurer, fixing the measure of his authority and his responsibility. He holds the securities in trust, to be administered, first for the people of Virginia, and then for the company making the deposit. This is the destination given them by the law, controlling not only the Treasurer but the Courts also; and it would seem there is no power, except that of the Legislature, to change such destination. * * * In returning the securities to the company depositing them, the State complies with her engagement, as expressed through her statutes. The foreign creditors have no just cause of complaint. As to them the securities are in the same condition they occupied before the deposit was made." These views are sound and nothing can be added to their force. The statute of New York is to be regarded as if it were in the same words as the Virginia stat-

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ute, in respect to the purpose and terms and conditions of the deposit. Under such a statute the funds are not liable to attachment at the suit of a person not claiming under a policy issued to a citizen or inhabitant of New York.

The motion to set aside the levy on the securities in the hands of the insurance superintendent is granted.

Wilhelmus Mynderse, for the motion.

Wheeler H. Peckham, opposed.

JOHN C. ROSE

vs.

THE STEPHENS AND CONDIT TRANSPORTATION COMPANY.

Negligence may be inferred from the fact of the explosion of a steam-boiler on a vessel, even where the defendant is under no contract obligation to the plaintiff.

(Before WALLACE, J., Southern District of New York, March 13th, 1882.)

WALLACE, J. The plaintiff was injured by the explosion of a steam-boiler which was being used by the defendant to propel a vessel chartered by the defendant to others to be used for the transportation of passengers and freight. If the explosion resulted either from the carelessness of the employees of the defendant in charge of the boiler, or from the negligence of the defendant in sending forth an unsafe and dangerous boiler to be used where human life would be endangered if the boiler should explode, it is conceded the defendant was liable. It is contended, however, that it was error to instruct the jury that they might infer such negligence from the fact of the explosion, and it is argued that such a presumption only obtains when the defendant is under a contract obliga-

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tion to the plaintiff, as in the case of a common carrier or bailee. Undoubtedly, the presumption has been more frequently applied in cases against carriers of passengers than in other cases of negligence, but there is no foundation in authority or in reason for any such limitation of the rule of evidence. The presumption originates from the nature of the act, not from the nature of the relations between the parties. It is indulged as a legitimate inference whenever the occurrence is such as in the ordinary course of things does not take place when proper care is exercised, and is one for which the defendant is responsible. It will be sufficient to cite two cases in illustration of the rule, without referring to other authorities. In *Scott v. The London & St. Katherine Docks Co.*, (3 *Hurlstone & Coltman*, 596,) the plaintiff, as he was passing by a warehouse of the defendant, was injured by bags of sugar falling from a crane in which they were being lowered to the ground. The Court said there must be reasonable evidence of negligence, but, where the thing is shown to be under the management of the defendant or his servants, and the accident is such as, in the ordinary course of things, does not happen if those who have the management use proper care, it affords reasonable evidence, in the absence of explanation by the defendant, that the accident arose from want of care. This case is cited with approbation in *Transportation Co. v. Downer*, (11 *Wall.*, 129.) In *Mullen v. St. John*, (57 *N. Y.*, 567,) the plaintiff, who was upon a street sidewalk, was injured by the fall of an unoccupied building owned by the defendant, and it was held that, from the happening of such an accident, in the absence of explanatory circumstances, negligence should be presumed, and the burden cast upon the owner to disprove it.

In the present case, the boiler which exploded was in the control of the employees of the defendant. As boilers do not usually explode when they are in a safe condition and are properly managed, the inference that this boiler was not in a safe condition, or was not properly managed, was justifiable, and the instructions to the jury were correct.

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The other questions which are presented upon the motion are not sufficiently serious to deserve extended comment. The instructions to the jury must be considered in their integrity and not in isolated parts, and, so considered, present the law of the case fairly and correctly. The evidence amply justified the jury in the conclusion that the defendant had not made such an examination of the boiler as prudence required, preparatory to its employment for the season of 1878, and which, if made, would have revealed the defect.

The verdict undoubtedly awarded the plaintiff liberal damages for the injuries he sustained, but it is very difficult to measure the compensation which a party should receive for such acute suffering as the plaintiff experienced. Certainly, the verdict is not so obviously extravagant as to indicate prejudice or partiality.

The motion for a new trial is denied.

Chauncey Shaffer, for the plaintiff.

Butler, Stillman & Hubbard, for the defendant.

JAMES S. SIMPSON AND GEORGE F. SIMPSON

vs.

WILLIAM H. DAVIS. IN EQUITY.

The 5th claim of design letters patent, No. 12,026, granted to Henry Textor, November 9th, 1860, for a design for newel posts, namely, "A design for the upper portion of a newel post, consisting of the scrolled ornaments, *l*, and the bead, *m*, the roses or rosettes, *n*, upon each side, as specified," is not a claim to a single ornament, within § 4,929 of the Revised Statutes.

It would seem that the design for the cap of a newel post is a design for a manufacture, within said statute.

A newel post of a certain shape, having ornaments and a cap, is an article of manufacture, within said statute.

(Before BENEDICT, J., Eastern District of New York, March 18th, 1882.)

BENEDICT, J. This action is brought upon a patent owned by the plaintiffs, which, it is alleged, has been infringed by the defendant. The patent is for design No. 12,026, and was issued November 9th, 1880, to Henry Textor. The specification states that Henry Textor is the originator and producer of a new and improved design for newel posts, the character of which is illustrated by a drawing accompanied by a description. There are 11 claims. Only the fifth, the sixth, and the eleventh are relied on here. It is not disputed that the defendant is engaged in manufacturing newel posts similar in ornament, shape, and configuration to the newel posts described in the plaintiffs' patent. The similarity is so great that a photograph of the plaintiffs' newel post is admitted to correctly represent the newel post made by the defendant. No question in regard to the infringement is, therefore, raised, but it is contended that the patent is void for want of novelty as well as of patentability in the subject-matter.

The fifth claim of the patent is for "a design for the upper portion of a newel post, consisting of the scrolled ornaments, *l*, and the bead, *m*, the roses or rosettes, *n*, upon each side, as specified." The statute (*Rev. Stat., section 4,929*,) authorizes a patent for any new and original ornament to be cast or otherwise placed on any article of manufacture. The subject-matter of the claim under consideration is for an ornament, not for a newel post or a part of a newel post having a new or original shape or configuration, but for an ornament intended to be placed upon a newel post. The claim does not seek to secure the scroll by itself, nor the bead by itself, nor the roses by themselves. Each of these is an ornament, but neither of them is new. The claim, therefore, seeks to cover these forms associated together in the manner described, as composing a single ornament. In the matter of ornamentation, mere juxtaposition of old forms is, doubtless, sufficient to authorize a patent for an ornament, when, by means of such juxtaposition, accomplished by industry, genius, effort and expense, the old forms are made to become component parts of an ornament substantially new in its effect. But, the

result of the industry, genius, effort and expense employed must, as I suppose, be a single ornament, which, taken as a whole, can be considered to be the embodiment of a new idea in ornamentation. The amount of the novelty may be small, but the effect of the ornament must, to some extent, at least, be new. The ornament may, in this sense, be new and original, although all the forms used in its composition are old and well known forms of ornamentation.

The claim under consideration is, therefore, not defeated when it is shown that scrolls similar in effect to the scroll described in the claim, and that beads and roses such as those described, have often before been employed in the ornamentation of newel posts. The difficulty with the claim does not arise from want of novelty in the forms employed, nor yet in the want of novelty in the method of arranging these forms, because, simple as the arrangement is, the case furnishes no evidence that a scroll and roses were ever before arranged one above another, with only a bead between. But I find it difficult to consider that the scroll, roses, and bead, when arranged as described in the claim, constitute a single ornament. There is no commingling of the lines forming the scroll, the bead, and the roses; no new idea seems to be embodied in the method of their arrangement. All that has been done is to place these distinct and well known ornaments one above the other, without the production of any such combined effect as to entitle the whole to be treated as a new and original ornament. No new ornament has in fact been produced. If, therefore, the plaintiffs' action rested upon the fifth claim of his patent alone, I should hesitate to uphold it.

The sixth claim is for "a design for the cap of a newel post, consisting of the gable-like projection, *e*, having rounded or curved outlines, the recessed or sunken scrolled ornaments, *s*, the foliated moulding, *t*, and the fillet, *u*, as specified." The statute authorizes a patent for "any new and original design for a manufacture;" and this claim is intended to cover such a design. The first question presented by this claim is, whether the cap of a newel post is a manufacture,

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within the meaning of the statute. The testimony shows that the cap of a newel post is a distinct article, often manufactured by itself, but never used except in connection with other parts, which, taken together, go to make up what is known as a newel post. Upon this testimony, I incline to the opinion that the article described in the sixth claim, namely, a cap of a newel post, may be held to be a manufacture; but whether this be so or not seems of no importance in view of the seventh claim of the patent, which is for the whole newel post, including the cap. The statute permits a patent for any new, useful and original shape or configuration of any article of manufacture. The seventh claim describes an article of manufacture, namely, a newel post of a certain shape or configuration, and having, among other distinctive features, the ornaments described in the fifth claim, and the cap described in the sixth claim.

Against this claim the only defence made is that the distinctive features of the newel post described were to be found in other newel posts prior to the date of the plaintiffs' invention, and many of them, in fact, copied by the inventor himself from newel posts erected in New York. But here the difficulty with the defence is, that there is no evidence that any newel post substantially similar in shape and configuration to the one described in the plaintiffs' patent had ever before been designed. The arrangement of ornament and shape presented by the plaintiffs' post is new, useful and original. The several experts testify that the newel post described in the patent would not be considered, either by the trade or by those wishing to buy such articles, to be similar to any of the other newel posts put in evidence; and the proof is, that, as between the plaintiffs' newel post and the one most similar to it of all those put in evidence, the demand has been twenty to one in favor of the plaintiffs' post. Moreover, the defendant has thought it worth the while to copy the plaintiffs' post exactly.

I am, therefore, of the opinion that the seventh claim of the plaintiffs' patent can be upheld, and that the patent se-

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cures to the plaintiffs the exclusive right to make newel posts such as are in said claim described. The fact being undisputed that the defendant has made newel posts similar to the post described in the seventh claim, it follows that the plaintiffs are entitled to an injunction as prayed for, and also to an accounting.

Edwin H. Brown, for the plaintiffs.

N. H. Clement, for the defendant.

WILLIAM ANTHONY SHAW

vs.

THE COLWELL LEAD COMPANY. IN EQUITY.

The second claim of re-issued letters patent, No. 3,744, granted to Peter Naylor, assignee of William Anthony Shaw, November 23d, 1869, for an improvement in the manufacture of tin-lined lead pipe, the original patent, No. 74,618, having been granted to said Shaw, February 18th, 1868, antedated February 6th, 1868, is valid.

The invention defined.

The questions of novelty and infringement considered.

Public use for two years before the application for the re-issue of a patent does not affect its validity.

It is sufficient for an invention to be useful in itself to be patentable, and it is not necessary it should be better than what was before known.

The right to recover for infringements of a patent is assignable.

The question of a verbal license to the defendant to use the patented invention, considered.

(Before WHEELER, J., Southern District of New York, March 18th, 1882.)

WHEELER, J. This suit is brought for relief against infringement of letters patent, re-issue No. 3,744, dated November 23d, 1869, for an improvement in the manufacture of

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tin-lined lead pipe. The bill alleges the grant of the original letters, No. 74,613, dated February 18th, antedated February 6th, 1868, to the orator; the assignment of them by the orator to Peter Naylor, upon terms that he should pay the expenses of a re-issue, prosecute infringers, and pay one-half the net profits to the orator; the re-issue to Naylor, assignee of the orator; infringement by the defendant ever since the grant of the re-issue; and the reconveyance of the patent and assignment of all rights of action for infringement, on the 17th of September, 1877, before the bringing of the bill. The answer sets up that the invention had been previously patented in England to George Alderson, in English letters patent, No. 2,749, on the 25th of February, 1804, and to the orator and Gardiner Willard, in letters patent of the United States, No. 41,401, dated January 26th, 1864; that the invention was in public use and on sale for more than two years prior to the application for the re-issued patent, with the knowledge, consent and allowance of the orator; that the orator, during the years 1866, 1867 and 1868, was the treasurer of the defendant, and allowed the defendant to use the invention; and, by a general denial of so much of the bill as is not otherwise answered, denies infringement. These are the only questions made by the answer that are continued in the evidence, or insisted upon in argument; there are others raised by the evidence and insisted upon.

As lead pipe is made by forcing a short and very thick-walled piece through dies, when softened by heat, and thereby making it into a much longer piece of the same sized bore and of the required thickness of wall, so tin-lined lead pipe is made by forcing a like short piece, composed of tin next to the bore and lead outside, through similar dies, when softened by heat, thereby making a much longer piece of pipe with the inside of tin and the outside of lead. The great difficulty in making it successfully lay in so shaping and proportioning the parts of tin and lead in the short piece, that, when forced through the dies, the inside would be of tin and the outside of lead, each of proper uniformity and thickness. This inven-

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tion was not of tin-lined lead pipe, for the patent assumed that to be before known, nor of machinery for making such pipe, nor of arranging tin within lead for the purpose of being so forced through dies, for these were either mentioned or described in the patent and not claimed. The bodies of the tin and lead, when arranged in the short piece, ready to be forced through, are called ingots, and the whole a charge, in the trade. The specification of the patent set forth a central ingot of tin, of the outward form of an inverted double frustum of a cone, the upper frustum containing a little more metal, and being a little shorter and more tapering than the lower one, encircled by an intermediate lead ingot of the outward form of an inverted frustum of a cone, having a deep circular cavity, marked D, in the upper end of the ingot, and an outer ingot of lead, of the outward form of a cylinder, encircling the other; and described making the lead ingots first, and casting the tin ingot in the intermediate lead one, which, as the tin would melt at lower temperature than the lead, would permit so casting them together without alloying the tin with the lead. There were four claims in the original patent: 1. Making the charge of metal in three distinct parts, as described, and uniting them either before or after they are put in the cylinder. 2. Making the central ingot or charge of tin in the form of a double frustum of a cone, or its equivalent, for the purpose of securing a uniform thickness of tin in the lead tube or pipe. 3. Making the intermediate lead or alloy ingot in the form of a frustum of a cone, substantially as described. 4. Making the cavities, D, in the upper end of the charge, for the purpose specified.

There are likewise four claims in the re-issue: 1. The manufacture of lead-encased tin pipe from ingots, or a charge of metal made substantially as herein described, of three parts, whether the same be united before or after they are put in the cylinder. 2. The manufacture of lead-encased tin pipe from a compound ingot, composed of concentric parts of lead and tin, when the central ingot is made of tin, in the form of superposed inverted frusta of cones, or their equiv-

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alent. 3. In the manufacture of the compound ingot for lead-encased tin pipe, the employment of an intermediate cone or cones, whereby a large portion of the lead ingot may be cast without contact with the tin, thus reducing the alloying of the two metals. 4. In the manufacture of the compound ingot as herein described, the formation of the tin ingot of superposed inverted frusta of cones, the upper one being of larger diameter but proportionately shorter than the other.

No question was made but that the re-issued patent is properly supported by the original. The infringement claimed is described by the orator himself in answer to cross-question 236, and consists in making a lead ingot in the form on the inside of the outside of superposed inverted frusta of cones, and placing accurately in the centre a pipe of tin, of the same height, and filling the space between them with melted tin, making a central ingot of tin of the outward form of superposed inverted frusta of cones, encircled by an ingot of lead of the outward form of a cylinder. There is no charge of metal in three parts, as described in the first claim, nor of intermediate cones, or ingots, as described in the third claim, of each patent; nor of cavities D, as described in the fourth claim of the original; nor of an upper frustum of a cone of larger diameter but proportionately shorter than a lower one, as described in the fourth claim of the re-issued patent. There is nothing but the central tin ingot in the form of superposed inverted frusta of cones, described in the second claim of each.

The patent of Alderson describes a charge of metal for drawing into tin-lined lead pipe, composed of a central ingot of tin cast into a hollow cylinder of lead, making the tin ingot cylindrical in outward form, and anticipates nothing in the claims of either patent, and nothing described in either, to be referred to by the claims, except the casting the tin into the lead, which may prevent alloying, as mentioned. The patent of Shaw and Willard, set up in the answer, is for a tin ingot tapering at the lower end, and enlarging at the upper, either cast into a lead ingot shaped to receive it, or with a

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lead ingot cast about it. This latter patent and the patent in suit might infringe upon Alderson's patent if that was in force; but these are for forms of ingots different from his, and are only for these improvements in form, and are not anticipated as such by the form in his. And for the same reason the Shaw and Willard patent does not anticipate this. That is for one form of ingot and this for another; and, as such, each stands independent of the other. The second claim is for the manufacture of lead-encased tin pipe from such ingot. If this means the manufactured article as a product, both these patents would anticipate this, in description, for they both describe such pipe; and, in fact, this would anticipate itself, and on its face would claim nothing patentable, for it mentions and describes the making of such pipe before. But the word is not understood, and, in argument, is not claimed, to have been used in that sense. It is understood to have been used as a verbal noun, signifying the making such pipe from such ingots, as set forth in the corresponding claim in the original patent. Such construction seems warrantable by the authorities. (*Curtis on Patents*, §§ 76, 77.)

The point against the validity of the patent on account of public use for two years before the date of the re-issue seems to rest upon the supposition that the statutes making such use a defence to a patent apply to the patent in suit, and to the application for that, whether it be an original patent or a re-issued patent. No case is cited in support of the proposition, nor has any to the contrary been cited or noticed; but there are a great many in which patents have been upheld that could not have been if this would be a defence, and it had been made. The language of the statutes is opposed to such construction. In section 15 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 123), this defence, as provided, is the being in public use or on sale with the consent and allowance of the patentee before his application for a patent. Section 7 of the Act of March 3d, 1839, (5 *U. S. Stat. at Large*, 354,) limits this defence to cases of such sale or prior use for more than two years prior to such application for a

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patent. The same expression is continued in Revised Statutes, section 4,886, providing for granting patents, and section 4,920, providing for this defence to a patent. And further, the re-issued patent is not a new patent, but is only an amended form of an old one, and the application for the re-issue is not an application for a patent, but is an application for an amendment of one; and that cannot be such an application as is referred to as being necessary to be made before two years of public use shall have been had.

There is a question made in the evidence, and insisted upon in the argument, as to whether this form of ingot is any better, or makes any better pipe, than prior forms, and whether, if it does not, there is any utility to support the patent. The statutes do not require inventions to be superior to, or better than, all other things known, to be patentable. It is sufficient if they are useful in themselves, if they are also new. There is no question, upon the evidence, but that this form of ingots is useful in the manufacture of this kind of pipe, nor but that the defendant uses it. If there is another form equally useful, or better, open to use by the defendant, that could be taken, but the right to use that would not defeat the patent for this.

None of the reasons set up or urged against the validity of the patent seem to be sufficient to defeat it. It is insisted, however, that, if the patent is valid, the use of the invention by the defendant has, upon the ground stated in the answer, as well as others, been so permissive that the defendant is not liable to the orator for it. It is expressly admitted, on the record, on behalf of the defendant, that the orator is the owner of the patent and of "all the rights which the said Peter Naylor acquired thereunder, and that he became such owner at the time and in the manner alleged in the bill." The right to recover for infringement of a patent, like other choses in action, is assignable in equity, and the real owner of the right is entitled to maintain a suit upon it, in equity, in his own name. Upon the allegations in the bill, and the concession, the orator is the owner of the right to recover

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for infringements which accrued to Naylor, as well as for any which has accrued to himself since he became re-entitled to the patent itself. Naylor had no right of recovery for anything prior to the date of the re-issued patent, November 23d, 1869. The permission or estoppel set up in the answer covers only the years 1866, 1867, 1868, and, therefore, can be no answer to the claim for infringement now in controversy, even if any permission from the orator, alone, would be any answer to a claim for infringement against the rights of Naylor acquired from him by the orator.

The evidence shows that the defendant brought suit, in a State Court of New York, against the orator, and that the orator set up, as a defence to that action, by way of counter-claim, that, in the year 1868, he was the owner of the patent, and gave the defendant the right to use the invention, for which the defendant agreed to pay him what it was reasonably worth; that the defendant had used the invention; that the use was worth a large sum of money; and that he had a right to collect the gains and profits. And, in this present case, the orator had testified, in answer to the first interrogatory, that he allowed the defendant to use the invention upon the understanding and agreement of the president and secretary that the company would compensate him for the use. These statements are relied upon and urged as establishing such permissive use. The position of the orator, so taken, if unchallenged by the defendant, might be a good bar to the maintenance of this suit for infringement. But the defendant does not set this up as a defence, nor accept it as being the true situation. The validity of the patent is denied in the answer, and all such recognition of its validity is denied in the evidence, in effect. The denial of the validity of the patent leaves the orator his standing in this Court; and a defence to the infringement must be set up, and made out, to defeat his right of recovery. No license is set up. If one according to these statements was set up, the statements would be evidence only, and not conclusive, and it would not be safe to say now how such an issue would be found, if

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properly made. These statements refer to time when the orator himself held the patent, and before the conveyance to Naylor. If such permission was given it might amount to a mere revocable license, of which the conveyance of the patent would be a revocation. No license at all from Naylor is mentioned, and a mere license from the orator would not operate against the rights of Naylor, unless by way of estoppel against these rights in the orator's hands. No foundation for such an estoppel is laid. It does not appear, so far as has been alluded to by counsel, or observed, but the defendant knew of the conveyance to Naylor, and knew that the use of the invention was an infringement of Naylor's rights. The orator had ceased to be an officer of, and to be immediately connected with, the defendant company, and it is not claimed that when he left he undertook to agree that the use of the invention patented in this patent might be retained. The evidence also shows that, July 23d, 1867, the defendant entered into an agreement with Tatham, Brothers, a firm, for license to them to use several patents owned by the defendant relating to tin-lined lead pipe, and its manufacture, upon certain considerations and royalties. The contract was in writing, executed by the defendant and by that firm, and contained a clause, seventh, providing that the agreement should "remain in force during the continuance of the said patents, and any improvement in the manufacture of the pipe made by either" should "be for the mutual benefit of both of the parties to this agreement." The orator was an officer of the defendant at the time, and it is argued that thereby he became a party to the agreement and bound himself to not only give to Tatham, Brothers, but to the defendant, any improvement he might make in that manufacture. The defendant was a corporation, distinct in legal identity from its officers, and that, not they, was the contracting party on one side of that agreement. The clause seems to refer to two parties only, one on each side, the firm on one side and the corporation on the other, and it does not

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seem capable of including any others within its scope or operation.

The defendant also insists that it made large outlays upon experiments to ascertain the best form of ingot for these purposes, and that these outlays covered materials for making this form of ingot, and that the orator knew of these experiments and expenditures, and did not object to them, and that now he ought not, in justice, to be heard to claim that the use by the defendant of this form of ingot was an infringement upon any one's rights. The defendant does not go so far in this direction as to set up that this invention was known to and used by others in the employ of the defendant prior to the orator's discovery of it, so as to defeat the patent; nor as to show that the expenditures were made in completing this invention, or in developing it, on the faith of any representation by the orator that the defendant should have the use of it. The outlays were made in experiments upon various other forms of ingots; the orator invented this form, and patented it, without objection by the defendant or any of its officers, and no expenditure about it is shown other than the making such implements as were necessary to use it. The defendant may have understood that the use made of the invention while the orator was treasurer of the company was permitted on account of that relation, and not wrongful, but that does not cover the claim of infringement involved in this case. The relation ceased, the patent was transferred to Naylor and re-issued, and nothing was done by the defendant to retain or obtain the right to use this invention. The orator obtained other patents alone, and as joint inventor, and the defendant carefully obtained the title to them; but it appears to have taken no steps to do the same with this. The defendant may have been misled into supposing it would have the right to use the invention, notwithstanding the patent, but, if so, it was without the fault of the orator, so far as is pointed out. Counsel have not called attention to the testimony of any witness, and the testimony of none has been noticed, showing that the orator has at any time said anything

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to the officers or agents of the defendant to give them to understand that he should not insist upon his patent.

Let a decree be entered that the orator is the owner of the patent; that the second claim is valid; that the defendant has infringed that claim; and for an injunction and an account, with costs.

Amos Broadnaw, for the plaintiff.

Ten Eyck & Remington, for the defendant.

ANSON SEARLS

vs.

CHARLES C. BOUTON AND OTHERS. IN EQUITY.

The second claim of re-issued letters patent No. 9,297, granted to Anson Searls, July 13th, 1880, for an improvement in whip sockets, the original, No. 150,195, having been granted April 28th, 1874, and letters patent No. 231,510, granted August 24th, 1880, to Anson Searls, assignee of John M. Underwood, for an improvement in whip sockets, are valid.

The question of the difference between the re-issue and the original patent cannot be considered unless the original is put in evidence.

The answer alleged prior knowledge by persons named, but not prior use, and alleged that said persons were "of" a place named, but did not allege knowledge there or at any other place. Although knowledge at the place named was proved, the proof was objected to because the defence was not alleged in the terms provided by statute, and it was held that the defence could not prevail.

The question of a license considered.

(Before WHEELER, J., Southern District of New York, March 18th, 1882.)

WHEELER, J. This suit is brought upon re-issued letters patent, No. 9,297, granted July 13th, 1880, to the orator, for an improvement in whip sockets, the original, No. 150,195, having been granted April 28th, 1874; and upon original letters patent, No. 231,510, granted August 24th, 1880, to

the orator, as assignee of John M. Underwood, also for an improvement in whip sockets. The defences set up in the answer, are, to the former, that it was not properly re-issued for the same invention described in the original; that the invention had been previously patented in several prior patents in this country; that the invention was previously "well known" to, among others, Charles A. Flesche, John Perpente and E. E. Stevens, without saying that it had been used by any person; and that defendants have not infringed; and to the latter the defence is want of novelty.

Although this objection to the re-issue is set up in the answer, the original patent is not put in evidence at all; and there is nothing properly before the Court by which to determine whether the original and the re-issue are for the same invention or not. As the re-issue was granted by the proper officer the presumption is that it was properly granted; and there is nothing in the case to overcome that presumption. The patent is for a centrally perforated rubber disk fitting loosely into an inner groove near the top of a whip socket, to steady the whip, and retained there by its expansive force keeping its outer edge within the walls of the groove, and permitting the insertion and withdrawal of the whip by its elasticity. The evidence shows that such disks had been for some time known and used for this purpose by being placed in the whip socket near the top, and being clamped or held there by the outer edge placed firmly between the body and top of the socket, or between a shoulder in the socket and a closely fitting ring, and by other similar arrangements for holding the outer edge tightly. These were patented in the prior patents set up in the answer. In the use of disks so fastened, the insertion and withdrawal of the whip would bend the inner part up and down, and cause it to break from the outer part at the edge of where it was firmly held. The invention of the orator obviated this breaking largely, by allowing the outer edge of the disk to roll in the groove with the movement up and down of the interior. This kind of disk was not described in any of the prior patents. It could be used in a socket formed in one piece in that

part; and the patent describes making its outer edge of harder rubber than its inner edge, to make it more secure in its place, and still permit the insertion and withdrawal of the whip. There are three claims: the first is of a whip socket formed there in one piece, with a groove, and such a disk inserted in it; the second is for the combination of such a disk so held in place with a whip socket; and the third is for such a combination with a disk having its outer edge of harder rubber. The second claim seems to cover the whole that the patent can be construed to cover. The whip socket without the loosely fitting disk in the groove would not be new; and such a fitting disk in a whip socket would include one with a harder edge. This combination is not shown in any of the patents. The patents are all for comparatively small differences; and this difference is small, but it exists, and is large enough to be patented.

The allegation in the answer as to knowledge, without an allegation of use, seems to have been made intentionally, in view of the evidence to support it, rather than inadvertently. The proof, at most, shows that but two sockets were made showing this invention, and that these were laid away with other specimens, without the rubber disks being in the grooves. Flesche, who made them, afterwards took a patent, which is one of those set up as anticipations, without this feature, and no use of them otherwise is shown. One of them, defendants' exhibit L, is in evidence, with a rubber disk, made since, in the groove. As so put together, this exhibit does seem to show all the elements of this patent, as construed. The evidence was seasonably objected to for the reason of the lack in the answer, and the question is whether such an answer supported by proof will defeat a patent. The section of the statute relating to the granting of patents provides that they may be granted if the invention was not "known or used" by others; as if either knowledge or use would prevent. (*Rev. Stat.*, sec. 4,886.) The section relating to defences and the mode of making them (§ 4,920) provides for notice stating not only the names and residences of

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the persons alleged to have had prior knowledge of the invention, but adds, "and where and by whom it had been used." In *Gayler v. Wilder*, (10 How., 477,) it was held, that these statutes were to be construed together, and with others on the same subject, and that prior knowledge of an invention not accessible to the public would not defeat a patent. The knowledge might be acquired in a foreign country and the invention not be patented or described in a printed publication there, and such knowledge would not prevent or defeat a patent by another in this country. The answer alleges knowledge by persons of New Haven, Connecticut, but not knowledge at New Haven, or any other place. The proof goes beyond this, and shows such knowledge as there was to have been at New Haven; but, affirmative defences, and especially this defence, as provided and regulated by the statute, must be alleged as well as proved, and proof objected to for want of allegation will not help out the defence. (*Roemer v. Simon*, 95 U. S., 214.) This defence cannot prevail, as made.

The defence of non-infringement rests upon a license granted by the orator to John O. Merriam and Edwin Chamberlain, "to manufacture," "at their shop in Troy, N. Y., and no other place or places." This appears to be a personal license, not transferable; and a license to make only. Merriam and Chamberlain had a shop in Troy and constituted a firm. Merriam appears to have sold out to a new firm composed of Edwin Chamberlain and Perry D. Randall. Edwin Chamberlain has since died, and Edward Chamberlain has succeeded him in the firm of Chamberlain & Randall. Merriam appears to have ordered materials, or to have permitted Chamberlain & Randall to order them in his name, for use in making whip sockets at that shop, but he does not appear to have been engaged himself in the manufacture. Sockets made under and pursuant to the license would be free to the trade, but sockets merely dealt in by the licensees would not thereby be made free. The defendants have not made it clear that the sockets they have sold, which would otherwise be an infringement, were made under and pursuant to the license.

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Therefore, they must be adjudged to have infringed; the extent of the infringement, unlawfully done, must of course go to the master for determination.

There was some difficulty in having these rubber disks thick enough to well retain their places in the sockets, and at the same time yielding enough to permit ready insertion and withdrawal of different sized whips. Underwood invented cutting away portions of the disk at intervals, around, between the outer edge and the perforation, making them more yielding in the interior, whereby this difficulty was, in some measure at least, overcome. His patent is for this improvement. The evidence of anticipating devices shows nothing like this.

As the case is made up and presented, the patents must be adjudged valid, and to be infringed.

Let a decree be entered for the orator, for an injunction and an account, according to the prayer of the bill, with costs.

J. P. Fitch, for the plaintiff.

N. Davenport, for the defendants.

RICHARD M. HOE AND STEPHEN D. TUCKER

vs.

CONRAD KAHLER. IN EQUITY.

Claims 3 and 4 of letters patent No. 131,217, granted to Richard M. Hoe and Stephen D. Tucker, September 10th, 1872, for an "improvement in printing presses," namely, "3. Separating two following sheets of papers, in their travel to the fly frame, into two different paths, by an arrangement of tapes and switches, and making the travel of one sheet suitably longer than the other, so that, when they meet again, they will issue one upon the other to the fly, substantially in the manner described and specified. 4. The employment and use of the adjusting roller 59, for regulating the travel of the first sheet, con-

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structed and operating substantially in the manner described and specified," are valid.

Claim 3 is for an arrangement of tapes and switches, which separates two following sheets of the printed papers, in their travel to the fly-frame, into two different paths, the travel of one of the two sheets in its path being suitably longer than the travel of the other of the two sheets in its path, so that, when the two sheets meet again, they will issue one accurately superimposed upon the other, to the fly.

The defendant's apparatus had no fly-frames, the sheets in it issuing in pairs to a folding apparatus, and it had single-acting switches, instead of double-acting switches, at the point where the longer and shorter paths took their departure, and it had no switches to separate the sheets after they had issued in pairs, but it was held to infringe claim 3.

H., one of the patentees, filed in the Patent Office, in 1854, a caveat describing the invention covered by claim 3, and illustrated it by drawings in a manner sufficiently full and clear to have enabled the apparatus to be built and put in practice. In the affidavit to the caveat, H. swore that he verily believed himself to be the original and first inventor of the improvement. The caveat was renewed in each year from 1860 to 1869, both inclusive. The patent was applied for in April, 1872. H. and T. were the joint inventors of what is embraced in the patent, and H. was not the sole inventor. H. believed, at the time, that he was the sole inventor. He was so advised by his counsel at the time, on the ground that, although he and T. were mutual inventors, the fact that T. was the hired employee of H. made the invention the property of H. and authorized the taking of the caveat in the name of H. alone. T. concurred at the time in that view: *Held*, that there was nothing connected with the caveat to interfere with the validity of the patent, or to prevent the carrying back of the invention, as a joint invention, to the date of the original filing of the caveat.

In the contents of the file-wrapper was an oath to the specification and application, sworn to by H., at London, England, before "a London commissioner to administer oaths in common law." No other oath by H. appeared now among the contents of the file-wrapper. There was a proper oath by T. The London commissioner was not an officer specified in § 30 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 202,) as one before whom the oath could be taken. The bill alleged "due application." The answer denied that allegation generally, but did not point out any defect as to the oath of H. The plaintiffs put in evidence the patent. The defendant put in evidence the file-wrapper and contents, under the plaintiffs' objection. The defendant took no objection, in the record of the testimony, as to the oath, or as to the putting in evidence the patent. The defendant did not show that there was no proper oath by H. or that the oath appearing was the only oath he made: *Held*, that it was not shown that there was not a proper oath by H., and that the presumption arising from the grant of the patent and from the recitals in it was not rebutted.

Priority of completion of mechanism, as well as priority of invention, determined in favor of H. and T., as between them and C.

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Claim 4 is a claim to the adjusting roller for regulating the travel of the first sheet, in its longer path, relatively to the travel of the second sheet, in its shorter path, and involves the two several series of tapes of the two several paths. The adjustment of the relative lengths of the two paths to each other, by modifying the length of the longer one, through an adjustment of the roller acting on the longer tapes, is the point of the claim. Such invention was new.

(Before BLATCHFORD, J., Southern District of New York, March 27th, 1882.)

BLATCHFORD, J. This suit is brought on letters patent No. 131,217, granted to Richard M. Hoe and Stephen D. Tucker, September 10th, 1872, for an "improvement in printing presses." Infringement is alleged of only claims 3 and 4 of the 6 claims, and only those parts of the specification need be referred to which concern claims 3 and 4. The specification says that the invention "relates to printing machines, and more particularly to that class commonly known as 'perfecting presses,' in which the sheets of paper are printed on both sides in passing once through the machine. It consists in certain novel combinations and arrangements of parts to be more fully described hereafter, which have for their object the more perfect operation of the machine in presenting the sheets of paper to the printing mechanism, and conducting them away after being printed." There are 6 figures of drawings, of which only figures 4 and 5 are important to the present suit. The specification says: "The sheets of paper to be printed are carried to and away from the printing mechanism by the series of tapes *a, b, c, d, e, f, g, h, i*, shown in detail in Figs. 4, 5." Then the printing mechanism is described, which prints both sides of each sheet, and the means of carrying the sheets to and through such mechanism. Then the text proceeds: "The sheets, after leaving the printing mechanism, are carried between the tapes *e, f*, up to the rollers 61, 62, where, by an arrangement of tapes and switches, they are alternately directed into different paths. The tapes *g* and *h* run in contact with the tapes *e, f*, after they diverge at the rollers 61, 62, and they act to carry the sheets forward after they leave the tapes *e, f*."

The tapes *g* pass around the roller 63 horizontally a short distance in contact with the tapes *f*, and thence around the roller 69 to the roller 63 again; and the other series *h* pass from the roller 60 upward and in contact with the tapes *e* to and over the roller 59 beneath the tapes *e*; thence horizontally to the roller 58; and thence to and around the roller 70; and, finally, in a horizontal direction, to the roller 63 and over it to the roller 60. These tapes convey the printed sheets to the flying mechanism as they are directed by the switches 72. The printed sheets, as they leave the tapes, are received by two separate fly-frames R, S, and laid by them upon two separate tables, P, Q, and, through the arrangement of the tapes before described, and the operation of the switches 71, 72, two sheets are presented at the same time, one upon the other, and taken by the fly. The switches 72 act to direct the sheets into different paths, and the switches 71 act to direct their passage to the fly-frames. As the sheets are fed in one after the other from the tables T, U, V, W, it is necessary to make some take a longer path than the others, in order to have two of them issue together at the same time from the tapes, to be taken by the fly-frames, and, for this purpose, the switches 72 are employed and operated as follows:” Then follows a description of means for operating the switches 72, and of means for operating the switches 71, and the fly-frames R, S, the fly-frames being alternately raised and lowered, one being up while the other is down. The text then goes on: “In conducting the sheets from the last printing cylinder to the flying mechanism, between the tapes, they follow one immediately behind the other, as they are fed from the tables, and it is necessary, as before stated, to make the first and third sheets travel a longer path than the second and fourth, in order to cause two sheets to issue simultaneously and lie one upon the other, when taken by the fly-frame. As the first sheet, therefore, approaches the rollers 61, 62, the switch 72 is turned into the position shown in Fig. 4, so that the sheet, in its travel upward, strikes against the curved edge of the switches 72, is directed by them between the

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rollers 60, 61, and the tapes *e*, *h*, and thus caused to travel between these tapes over the rollers 59, 58, while, as the edge of the second sheet approaches the rollers 61, 62, the switch is turned back into the position shown in Fig. 5, so that the sheet will be directed by it between the rollers 62, 63, and caused to enter between the tapes *f*, *g*, and be carried by them in a shorter path to the point where they issue to the fly. The third and fourth sheets are acted upon by the switches 72 in the same manner, and one caused to take a longer path than the other, and so on for the following sheets. Two printed sheets are thus brought out on the fly-frame by being separated in their course, after they leave the printing mechanism, into two different paths, and being brought together again, so that, when they meet, they will issue one upon the other. The roller 59 is held in adjustable bearings 80, secured to the side-frames C, and can be raised or lowered to make the path of the first sheet longer or shorter, as it may be necessary. The machine is provided with two separate fly-frames and receiving tables, placed back to back, for the purpose of causing the sheets, when thrown upon the tables, to have one side exposed to view on one table, and the other side in view on the other table, so that both printed sides are in sight at the same time, for inspection. In delivering the double sheets to the fly-frames, they are directed alternately to each fly by the switches 71, which vibrate, between the rollers 57, 68, and issue in front of the fly S; but, as the edges of the next two sheets approach the switches 71, they will be turned in the other direction, Fig. 5, and caused to direct the sheets into the path between the rollers 66, 67, so that they will issue in front of the fly R and be laid upon the table P." Claims 3 and 4 are as follows: "3. Separating two following sheets of papers, on their travel to the fly-frame, into two different paths, by an arrangement of tapes and switches, and making the travel of one sheet suitably longer than the other, so that, when they meet again, they will issue one upon the other to the fly, substantially in the manner described and specified. 4. The employment and use

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of the adjusting roller 59, for regulating the travel of the first sheet, constructed and operating substantially in the manner described and specified.”

Claim 3 is for an arrangement of tapes and switches, which separates two following sheets of the printed papers, in their travel to the fly-frame, into two different paths, the travel of one of the two sheets in its path being suitably longer than the travel of the other of the two sheets in its path, so that, when the two sheets meet again, they will issue one accurately superimposed upon the other, to the fly. Each sheet follows the line of travel of its controlling tapes. Sheets 1, 3, 5 and so on, in numerical order, go the longer path, and sheets 2, 4, 6 and so on, in numerical order, go the shorter path, so that sheet 1, starting before sheet 2, may yet arrive at the same time with it, and the two issue in unison one upon the other, and so with sheets 3 and 4, and sheets 5 and 6. Two sheets are delivered at one and the same time, to one fly-frame, and then two others are delivered at another and the same time, to the other fly-frame.

The defendant's apparatus has no fly-frames. The sheets in it issue in pairs to a folding apparatus. It also has single-acting switches, instead of double-acting switches, at the point where the longer and shorter paths take their departure, and it has no switches 71. If the fly delivery devices, and the switches 71, and the double-acting switches, as distinguished from the single-acting switches, are no part of claim 3, then the infringement is clear. In the defendant's machine, the printed sheets are successively carried by the same sets of tapes to a place of divergence, where there are single-acting switches, along the edge of the sheet. When the switches are out of the way, the sheet passes on in a path which is a continuation of its path up to the switches. When, for the next sheet, the switches are interposed, that sheet is diverted into another path. Then the switches move out of the way again, and the first operation is repeated, and so on, the switches moving into the way and out of the way alternately for each alternate sheet. One of the paths is suitably longer

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than the other, so that, when the two paths meet again, the sheets coincide, and one is upon the other, and they issue in pairs. The question of the infringement of claim 3 depends, therefore, mainly upon the proper construction of that claim.

The object of the invention in claim 3, as indicated by the text of the specification, is, to carry along the sheets in succession, and divide them into two series, each series consisting of all the alternate sheets, and to cause a sheet of one series and the following sheet of the other series to be brought together, in pairs, surface to surface, with coinciding forward edges, and thus be delivered ready for the next operation that is required. In the plaintiffs' patent a fly takes them. In the defendant's apparatus they pass on and are mechanically folded, the two sheets at a time. In the plaintiffs' patent the use of the two flies makes necessary the switches 71, to direct each successive pair of sheets to a different fly. But, there is nothing in claim 3 which refers to any operation that is to be performed upon the sheets after any successive two sheets are made thus to coincide and be superimposed. The separation into two paths, the longer and the shorter travel, the meeting, and the issuing one upon the other, are all there is that is made essential either by the description or the claim. It is true that the travel is to the fly-frame, because there is a fly-frame, and that the fly takes the pair of sheets, when they issue, because there is a fly. But the invention of separation, travel in paths of different lengths, and uniting and issuing one upon the other, has no relation to and does not include the fly-frame or the switches 71, nor does claim 3 include them. The word "switches," in claim 3, cannot be construed to include the switches 71, without distorting the language of the claim. The switches 71 take no part in separating two following sheets of papers, in their travel to the fly-frame, into two different paths, one longer than the other. The switches 71 act upon the sheets after they have left their different paths and have come together again, one upon the other, and act upon them only as pairs, and have no action to make pairs of them.

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A determination as to whether the switches 72 shall be single-acting or double-acting is controlled entirely by the fact as to whether the original path is to proceed on from where the switches are located, in a continuation of the same line, as a path for one of the sheets, leaving the other sheet of the pair to be diverted by the switches into another path, or whether the original path is not to proceed on in the same line, but there are to be two new paths, each controlled by a separate movement of the switches. In the former case, the switches keep out of the way, to permit the original path to continue on and continue open, as one path, and then come into the way to create the second path. In the latter case, the switches come into the way to divert one sheet from its original line into one path, and then come into the way to divert the second sheet from its original line into another path. There is no difference in principle between the switching arrangement in the two cases. The change is purely mechanical, depending on the courses the sheets are to take with reference to the path by which they approached. The single-acting switches direct the travel of the sheet out of whose way they keep, relatively to the path of the other sheet, as effectually as they direct the path of the latter relatively to that of the former, by being interposed in the way.

On the 24th of January, 1854, Mr. Hoe filed in the Patent Office a caveat which described the invention covered by claim 3, and illustrated it by drawings in a manner sufficiently full and clear to have enabled the apparatus to be built and put in practice. The affidavit to the caveat was sworn to by Mr. Hoe February 24th, 1854, and was filed in the Patent Office February 27th, 1854. In that affidavit Mr. Hoe swears that he verily believes himself to be the original and first inventor of the improvement. This caveat was renewed October 4th, 1860; September 18th, 1861; October 9th, 1862; September 16th, 1863; August 22d, 1864; October 5th, 1865; October 5th, 1866; October 3d, 1867; October 7th, 1868; and October 5th, 1869. The patent in suit was applied for April 4th, 1872. The evidence of Mr. Hoe and

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Mr. Tucker is entirely conclusive to show that they were the joint inventors of what is embraced in the patent, and that Mr. Hoe was not the sole inventor. Notwithstanding the affidavit to the caveat, the fact of joint invention is clear. Moreover, the evidence shows that the affidavit was true, and that Mr. Hoe did at the time he made it believe himself to be the original and first inventor of the improvement. All that Mr. Hoe swears to is his belief. It is shown that he had such belief; that he told Mr. Tucker, at the time, that he had such belief; that he was advised by counsel, that, notwithstanding he and Mr. Tucker mutually produced or invented what was in the caveat, yet their relations, as employer and hired employee, made the invention the property of the employer, and authorized the taking of the caveat in the name of the employer alone; that he told Mr. Tucker of such advice, at the time; and that Mr. Tucker concurred in what was done. With this explanation, there is nothing connected with the caveat to interfere with the validity of the patent, or to prevent the carrying back of the invention claimed, as a joint invention, to the date of the original filing of the caveat. The caveat having been filed as for an invention of Mr. Hoe alone, he could have no motive, nor could there be any advantage, in the joint application for the patent, as for a joint invention, except that it was true that the invention was, in fact, joint, and that the advice he had received before the time the caveat was filed had been modified by different advice received on full consideration of all the facts, when a patent was to be applied for. The impulse of self interest would naturally be, to disregard the truth, and thus avoid any necessity for explaining the apparent discrepancy between the affidavit to the caveat and the affidavit to the application for the patent. Both Mr. Hoe and Mr. Tucker testify fully and without reservation and disclose fully all the facts and all the motives which induced the action taken. There is nothing to impeach their truth or credibility. The question is as to what Mr. Hoe and Mr. Tucker believed at the time. The question is not as to whether the advice of the counsel was correct on the facts

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presented to him. Exactly what facts were presented to him cannot now be told. The matter was oral. Whether all the facts, as now disclosed, were presented to him, we cannot tell. The evidence shows that the same counsel who gave the advice, afterwards and with reference to taking out a patent for the joint inventions of Mr. Hoe as employer and Mr. Tucker as his employee, advised that there was a question as to the propriety of taking out such patent in the name of the employer alone, and that it was wiser to take it out in their joint names. This goes to confirm the fact that the original advice was given. Mr. Hoe, as a layman, had a right to act upon it, and to swear to his belief. This he did.

In the contents of the file-wrapper in the matter of the patent is an oath sworn to by Mr. Hoe, March 12th, 1872, at London, England, before "J. Nunn, a London Commissioner to administer oaths in common law," the official character of Mr. Nunn being authenticated by a certificate made by the Consul-General of the United States at London. No other oath by Mr. Hoe to the specification or applications appears among the contents of the file wrapper. There is a proper affidavit by Mr. Tucker, that he verily believes himself to be the first, original and joint inventor with Mr. Hoe, and as to the other particulars required. The form of the oath by Mr. Hoe is not criticised. But it is objected that the oath was not taken before a proper officer, and so there was no oath by Mr. Hoe, and no valid patent. The contents of the oath were prescribed by § 30 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 202.) That section provided that the oath might be made "before any person within the United States authorized by law to administer oaths, or, where the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be."

The bill alleges that the plaintiffs obtained letters patent for their invention "in due form of law." It alleges nothing

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as to any oath or as to any application, except to say that they obtained the patent "upon due application therefor." The answer does not aver any defect in Mr. Hoe's oath or any want of an oath, but alleges merely that the defendant "is not informed whether, in other respects, the requirements of law relative to the granting of letters patent were complied with by the said Hoe and Tucker, or what, if any, proceedings were had prior to the issue of said letters patent, and, therefore, denies the allegations of the bill of complaint in respect to the same, and leaves the complainants to make such proof thereof as they may be advised." The plaintiffs sustained whatever *prima facie* burden there was upon them because of the averment as to "due application," by introducing the patent. The plaintiffs did not put in evidence the file-wrapper and contents. They were put in evidence by the defendant, under the objection by the plaintiffs that they were incompetent, irrelevant and immaterial. There is no disclosure in the record of any point being made by the defendant as to a defect in Mr. Hoe's oath, or as to the want of an oath by Mr. Hoe. The plaintiffs had put the patent in evidence without any objection being taken by the defendant that it was not properly granted, because there was no proper oath. There is no evidence put in by the defendant to rebut the presumption, from the grant of the patent, that there was a proper prior oath by Mr. Hoe, tending to show that there was no such oath by him, or that the oath appearing was the only oath he made. The copy of the file-wrapper and contents is a copy certified January 9th, 1881, and speaks only as to what were the contents of the file-wrapper on that date. The papers are not evidence to show that there was not a proper oath by Mr. Hoe, other than the one referred to, even if that were an improper one. They were not competent or relevant to show the want of an oath. The patent recites that the plaintiffs "have complied with the various requirements of law, in such cases made and provided," and, "upon due examination made," they are "adjudged to be justly entitled to a patent under the law." Section 26 of the Act of 1870 pro-

vides that the inventor must make application in writing to the Commissioner of Patents for the patent. Section 30 provides for the oath to be made by the applicant. Section 31 provides that, "on the filing of any such application and the payment of the duty required by law, the Commissioner shall cause an examination to be made of the alleged new invention or discovery; and if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor." Assuming that it is open to a defendant, on pleadings such as those in this case, or in any case, to defend a suit on a patent for infringement, by setting up and showing a defect in or a want of the preliminary affidavit, when a patent is issued containing such recitals as that in this case—a question not now necessary to be considered or discussed—it is very clear that the defendant in this case does not show the existence of such a defect or want by any competent evidence.

It remains to consider the Campbell machine, on the question of novelty as to claim 3. It is clear that Hoe and Tucker made the invention before Campbell did, and clearly described it in the caveat and drawings filed in 1854. No press containing the invention of claim 3 was made before 1871, because a printing press of the kind and capacity shown in the caveat is a structure of large cost, not to be made with the chance of a sale, but only to be made on an order, of a particular size, for a particular newspaper. On the 21st of April, 1871, an order for the press was received from the Daily News. By December, 1871, the machine was built and set up and successfully worked in the factory of Mr. Hoe, embodying claim 3. It was then taken down and was put up in the Daily News Office and worked there in February, 1872. Although the Campbell delivery apparatus is alleged to have been constructed early in the fall of 1871, tapes were not applied to it, nor were the switches or the mechanism that operates the switches applied, until January or the first of February, 1872, in Ayer's factory at Lowell. The delivery

apparatus was not set up, nor were sheets of paper run through it, before that time. Therefore, priority of completion of mechanism, as well as priority of invention, must be determined in favor of the plaintiffs.

Claim 4 is a claim to the adjusting roller for regulating the travel of the first sheet, in its longer path, relatively to the travel of the second sheet, in its shorter path. It thus involves the two several series of tapes of the two several paths. The adjustment of the relative lengths of the two paths to each other, by modifying the length of the longer one, through an adjustment of the roller acting on the longer tapes, is the point of the claim. The defendant's expert says that the English patent to Dryden and Miles does not contain any description of the apparatus relied on, and that the drawing alone is imperfect and is not a sufficient description to invalidate claim 4. The plaintiffs' expert says that the roller of Dryden and Miles does not act on one set of tapes alone, but varies the lengths of two sets of tapes simultaneously and to substantially the same extent.

The defendant's expert says that the Dryden press at Gray & Green's exhibited the invention in claim 4, but he gives no reason for so thinking. The plaintiffs' expert says that that press had only one set of tapes, and had no method of adjustment by which the travel of one sheet could be adjusted relatively to the travel of another and following sheet; and that the adjustment of the roller in it adjusted the travel of the same sheet relatively to forms of types which printed the two sides of it, so as to make the impressions register. This is not the invention of claim 4.

There must be a decree for the plaintiffs as to claims 3 and 4, with costs.

M. B. Philipp and B. F. Thurston, for the plaintiffs.

B. F. Lee and W. D. Shipman, for the defendant.

The Boston Beef Packing Company v. Stevens.

THE BOSTON BEEF PACKING COMPANY

vs.

CALVIN A. STEVENS AND OTHERS.

S. and others were sued personally and also in their representative capacity as executors and trustees under a will, for damages caused by the fall of a building owned by them as such executors and trustees, and which had been leased by them. A verdict was had for the plaintiff, establishing that the building was unsafe at the time it was leased and that it fell without any contributory fault in the lessees or in the plaintiff. The plaintiff occupied an adjoining building: *Held,*

- (1.) That the action could not be maintained against the defendants in their representative character, and the process, pleadings and proceedings must be amended by striking out the description of the defendants' official character, without the granting of a new trial;
- (2.) That the defendants were liable as individuals for negligence in authorizing and sanctioning the acts of the tenants in the use of the property.

(Before WALLACE, J., Southern District of New York, March 29th, 1882.)

WALLACE, J. The defendants are sued personally, and also in their representative capacity as executors and trustees under the will of Calvin Stevens, deceased, for damages alleged to have been sustained by the plaintiff by the fall of a building owned by the defendants as such executors and trustees, and which had been leased by them for a storage warehouse. The jury found for the plaintiff, and, under the instructions of the Court, their verdict established two propositions: first, that the building was unfit and unsafe for use as a storage warehouse at the time the defendants let it for such use; and, second, that the building fell without any fault contributing to the fall on the part of the lessees. The plaintiff was the occupant of an adjoining building, and the verdict of the jury further established that there was no contributory negligence on the part of the plaintiff.

Upon what theory the defendants were sued in their repre-

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sentative character, and by what rule of law their liability in such character can be maintained, has not been satisfactorily shown. The question was reserved upon the trial, but no authority has been adduced to change the opinion expressed by the Court upon the trial, that an action cannot be maintained against an executor or trustee in his representative character, for a wrongful act which was not and could not be committed by him in his official capacity, but which, because it was a wrongful act, was in excess of his authority.

A new trial, however, should not be granted. The only defendants in the case are the individuals named as such, and, although they are also described in their representative character, they cannot, in an action at law, sever their identity. The same individuals cannot have a judgment in their favor and one against them, in the same record. The plaintiff must amend the process, pleadings and proceedings by striking out the description of the defendants' official character.

Upon the main question in the case, that of the liability of the defendants for negligence, there is no reason to doubt the correctness of the rulings at the trial. The defendants were carefully protected by the instructions to the jury from all responsibility for the acts of the tenants. They were held liable only to the extent that for their own profit they authorized and sanctioned the acts of the tenants in the use and control of the property. As the verdict was upon the theory that the tenants were not guilty of negligence, unless the defendants are held liable, the singular result would follow, that a wrong has been committed for which no person can be held responsible. Whoever, for his own advantage, authorizes his property to be used by another in such manner as to endanger and injure unnecessarily the property or rights of others, is answerable for the consequences. Sometimes, the liability has been referred to the law of nuisance. (*Norcross v. Thoms*, 51 *Maine*, 503; *Fish v. Dodge*, 4 *Denio*, 311.) But it exists when the injury results from negligence as well as when from an intentional wrong. The mere fact that a third person is interposed between the owner or principal and the party in-

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jured cannot affect the responsibility of him who originates and sanctions the injury. (*Swords v. Edgar*, 59 N. Y., 28.) As is said in *Todd v. Flight*, (9 C. B., N. S., 377,) "if the wrong causing the damage arises from the non-feasance or the misfeasance of the lessor, the party suffering damage from the wrong may sue him." The case of *House v. Metcalf*, (27 Conn., 631,) is precisely in point. The rule is too well settled to require further citations.

The motion for a new trial is denied.

James McKeen, for the plaintiff.

George W. McAdam, for the defendants.

LEMAN W. TYLER

vs.

JAMES D. GALLOWAY AND OTHERS. IN EQUITY.

The first claim of re-issued letters patent granted, August 5th, 1879, to Leman W. Tyler, as assignee of William Sternberg, for an improvement in cheese-hoops, the original patent having been granted to said Sternberg, March 21st, 1871, is an inexact claim, which, if construed according to its natural meaning, would include an invention broader than the one which was made. If a limited construction be given to it, it would be substantially the same as the second claim of the re-issue. The second claim of the re-issue being valid and infringed, the Court held that the plaintiff could have a decree on it, without costs, on disclaiming the first claim.

(Before SHIPMAN, J., Northern District of New York, April 1st, 1882.)

SHIPMAN, J. This is a bill in equity to prevent the infringement of re-issued letters patent granted, August 5th, 1879, to the plaintiff, as assignee of William Sternberg, for an improvement in cheese-hoops. The original patent was

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granted to Sternberg, March 21st, 1871. The object of the bill is to prevent the use of cheese-hoops known as the Frazer hoop, which are made under the patent granted to Milton B. Frazer, January 9th, 1872.

The questions which are involved in this case, viz., the validity of the plaintiff's re-issued patent and its infringement by the use of the Frazer hoop, were decided by Judge Wallace in the case of *Tyler v. Welch*, (18 *Blatchf. C. C. R.*, 209.) At the suggestion of Judge Wallace this case was heard by another judge, as it was thought that the recently decided cases of *Miller v. Brass Co.*, (104 *U. S.*, 350,) and *James v. Campbell*, (*Id.*, 356,) might present the question of the validity of the re-issue in a new light.

The nature of the Sternberg invention, the differences between the original and re-issued patents in the descriptive part of the respective specifications, and the method of construction of the two hoops, are fully described in *Tyler v. Welch*, cited *supra*. I entirely concur with Judge Wallace, and for the reasons which he gives, in his conclusions, that the Frazer hoop is an infringement of the second claim of the re-issued patent, and that there is no "new matter" either in the descriptive part of the specification or in the second claim of the re-issue. This claim is a substantial reproduction, in different phraseology, of the single claim of the original patent.

The original claim was as follows: "The grooved hoop A, a, in connection with the expansible ring B, substantially as and for the purpose herein specified." The two claims of the re-issue are as follows: "1. An expansible ring or band, in connection with the upper part of a cheese-hoop, to hold the upper edge of the bandage while being filled with curd and during the process of pressing, substantially as specified. 2. The combination of the expansible ring or band and the cheese-hoop grooved or depressed sufficient to receive said ring or band, so that it will not interfere with the follower, substantially as specified."

Judge Wallace was of opinion that the first claim of the re-issue was capable of a broader construction than Sternberg's

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invention warranted, but was disposed to limit the claim so that it should only cover the actual invention. While such limitation is in accordance with the existing rules of construction, yet, in view of the recent decisions of the Supreme Court, and of the fact that in this case, with such a construction, both claims of the re-issue would be the same, but especially in view of the late decisions, I think that such a course is not advisable and that the claim should be declared void. The plaintiff, in obtaining a re-issue, introduced an inexact claim, which, if construed according to its natural meaning, would include an invention broader than the one which was made. If such a construction should be adopted, the patent would be improperly enlarged. If, on the other hand, a limited construction should be given, the first claim would be substantially the same as the second and would be superfluous. One claim in a re-issue may be void without necessarily invalidating the other claims. In such case, it is proper to disclaim the void claim. (*O'Reilly v. Morse*, 15 *How.*, 62; *Schillinger v. Gunther*, 17 *Blatchf. C. C. R.*, 66.) In this case there has been no unreasonable neglect or delay.

Whenever the plaintiff shall have satisfied the Court that a proper disclaimer has been filed in the Patent Office, disclaiming the first claim in such manner as to claim only the invention as specified in the second claim of the re-issued patent, a decree will be entered for an injunction against the infringement of the second claim, and for an accounting of profits and damages arising under said infringement, but without costs.

George W. Hey, for the plaintiff.

H. R. Durfee, for the defendants.

Fountain v. The Town of Angelica.

JAMES T. FOUNTAIN vs. THE TOWN OF ANGELICA.

The provision of § 5 of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 472,) that the Circuit Court shall dismiss a suit if the parties have been improperly or collusively made or joined for the purpose of creating a case cognizable under said Act, construed.

In this case the suit was dismissed, it appearing that the plaintiff had no substantial interest in the coupons sued on.

(Before WALLACE, J., Northern District of New York, April 3d, 1882.)

WALLACE, J. By the 5th section of the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 472,) to determine the jurisdiction of Circuit Courts of the United States, it is declared, that if, at any time in the progress of a case, either originally commenced in a Circuit Court or removed there from a State Court, it shall appear that such suit does not really involve a dispute or controversy properly within the jurisdiction of the Court, or that the parties to said suit have been improperly or collusively made or joined, either as plaintiffs or defendants, for the purpose of creating a case cognizable or removable under the Act, the said Circuit Court shall proceed no further but shall dismiss the suit, or remand it to the Court from which it was removed. This action presents the question whether the plaintiff has been improperly or collusively made a party for the purpose of creating a case cognizable by this Court, within the meaning of the section referred to.

It is said by the Supreme Court, in *Harves v. Oakland*, (104 *U. S.*, 450,) that this statute strikes a blow at improper and collusive attempts to impose upon this Court cognizance of cases not justly belonging to it. Before this Act was passed it was settled law, that, although a transfer of the subject of the controversy may have been made for the purpose of vesting an interest in parties competent by reason of their domicile to litigate in the Federal Courts, that circumstance would not defeat the jurisdiction if the transaction invested

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the assignee with the real interest in the subject-matter; yet, if the assignment was colorable only, and the real interest still remained in the assignor, jurisdiction would not be entertained. (*Barney v. Baltimore City*, 6 *Wallace*, 280.) The section in question, therefore, was quite unnecessary if it was only intended to reach a case in which the plaintiff, by assignment, obtained merely a colorable title to the subject of the controversy. It is not difficult to discern the purpose of the section. It had long been notorious that the jurisdiction of the Circuit Courts was constantly invoked for the benefit of parties not within the class which the constitutional grant of jurisdiction to the Federal Courts was intended to include, by parties who, because they were citizens of the same State as their adversary, could only resort to the Courts of the State, but who, for some ulterior motive, desired to resort to the Federal Courts. The convenient device was resorted to of transferring the subject of the controversy to a citizen of another State, a friendly coadjutor, who, while acquiring the legal title, was expected to litigate for the benefit of the original party. Thus new parties were introduced into controversies in which they had no substantial interest, merely to bring cases within the Federal jurisdiction. It cannot be doubted that the provision in question was intended to meet and prohibit a jurisdiction sought and obtained by such collusive methods. It should be held that a plaintiff who has been introduced into a controversy, by assignment or transfer, merely that he may acquire a standing and relation to the controversy which will enable him to prosecute it for the beneficial interests of the original party, has been improperly and collusively made a party, for the purpose of creating a case cognizable under the Act.

No better illustration of the class of cases which the section was intended to meet could be presented than the present case affords. It is palpable, upon the evidence, that the plaintiff has no substantial interest in the coupons which are sued upon, conceding that he acquired the legal title to them so as to enable him to maintain the action. He bought them

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at the solicitation of one Dick, without any inquiry as to their validity or value, and without any negotiation concerning the price to be paid. He pretended to pay for them by a check which he has never paid; which was made for the full face amount of the dishonored and contested coupons; which was paid, if paid at all, by a bank of which Dick was a director and the plaintiff was an assistant cashier; and which, after the expiration of three years, he has never heard of since he gave it. He testifies he had no personal interest in the transaction. He was informed the coupons would have to be collected by suit. He placed them in the hands of Dick's attorney for collection, very soon after receiving them. He testifies that he did not expect to be responsible to the attorney for his charges. In short, he was merely an instrument of Dick, selected by Dick, and invested with a formal title to the coupons, in order that Dick might litigate them in a Federal Court.

It is the duty of the Court to dismiss the suit.

Marshall, Clinton & Wilson, for the plaintiff.

Hamilton Ward, for the defendant.

GEORGE B. PHELPS

vs.

THE CANADA CENTRAL RAILROAD COMPANY.

Before this action was removed into this Court the State Court had made an order restricting the plaintiff from setting up any cause of action in addition to one for breach of contract, on which an attachment had been granted. The plaintiff elected to consent to that order, as a condition of retaining the attachment, and it was in force when the action was removed. Nothing having occurred to change the rights or position of the parties, a motion by the plaintiff for leave to amend his complaint was denied by this Court.

(Before WALLACE, J., Northern District of New York, April 3d, 1882.)

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WALLACE, J. Before this action was removed into this Court the State Court had granted an order restricting the plaintiff from averring in his complaint any cause of action against the defendant other than for alleged breach of contract set forth in the affidavit upon which the defendant's property was attached and its appearance thereby compelled. Although the main point considered by the State Court upon the motion which resulted in such order was the right of the plaintiff to incorporate into his complaint a cause of action and prayer for equitable relief, the order made was both broad and explicit in its terms, and confined the plaintiff to the cause of action set forth in the affidavit for the attachment. The plaintiff elected to consent to that order as a condition of retaining his attachment, which would otherwise have been vacated. Whether the State Court would have thus adjudged if the plaintiff had complained upon a cause of action at law only it is not for this Court to determine. It suffices that the order, as made, was in force when the action was removed to this Court. Undoubtedly, this Court has power to modify that order, but it would be unseemly, when nothing has occurred since the removal to change the rights or position of the parties, to disregard the adjudication of the State Court made upon hearing and deliberation and consented to by the plaintiff.

Although the plaintiff is entitled, by the Code of Procedure of the State, to amend, as of course, within the time limited by the Code after the defendant has answered, that right was waived, in so far as the exercise of it would involve any departure from the terms of the order, by the election signified upon the hearing which resulted in the order.

The motion for leave to serve the amended complaint is denied.

Mullin & Griffin, for the plaintiff.

Edward C. James, for the defendant.

DAVID G. YUENGLING, JR. v. HENRY SCHILE. IN EQUITY.

Y. took out a copyright, in 1880, on a chromo-lithographic print, entitled "Gambrinus and his followers," as proprietor, he being a citizen of the United States. The chromo was designed in Europe, by an alien, and printed there. Y. showed no title derived from the author: *Held*,

- (1.) The chromo was the subject of a copyright;
- (2.) Y., not being the author or deriving title from him, could not, under § 4,952 of the Revised Statutes, lawfully obtain a copyright for the chromo;
- (3.) The author, not being a citizen of or resident in the United States, could not obtain a copyright for the chromo as author, and, therefore, Y. could not, as proprietor;
- (4.) A chromo is a "print," within § 4,971 of the Revised Statutes.

(Before BROWN, J., Southern District of New York, April 3d, 1882.)

BROWN, J. The plaintiff moves, upon a bill of complaint and affidavit, for a preliminary injunction to restrain an infringement of the plaintiff's rights under a copyright alleged to have been obtained by him on the 23d of August, 1880, upon a "chromo" entitled "Gambrinus and his followers." The moving papers allege that the complainant, on that day, was a citizen of the United States, and "proprietor of said chromo;" that he filed on that day, before publication, in the office of the librarian of Congress, the title or description thereof, and on the same day deposited in his office two copies of the same, and gave notice of his copyright by inscribing on the visible front of such chromo, near the bottom, the words, "Copyrighted, 1880, by D. G. Yuengling, Jr., New York;" that he has been at great expense in producing such chromo, and the same is of great value to him; that he has used it as a gratuitous advertisement in his business, as a lager bier brewer; and that the defendant is about to issue a piratical imitation of such chromo, in violation of the plaintiff's rights in such copyright.

The complainant's chromo is of evident artistic merit. It is designed as a symbolic glorification of lager bier drinking.

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In the centre is a conspicuous figure of King Gambrinus, his left arm resting upon a keg of lager, and his right holding aloft a foaming glass of that beverage. On either side of him are a dozen figures of persons representing various classes in life, into whose eager hands his page is distributing the drink. This chromo, by its subject, its brilliant coloring, its excellent finish, and the artistic grouping of its figures, forms a striking picture, suitable for hanging in saloons, and well calculated to draw attention to the plaintiff, whose name is printed in large type beneath the figures, as a person engaged in the lager bier business, and constituting, therefore, a valuable mode of advertising. Among the Germans, and in the lager bier trade, "Gambrinus" is familiarly known as the inventor of lager bier, while King of Flanders, as the legend goes, who used it first as a potion or draught.

The defendant's chromo, claimed to be an infringement, is a few inches smaller than the first, and presents the same general grouping, expression and coloring of the figures, though having some conspicuous changes. Upon the head of the lager bier cask the words "Bock Bier" are conspicuously printed; and the figure of a goat, with its fore feet upon the top of the cask, appears prominently in the foreground, beside the King. The troubadour, who, in the first picture, is reclining upon the ground beside a maid drawing bier at the spigot, is omitted in the defendant's chromo, which also contains at the left a prominent typical figure of "Brother Jonathan," who is substituted in the place of a tailor in the first. There are various other minor changes.

Upon the whole, it is plain that the defendant's chromo is formed upon the same general design as the first, although with very important variations, and is an infringement of it, if the first was lawfully copyrighted before any publication of it. The defendant's chromo is designed as a card, advertising the sale of "bock bier," which is sold mainly in the months of April and May.

From the defendant's affidavits it, however, appears, that the complainant's chromo was designed in Europe by G.

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Bartsch, an alien European artist, whose name is engraved on the face of the print; that in the right hand corner beneath are printed the words, "Wittemann Bros., Publishers of Art Lithographs, New York;" that the work is strictly a chromolithographic print; that all the complainant's copies of it were printed and completed in Europe, whence it was imported to this city by the complainant, who thereupon undertook to take out a copyright, by depositing two copies with the librarian of Congress, as above stated, and stamping upon the left-hand corner the words added by the complainant, "Copyrighted, 1880, by D. G. Yuengling, Jr., New York;" that the defendant has long been a designer, and is also engaged in the lager bier advertising business; that, in the summer of 1880, at the book printer's establishment of Kelly & Bartholom, 22 College Place, in this city, where he had previously been accustomed to get work done, he was shown a copy of all the colored portion of this chromo, but without the copyright stamped thereon; that he was informed by them, at that time, that it was a German work, not copyrighted, and had shortly before been imported and received by them from Europe; that he was then allowed to take this copy away with him, and had retained it ever since, and had made his own chromo therefrom, with the variations above pointed out; and that he never saw any copy with any copyright stamp upon it, and had no knowledge of any such copyright until the commencement of this suit.

It is urged, on the part of the defendant, that the plaintiff's chromo is not the subject of a copyright, because it was designed, used and circulated by him as a gratuitous advertising card, for the benefit of his private business as a lager bier brewer, and not for the instruction or improvement of the public. The case of *Cobbett v. Woodward*, (*Law Rep.*, 14 *Eq.*, 407,) relied on by the defendant, was a case where the catalogue of an upholsterer containing engravings of the articles offered by him for sale and circulated gratuitously was held not to be the subject of copyright, on this ground. A similar decision was made in this Court, in the case of

Collender v. Griffith, (11 *Blatchf. C. C. R.*, 212,) concerning engravings of billiard tables offered for sale; but in that case it was held that the engravings were not works of art, and did not have any value or use as such, and that it was a mere mode of advertising the tables for sale. The case of *Ehret v. Pierce*, (18 *Id.*, 302,) was decided upon the same principle. The case of *Cobbett v. Woodward*, (*supra*,) has not been followed in England, but was substantially overruled in the subsequent case of *Grace v. Newman*, (*Law Rep.*, 19 *Eq.*, 623.)

The plaintiff's chromo in the present case is not a mere engraving, or print, of any article which the complainant offers for sale. It is a work of the imagination, and has such obvious artistic qualities as, in my judgment, render it fairly a subject of copyright, without regard to the use which the plaintiff has made, or may intend to make, of it. Where the work in question is clearly one of artistic merit, it is not material, in my judgment, whether the person claiming a copyright expects to obtain his reward directly through a sale of the copies, or indirectly through an increase of profits in his business, to be obtained through their gratuitous distribution.

There are several grounds, however, why the preliminary injunction sought in this case should not, I think, be granted.

(1.) It being conceded that the complainant is not the author or designer of this chromo, it is incumbent upon him to show how he became entitled to any exclusive copyright of it. In *Greene v. Bishop*, (1 *Cliff.*, 186, 198,) Clifford, J., says: "It is undoubtedly true, that, when a party comes into a Court of law or equity, seeking protection to a copyright, he must show that he is the author of the work, or that his title is derived from one sustaining that relation to the publication." (*Little v. Gould*, 2 *Blatchf. C. C. R.*, 181.) The plaintiff does not show any such derivative title, and it appears that he is not the author.

The owner or proprietor of a work has not, since the Act of July 8th, 1870, any more than before, in that character

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alone, any right of copyright. It is only to "authors and inventors," or to persons representing the author or inventor, that Congress is authorized by the Constitution to grant a copyright. (*Constitution, Art. 1, sec. 8.*) The right of any other person than the author or inventor must, therefore, be a purely secondary and derivative one; and, in enforcing any alleged copyright, such a person must show an exclusive right lawfully derived from the author or inventor; and this the plaintiff has not done. I find no other averment in the papers save that in the bill, that, on the 23d of August, 1880, he was the "proprietor of said chromo." This is not enough. It does not show any exclusive right derived from an original author. It appears, in opposition, that the work was designed and printed in Europe, by an alien artist, and that copies of this design were imported into this country, and came into the defendant's hands, independently of the complainant. There is no averment either that the design itself was new, or that the lithographic stones for the print were engraved by any person employed by the plaintiff, or in his behalf, or that any right of copyright was ever transferred, or intended to be transferred, to the plaintiff, by the author or artist. The chromo may be a mere copy of a European painting long since published in Europe, and free to be copied by any one. For aught that appears, the whole design may have been common property for an indefinite period, as would seem to be the case with the typical form of King Gambrinus. The complainant may have been the "proprietor" of the chromos which he imported, and may have "produced them at great expense," and yet have no exclusive right whatever, as between himself and the European artist, to the sole use even of the lithographic stones in Europe, for the multiplication of any additional copies, much less to the original design. In that case he could acquire no copyright which would exclude the defendant, or any other person, from availing himself, either wholly or in part, of other copies obtained from Europe, either from the same stones, or from the common source of the design. In *Johnson v. Donaldson*, (18 *Blatchf. C.*

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C. R., 287,) in reference to an alleged infringement of the copyright of a chromo, it was held, by Wallace, J., that, if the plaintiff acquired his copyright by appropriating a sketch from a foreign publication, he would not become a proprietor thereof, and could acquire no exclusive copyright; and that, even if the plaintiff were the artist and designer of the picture so appropriated, the defendant would not be liable "if he did not avail himself, directly or indirectly, of the plaintiff's production." In *Rosenbach v. Dreyfuss*, (2 *Fed. Rep.*, 217,) it is said, by Choate, J.: "It is not enough that the defendant *may* be liable if the facts stated in the complaint be true. It must appear that he *is* liable if the complaint is true;" and judgment was rendered for the defendant on demurrer, because it did not certainly appear that the articles described were articles for which a copyright could be granted under the laws of the United States.

In this case it appears, affirmatively, from the defendant's affidavits, that, in making his chromo, he has not availed himself of any copy of the chromo imported by the plaintiff; while, from the want of any averment, either that the design was new, or that the plaintiff had ever acquired the exclusive right of the foreign artist, in case the artist had any such exclusive right, it is impossible to say that the defendant, in availing himself of parts of a foreign copy, independently imported, violated any right of the author, much less of the plaintiff, who could only claim through the author.

(2.) The plaintiff claims that the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 212, § 86, *Rev. Stat.*, § 4,952,) authorizes a citizen or resident of this country, if he be the "proprietor" of any book, map, print, chromo, &c., to obtain a copyright therefor, although the author, inventor, or designer is an alien. The Act of 1870, for the first time, uses the word "proprietor" in connection with the words "author, inventor," and "designer," as one of the persons to whom a copyright may be granted, although, ever since the Act of May 31st, 1790, (1 *U. S. Stat. at Large*, 124,) a proprietor

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might obtain a copyright, if he were the lawful representative of the exclusive rights of a native or resident author. Thus, though the connection in which the word "proprietor" is used in the Act of 1870 is new, the use of the word itself, in relation to copyrights, is as old as the laws of copyright. (1 *U. S. Stat. at Large*, 124, 125, §§ 2, 3, 4, 6; 2 *Id.*, 171, 172, §§ 1, 3; 4 *Id.*, 437, § 3; 11 *Id.*, 138, 139, § 1; 13 *Id.*, 540, § 2; 8 *George II*, ch. 13, § 1; 17 *George III*, ch. 57.)

The literal reading of the 86th section of the Act of 1870, now embodied in § 4,952 of the Revised Statutes, does not require that both the "author" and "proprietor" shall be citizens or residents of the United States. It provides that "any citizen of the United States or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person" may obtain a copyright; and § 103 of the Act of 1870, embodied in § 4,971 of the Revised Statutes, provides that nothing therein "shall be construed to prohibit the printing, publishing, importation, or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving, or photograph, written, composed or made by any person not a citizen of the United States, nor resident therein." By virtue of the latter section an exclusive copyright in the work of any foreign author or artist in the subjects mentioned in that section is prohibited; but this section does not embrace the words "painting, drawing, chromo, statue, statuary" and "models," which were introduced into the copyright law for the first time in the Act of 1870; and, on this ground, it is urged by the complainant, that a "proprietor" may obtain a copyright on the last-mentioned subject, though the artist or author is an alien, because these are not prohibited by § 4,971.

There are three objections to the plaintiff's contention in this respect: first, that it involves a reversal of the policy of

the Government from its foundation, to protect American artists and authors only ; second, that the word “ proprietor,” as used in the copyright laws, in itself means the representative of an artist or author who might himself obtain a copyright ; and, third, that chromos are in reality embraced under the description of a “ print,” in the restrictive section 4,971.

It cannot be doubted that the purpose of the copyright laws, from the foundation of the Government, has been to encourage native talent and to protect American authors and artists only, (*Drone on Copyright*, 231, 257 ;) as the English Acts were designed “ to protect those works which were designed, engraved, etched, or worked in Great Britain.” (*Page v. Townsend*, 5 *Simons*, 395, 404.)

In the first Act on the subject, that of May 31st, 1790, the prohibition against an extension of the copyright to alien authors was as broad as the section authorizing copyright in favor of resident authors. (1 *U. S. Stat. at Large*, 124, 125, §§ 1, 2, 5.) With every extension of the subjects of copyright, made by subsequent statutes, a corresponding restriction was inserted in the prohibitory section relating to foreign authors or artists, until the Act of 1870, when the few additional subjects above-mentioned were added to the subjects of copyright, without any corresponding insertion in the restrictive clause as respects foreign authors or artists. But, even this omission, which was probably accidental, would not of itself have sufficed to admit copyright upon the works of foreign authors or artists ; because the section authorizing the granting of copyrights has always been limited to authors or artists being citizens or residents of the United States, or to their lawful representatives or assigns. It is only by the introduction of the word “ proprietor ” into the authorizing clause of the Act of 1870, (§ 86,) that any doubt could arise in regard to the new subjects of copyright then first introduced and not expressly restricted as respects foreign artists ; and its effect, by a mere literal reading, to allow a copyright on the works of foreign artists, has the appearance of being accidental only. After a policy so early established and so constantly upheld,

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in reference to every subject of copyright, through all the extensions of the law up to 1870, to limit its protection to the works of native or resident authors, there is certainly a strong presumption that no change in this policy was intended in respect to a few articles only added for the first time by the Act of 1870 as subjects of copyright. There is nothing apparent in the nature of these new subjects of copyright themselves to distinguish them from the subjects of copyright previously existing, which can serve as a probable foundation for any such supposed change of policy. A copyright here upon such articles designed and manufactured abroad would be a double injury to American authors and designers. It would not only encourage the employment of foreign artists, to the neglect and detriment of native designers, but it would prevent the use by the latter in this country of the foreign material which would otherwise find its way here, to the education and development of our native artists, and which would serve as models or suggestions for their own work. If all foreign works of this kind can be copyrighted in this country, through a mere transfer to some resident dealer, or agent of the foreign authors, our native artists will be thereby effectually foreclosed and debarred from availing themselves of all such materials for the improvement of their own works. Every intendment, and every presumption, to be derived from the history of copyright in this country, and from other parts of the Act of 1870, seem to me to be against any such intention in that Act.

The effect of the literal construction contended for by the plaintiff would, moreover, be to make the Act of 1870 inaugurate two diverse and conflicting policies in reference to the articles which may be copyrighted under § 86, now § 4,952 of the Revised Statutes—one policy virtually protecting foreign artists by copyright in respect to the few subjects first introduced into the law of 1870; and another policy excluding them in regard to all the other and much larger number of subjects of copyright named in that Act. I cannot believe, in the light of the history of the copyright Act, that, in

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reference to these few new subjects, Congress intended to inaugurate any such change of policy, or to grant an exclusive copyright upon the importation of works wholly designed, manufactured and completed abroad, upon merely depositing copies of lithographs in the Congressional Library by some resident owner. Such a construction would, in effect, confer upon foreign authors and artists, in respect to these subjects of copyright, all the advantages of an international copyright Act, without any reciprocal rights or advantages whatever in favor of our own authors and artists.

The argument for the plaintiff rests wholly upon the use of the word "proprietor" in the authorizing clause (§ 86) of the Act of 1870. But, the history of the use of the term "proprietor," ever since the Act of 1790, shows that it has always been used in the copyright laws in the limited and restricted sense of a person who, by purchase or otherwise, has lawfully acquired the exclusive rights of some native or resident author or artist, and in no other manner.

By § 1 of the Act of 1790, the right to obtain a copyright is granted to a resident author upon *his* works, or to any other person being a *citizen*, or *resident*, who has *purchased* or legally acquired the copyright of any *such* work, or the executors, administrators or assigns of such persons. Section 2 imposes a penalty for publishing, &c., "without the consent of the author or *proprietor*." The same expression "author or *proprietor*" is again several times used in §§ 2, 3, and 4 of that Act. Thus in this early Act, the term "proprietor" is used to embrace all the persons, except the original author himself, who, by § 1, might obtain a copyright, viz., the author's executors, administrators or assigns, or any person who had purchased "or legally acquired the copyright." By § 1, it is seen; moreover, that the purchasers referred to are the purchasers of "*such* map, chart, book, or books," *i. e.*, of the works of *resident* authors only. It is the same in all the subsequent statutes above cited.

From the Act of 1790 down to 1870, there could be no "proprietor," in the sense of the copyright law, except the

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owner of the work of a citizen or resident author, including a transfer of such resident's right of copyright. In the case of *Keene v. Wheatley*, (9 *Am. Law Reg.*, 33,) Cadwalader, J., says, *p.* 45: "The other sections concern copyright. They apply only to authors who, if not citizens, must be residents of the United States, and proprietors under derivations of title from *such* authors. No other proprietor can obtain a copyright under the Act." A third person may become such an owner, or "proprietor," through a transfer or assignment, verbal or written, embracing the right of copyright, after the work is completed, or by virtue of an original employment under a contract with the author, which, by agreement, is to confer upon the employer the complete ownership both of the work itself and of any copyright that may be obtained thereon. Upon such a contract "the person who remunerates," says Vice Chancellor Hall, in *Grace v. Newman*, (*L. R.*, 19 *Eq.*, 623, 626,) "must be taken to be the equitable assignee" of the copyright. (*Parton v. Prang*, 3 *Cliff.*, 537, 547, 551; *Boucicault v. Fox*, 5 *Blatchf. C. C. R.*, 87; *Little v. Gould*, 2 *Id.*, 362; *Sheldon v. Houghton*, 5 *Id.*, 285; *Paige v. Banks*, 7 *Id.*, 152, and 13 *Wall.*, 608; *Drone on Copyright*, 238, 243-5, 257-9.)

To a mere owner of a work as such, to a "proprietor" in that sense only, without any express or implied *transfer* from the author or inventor of his right to a copyright, Congress, as above observed, is not by the Constitution vested with the power to grant a copyright. Congress is not, indeed, prohibited from protecting foreign authors and artists, if it choose to do so; but, in view of its inflexible refusal to do so up to this time, the phraseology of the statute of 1870, in § 86, is not to my mind a sufficient indication of any such change of purpose. When, therefore, in the Act of 1870, the word "proprietor" is found used, for the first time, in connection with the words "author, inventor, designer," as a person to whom copyrights may be granted, it must be construed, if possible, in harmony with the inflexible policy and intent of the copyright law up to that date, and be held to be used in

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the same sense in which the word had always before been used in the copyright law of this country, viz., as meaning the lawful owner and representative, whether by assignment, employment, death, or other lawful succession, of the exclusive rights of some native or resident author or artist only. It must be construed in harmony with the policy of the copyright law, rather than upon its literal and independent reading. Upon the same principle, the Supreme Court, in the late case of *Wilmot v. Mudge*, (103 U. S., 217, 220,) held that the literal reading of an amendment of the section of the bankrupt law as to the effect of a discharge of a fraudulent debt by a composition, must give way to the manifest general purpose and intent of the Act. In that case the Court say: "It is conceded that the defendants in error came within the terms of this provision, and it is insisted that they must be bound by the composition. We admit the apparent force of the logic. But, as we have already said, these several statutes, sections and provisions are to be construed as parts of one entire system of bankrupt law. . * * * There is no injustice, nor any difficulty, in restraining the language of the composition section, as regards its binding force, to persons whose debts are capable of being discharged by the bankrupt law. * * * In this manner both provisions of the bankrupt law can stand and be consistent." Upon the same principle, the word "proprietor" should be construed so as to produce a harmonious, rather than a contradictory, policy in the different parts of the copyright law, by giving that word the restricted meaning and sense in which it has been used in all the past copyright Acts in this country. As respects this chromo, the plaintiff was not a "proprietor" of a native work; and, upon the construction here given, he was not, therefore, a "proprietor" within the meaning of § 4,952, even had he shown an exclusive right from the foreign artist; and he is, therefore, not entitled to the benefits of the copyright law on this chromo.

(3.) The chromo in question is nothing but a lithographic *print* in colors. Lithographs were undoubtedly embraced in

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the term "print," under the Act of February 3d, 1831, both in the authorizing and the restricting clauses. (4 *U. S. Stat. at Large*, 436, 438, §§ 1, 8.) The only difference between chromo-lithographic prints and other lithographs is, that the former are printed from several stones, namely, one for each color, while the latter are printed from one stone, with ink of some kind. It cannot be contended that a "print" is any the less a "print" because struck off in different colors; and it has been held that playing cards, printed in colors, are "prints." (*Richardson v. Miller*, 12 *Off. Gaz. of Pat. Off.*, 3.) A print is a mark or form made by impression or printing; anything printed; that which, being impressed, leaves its form, as a cut in wood, or metal, to be impressed on paper; the impression made; a picture; a stamp; the letters in a printed book; an impression from an engraved plate; a picture impressed from an engraved surface, &c. (*Webst. Dict.*; *Worces. Dict.*; *Wood v. Abbott*, 5 *Blatchf. C. C. R.*, 325.) "It means, apparently, a picture, something complete in itself, similar in kind to an engraving, cut or photograph." (*Rosenbach v. Dreyfuss*, 2 *Fed. Rep.*, 217, 221.)

Chromo-lithographs were, therefore, copyrightable as "prints," under the Act of 1831, and, as such, were within the restriction of § 8 of that Act. As chromo-lithographs became largely dealt in, and, under the slang name of "chromos," became a considerable article of trade, it was not unnatural that, for greater certainty, they should be mentioned by name, in the revision of the copyright Act, in 1870. But, Congress did not thereby abolish the restriction which already existed upon copyrighting them when made by alien artists, because such chromo-lithographic prints are included in the word "print," which is contained both in § 103 of the Act of 1870 and in § 4,971 of the Revised Statutes. Under that general designation of "prints," being restricted before, they are restricted still; for, in the use of the new and specific word "chromo," in the Act of 1870, and in § 4,952 of the Revised Statutes, there is nothing incompatible with the re-

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striction under the more general word "print," which both statutes continue in force as before. (65 *Terra Cotta Vases*, 10 *Fed. Rep.*, 880.)

The preliminary injunction should, therefore, be denied.

Charles Unangst, for the plaintiff.

William F. Pitshke, for the defendant.

JOHN C. ROSE

vs.

THE STEPHENS AND CONDIT TRANSPORTATION COMPANY.

In a suit to recover damages for personal injuries, the complaint alleged that the plaintiff had sustained severe injuries, and claimed \$5,000 damages. After a verdict for the plaintiff, the defendant moved for a new trial because of newly-discovered evidence relating to the extent of the plaintiff's injuries. It did not appear that before the trial the defendant had made any investigation as to the character or extent of those injuries. The motion was denied.

(Before WALLACE, J., Southern District of New York, April 8th, 1882.)

WALLACE, J. The motion for a new trial upon the ground of newly-discovered evidence should not be granted, because the defendant has failed to show that by the exercise of reasonable diligence the evidence newly discovered could not have been obtained and used upon the trial. The evidence relates to the extent of the injuries received by the plaintiff through the negligence of the defendant. The plaintiff alleged in his complaint that he had sustained severe injuries, and claimed \$5,000 damages. It does not appear that prior to the trial the defendant made any investigation to ascertain the character or extent of these injuries. Its officers seem to have contented themselves, in their preparation for a defence of the action, with accepting the plaintiff's case as it might

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appear upon the trial, so far as this issue is concerned. If it had been shown, upon this motion, that an effort had been unsuccessfully made upon their part, by inquiry of such persons as would be likely to have knowledge of the facts, to ascertain the character of the plaintiff's injuries, a very different case would be presented, and one which might appeal with some force to the favorable consideration of the Court. To grant the motion upon such a case as is made would encourage supineness on the part of defendants. The precedent would encourage defendants to ignore proper preparation upon one material issue, in order to obtain the chances of a second trial in case of failure upon the other issues.

The motion is denied.

Chauncey Shaffer, for the plaintiff.

Thomas E. Stillman, for the defendants.

GORDON MCKAY, TRUSTEE, &C.

v8.

ANDREW H. JACKMAN. IN EQUITY.

THE SAME

v8.

THE SCOTT SOLE SEWING MACHINE COMPANY AND OTHERS. IN
EQUITY.

THE SAME

v8.

DAVID LEHMAN AND OTHERS. IN EQUITY.

Lyman R. Blake invented an improvement in sewing machines, by which the soles and uppers of shoes could be sewed together by chain stitches, and ob-

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tained a patent for it, No. 20,775, July 6th, 1858. It was extended for 7 years and expired July 6th, 1879. August 14th, 1860, he obtained two other patents, Nos. 25,961 and 25,962, one for the process of sewing a shoe so sewed, and the other for the shoe sewed by such process. August 13th, 1874, they were extended for 7 years. January 13th, 1880, No. 29,561, was re-issued as No. 9,043. J. took a license from the plaintiff, with the right to use it under all three of the patents, during the term of either, for license fees for all shoes made on it. After No. 20,775 expired, S. made machines for sewing shoes by said process and sold them to the other defendants, who used them. J. and S. and the other defendants were sued, after No. 20,775 expired, for infringing No. 25,962 and re-issue No. 9,043. Blake did not invent a shoe sewed with such stitch: *Held*, that the machine alone was patentable and not the process or the product.

The bill was dismissed as to all the defendants and subject-matter except the arrears of license fees due by J. for the use of the machine.

(Before WHEELER, J., Southern District of New York, April 15th, 1882.)

WHEELER, J. These suits are brought upon two patents originally granted to Lyman H. Blake, dated August 14th, 1860, one, No. 29,561, for an improvement in the construction of boots and shoes, and the other, No. 29,562, for an improvement in boots and shoes. They were to run fourteen years, and, August 13th, 1874, were extended seven years. They were acquired by the orator, and the former was re-issued, in No. 9,043, dated January 13th, 1880, and both have expired since these suits were brought.

Before Blake's inventions boots and shoes were made by pegging through the outer sole, upper and inner sole, by sewing a welt to the inner sole and upper, and then sewing the outer sole to the welt, some very light shoes were made wrong side out, by sewing through the inner sole, upper, and part way through the outer sole, and then turned, and some very low shoes were made by sewing common stitches directly through the inner sole, upper, and outer sole. Sewing parts of uppers, and pieces of leather and cloth for other purposes, together, by chain stitches, made by a machine, by drawing loops of the thread through the material, without drawing the rest of the thread through, was then known and practiced. But no boots or shoes made by sewing the soles and uppers

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together by such stitches, nor any method of so sewing them together, was then known. No means to which that place was accessible, for setting the stitches, had then been discovered. Blake invented an improvement in sewing machines, by which the soles and uppers of all kinds of boots or shoes could be sewed together without any welt, by that kind of stitches; and it was not useful for, nor adapted to, sewing any other kind of stitches, nor in any other place. This improvement was patented to him in letters patent No. 20,775, dated July 6th, 1858, and was highly useful to the public. He made boots and shoes on his machine, and was undoubtedly the first to produce such boots or shoes, or to practice that mode of making them. He made application for a patent for this process of making boots and shoes, and for the boots and shoes made by this process, as a new manufacture, June 30th, 1859; the specification was returned to him for the erasure of one of the claims, with information that claims for the process and product could not be considered in the same application, July 30th, 1859; he withdrew the claim for the product, with notice that he intended to renew it in a separate application, April 16th, 1860, and did renew it July 21st, 1860. The machine patent was granted for fourteen years, was extended seven years, was owned by the orator, and expired July 6th, 1879. The defendant Jackman took a lease from the orator of a sewing machine, with the right to use it under all three of the patents, during the term of either, for license fees for all boots and shoes made upon it, and operated under that license. Since the expiration of the machine patent, the defendant the Scott Sole Sewing Machine Company has made machines for sewing these boots and shoes by this method, and sold them for use to the defendants in the other cases, who have used them. These bills are brought for relief against these acts, as alleged infringements; and, in the case against Jackman, the bill covers any arrears of license fee there may be for the use of the machine, as this Court has jurisdiction of that subject on account of the citizenship

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of the parties ; no question as to that, however, is made for decision.

The machine patent appears to have always been of unquestioned validity. That was so related to the others that any question as to their validity would have been practically unavailing while that was in force, and no question appears to have been really made and contested about either until after that had expired ; and the actual validity of these two patents, as granted, does not appear to have ever been contested until now. In *McKay v. Dibert*, (5 *Fed. Rep.*, 587,) these patents were in controversy ; the infringement complained of appears to have been the use of a machine after the expiration of the machine patent. It seems to have been argued there, that, as the exclusive right to make and use and vend to others to be used, during the term of the patent, had been granted in consideration of the full right which the public should have to the invention after the expiration of the term, the public would have the full right to the machine after that time, notwithstanding the other patents, and that they would practically be cut down to the life of the machine patent, by the expiration of that. The Court, Nixon, J., appears to have held that the expiration of the machine patent left the machine free to all, except for use to infringe other patents with, but that its expiration could not affect the validity of other patents. That case is cited in the orator's brief at page 16, and this is all that is claimed from it. The same point was made upon the hearing on the motion for preliminary injunctions in these cases, and was disposed of orally by Blatchford, J., upon the authority of that case. The question was also made, whether a mere sale of the machine for use in making such boots and shoes would be an infringement, and it was held that it would be and injunctions were granted. These questions appear to have been all that were then decided. A stenographic report of the proceedings upon that motion has been furnished and examined, and the question as to the validity of these patents when granted does not appear to have been considered. Both of these decisions, too, were made before

those of the Supreme Court in *Miller v. Brass Co.*, (104 U. S., 350,) and in *James v. Campbell*, (*Id.*, 356.) So, the questions as to the validity of these patents, as made in these cases, are now to be passed upon.

The first step is to ascertain exactly what Blake did invent. There are many peculiar and valuable qualities of this kind of stitch when used to bind together the surfaces of leather. Only the loops of the stitches are drawn through as made, and the wax is not scraped off and the thread frayed and worn, as is the case when each stitch is set by drawing the whole length of the thread through from the ends; each loop, as drawn to place, tightens the preceding loop and makes the seam very close; and they can be sewed by machine and drawn tighter than by hand, making the binding together of the surfaces of the leather very firm. These qualities are very useful in the sewing together of the soles and uppers of boots and shoes, but none of them are peculiar to that work, or to the work in that place. The same qualities existed in this kind of sewing as used in uniting parts of uppers and elsewhere, and Blake had the advantage of knowing all about them. Had it been desirable to sew seams like those through soles and uppers in boots and shoes, where the uppers would not have been in the way, it would have required no invention whatever to do it with the machines then in use and with this kind of stitch; or, had it been desirable to so sew any seams, it would have required no invention to take these stitches for them. The fitness of the seams was apparent, but the uppers were in the way of employing them. Blake invented means for getting by the uppers, and sewing the seams there notwithstanding the uppers. He used his means to sew the seams there, and accomplished a great thing, but not because he had made a new kind of seam or given a seam any new quality, but because he had put a well-known seam in a difficult place. This was all due to the machine and its operation, and, when he had patented the machine, he had patented all there was of it. If, after he had made his machine, and before he had made a boot or shoe with it, some one else, know-

ing all about it, had, by hand or other known means, made boots or shoes by sewing the soles and uppers together with this stitch, that other person would not have been entitled to a patent for either the process of sewing or the boot or shoe, for there would have been no invention in either. After knowledge of a machine to make a shoe in a particular manner, there would be no room for an invention of that manner of making a shoe, or of a shoe made in that manner; and there would be no more room for the inventor of the machine than for any one else.

It may be doubtful whether such a process or product as these is by itself patentable. Mr. Justice Grier, in delivering the opinion of the Court in *Corning v. Burden*, (15 How., 252), said: "A process *eo nomine* is not made the subject of a patent in our Act of Congress. It is included under the general term 'useful art.' An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But, where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes. A new process is usually the result of discovery; a machine of invention." In *Cochrane v. Deener*, (94 U. S., 780), Mr. Justice Bradley said: "A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." The above language of Mr. Justice Grier, with more to the same import, was quoted with approval by Mr. Justice Bradley, in *Tilghman v. Proctor*, (102 U. S., 707.) Neither of these definitions includes mere mechanical operations, like the looping and drawing thread to form stitches, in sewing, either by machinery or by hand; and such operations, apart from the means for performing them, do not appear to be within the reach of protection by

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the patent laws. (*O'Reilly v. Morse*, 15 *How.*, 62: *Burr v. Duryee*, 1 *Wall.*, 570.)

There is, of course, no doubt but that a boot or shoe might be the subject of a patent, as an article of manufacture, but there would have to be something new about it, as such, in the sense of the patent laws. Blake did not invent a boot or shoe; nor a sewed boot or shoe; nor a boot or shoe sewed with this kind of stitches; all these were known and in use before; he invented a machine by which boots and shoes could be sewed with this kind of stitches in parts where they could not be so sewed before. The new effect was due to the operation of the machine. The patentability belonged to the machine, and not to the boot or shoe, as appeared before. In *Collar Company v. Van Deusen*, (23 *Wall.*, 530,) Mr. Justice Clifford, on this subject, said: "Articles of manufacture may be new in the commercial sense, when they are not new in the sense of the patent law. New articles of commerce are not patentable as new manufactures, unless it appears, in the given case, that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production." In this case that requisite does not appear.

Further, this machine, the process it went through with, and the work it wrought, were so intimately connected that the machine could not be conceived of as an operative thing without involving the rest. The specification of the machine and its use, in the machine patent, included also a description of the process and product. This is shown by the patent itself, and is proved, also, by the testimony of experts, examined as witnesses. It also appears to have been the view taken by Judge Nixon, in *McKay v. Dibert*, where he suggests that a surrender and re-issue of this patent in divisions would have avoided the incongruity arising from the expiration of the patents at different times. In *Miller v. Brass Co.*, (*ubi supra*,) it is strongly intimated, that, whatever a patentee describes in the patent and does not claim is abandoned to the public, unless it was omitted to be claimed by inadvertence

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or mistake, and a correction is sought immediately upon discovery of the omission. There is an allusion to the statute for defeating a patent by two years' public use and being on sale of the invention, as an illustration or reason, but the case does not seem to hold that two years are to be allowed in which to reclaim what is so described. In *James v. Campbell*, (*ubi supra*,) Norton had taken out a patent, December 16th, 1862, for a post-marking and postage-cancelling stamp, containing a combination of the post-marker and blotter and cross-bar connecting them, the blotter to be made of steel or other material which would answer its purpose, and to have on its face circular cutters inclosed in circular rings, to cut the postage stamp at the time of defacing it with ink. The specification described, and the drawings showed, the whole. The claims were for the cancelling stamp separately, and for the combination of the cancelling stamp with the cross-bar. On the 5th of January, 1863, twenty days after, he made application for a patent for a post-marking and postage-cancelling stamp of the same construction as the other, except that the blotter was to be made of wood, cork, rubber, or similar material, held by a tube fastened at one end of the cross-bar. The claims were for the blotter, separately, and for the blotter in combination with the cross-bar and post-marking device. This patent was granted. It was several times re-issued, but the validity of it, as originally granted, came under consideration, and especially the claim for the combination. This combination was not the same as that patented in the former patent, in any sense; that was a combination of a blotter with a cross-bar only, while this was a combination of a different blotter with a cross-bar and post-marker. The whole of this combination was described in the former patent, except the difference in the blotter. Of these patents Mr. Justice Bradley said: "It is hardly necessary to remark, that the patentee could not include in a subsequent patent any invention embraced or described in a prior one granted to himself, any more than he could an invention embraced or described in a prior patent granted to a third person. Indeed, not so well; because, he *might* get a patent for an invention before

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patented to a third person in this country, if he could show that he was the first and original inventor, and if he should have an interference declared. Now, a mere inspection of the patents referred to above will show, that, after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a post-mark and cancelling-stamp at the same time; nor for the general combination of a post-stamper and blotter in one instrument; nor for the combination of a post-stamper and blotter connected by a cross-bar; for all these things, in one or other specific form, were exhibited in these prior patents." The original patent was declared to have been invalid upon this ground. As before shown, Blake's machine patent exhibited both the shoe of his product patent, and the mode of construction of his process patent, to which he was no more lawfully entitled than Norton was to his second patent for what was exhibited in the first.

It is conceded, in the defendants' brief, that there should be a decree for an account of license fees, against Jackman.

Let decrees be entered for an account of license fees, in the case against Jackman, and dismissing the bill as to the residue; and dismissing the bills, with costs, in the other cases.

Elias Merwin & J. J. Storrow, for the plaintiff.

J. C. Clayton, for the defendants.

CHARLES F. McCAY

vs.

G. DE ROSSETT LAMAR. IN EQUITY.

G. recovered from the United States, by suit in the Court of Claims, money as the proceeds of cotton seized in the Southern States and sold. G. having died, L., his executor, was sued by M., to recover some of the money, as the

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proceeds of cotton which belonged to his assignor, a Virginia corporation. The proceeds being identified: *Held*:

- (1.) Although the corporation was engaged in running the blockade, and in aiding the rebellion, it could have recovered itself, as it did not appear that the cotton was received by G. under any arrangement that it should be unlawfully used;
- (2.) The assignment of the claim by the corporation to M. was valid;
- (3.) The failure of the plaintiff to maintain an immaterial issue was disregarded, the material allegations of the bill being proved;
- (4.) M. was not entitled to interest on the avails, unless it was received.

(Before WHEELER, J., Southern District of New York, April 21st, 1882.)

WHEELER, J. The defendant is the executor of the will of Gazaway B. Lamar, who owned, was interested in, and connected with, large amounts of cotton, which were seized in the Southern States by United States treasury agents, at about the close of the war of the rebellion, and sold; and the proceeds of which were turned into the treasury of the United States. He brought proceedings in the Court of Claims for the recovery of these avails, and therein recovered, in April, 1874, the sum of \$579,343 51. The orator claims that \$23,844 88 of this sum was recovered for 136 bales which, subject to some claim for advances in which Lamar was interested, belonged to the Richmond Importing and Exporting Company, a corporation of Virginia, and that the right of that company to this cotton, and its proceeds, has been assigned to him. This bill is brought for the recovery of these avails, and the cause has been heard upon bill, answer, replication, proofs, and argument of counsel.

Three principal questions are made in respect to the orator's right of recovery. One is as to whether these 136 bales were embraced in Lamar's recovery. Upon this question careful and repeated examinations of the proofs lead to the conclusion that they were. The proof of the proceedings in the Court of Claims would, alone, leave the matter somewhat in doubt, perhaps too much so for a foundation for a recovery. But, while the case was pending, he made his will, that of which the defendant is executor, containing these clauses: "It

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is my further will and desire, and I hereby direct my executors to press my claims upon the Government of the United States for the payment of the following cotton, which are now before the Court of Claims ;" among other lots following was specified: "136 bales cotton, belonging to a gentleman in Richmond, Virginia, on which C. A. Lamar made advances." "When all the collection for this private cotton are made, and the amount placed to the credit of the several accounts, and interest charged to each account for my advances, then a division must be made of the net balance to the private account of each." After the recovery he advertised, in the Richmond Enquirer, for the owner of two parcels of cotton, and this lot was in two parcels, stating, "I have to-day received payment for the same from the United States Treasury," and requesting the owner to come forward, pay advances and expenses, prove ownership, and receive the balance due. The proofs also show that he entered this cotton in his books as belonging to an owner unknown, but advertised for in Richmond, charged it there to the United States at \$23,844 88, and credited to the United States that sum as received for it. This clearly shows that his claim embraced this cotton, that he understood that he recovered for it, and, all together, the proof is quite satisfactory that he did recover for it. The proof, including correspondence, shows quite clearly that this cotton was purchased and forwarded to C. A. Lamar, by a Mr. Hambleton, of Richmond, as agent for the Richmond Importing and Exporting Company, and was owned by that company.

Another question is as to whether that company could have recovered for this cotton or its avails; for, it is said, if that company could not, its assignee could not. It is argued that it could not because it was chartered and organized to run the blockade and aid the rebellion. The proof shows that it was chartered "for the purpose of owning, navigating and freighting ships and other vessels engaged in foreign and domestic commerce, and of buying and selling the products and commodities so freighted or intended to be freighted,"

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and that it was engaged in running the blockade, and in that way indirectly, if not directly, to some extent, aiding the rebellion. But the proof does not show that C. A. Lamar or Gazaway B. Lamar received this cotton under any arrangement that it should be used in aid of the rebellion, or in any unlawful manner, such that it could not be recovered for in the hands of either; and the fact that it was recovered for by the latter shows that nothing he was doing with it forfeited or outlawed it. The corporation appears to have been lawful enough in itself. The business it was chartered for might be lawful or unlawful. In transacting unlawful business it would incur the consequences of its unlawful acts, the same as a person; but such unlawful acts would not, of themselves, forfeit its property not involved in them, nor its other lawful rights. As the case is presented, no good reason is shown why this company might not, in its own name, have recovered these avails of the defendant's testator in his lifetime, or of his executor since his decease.

The other principal question is, whether the claim is so assigned to the orator that he can recover upon it in his own name. It is not questioned but that an assignee of a mere right of action or recovery may maintain a suit in equity upon it in his own name; but it is strenuously argued that no real and valid assignment of this claim is shown. That company had a valid claim against Mr. Lamar, the testator. He held these avails of the property of the company in trust for the company. The company had a right to charge him as its trustee of the funds, whether he was willing or not; he seems to have been willing, however, and to have charged himself, so far as he could. The disposition of the cotton was directly within the corporate powers of the company; and the disposition of the avails of the cotton was impliedly within the same scope. The charter provided, that "the affairs of the company shall be managed by a president and board of directors, whose term of office, and their number, shall be determined and elected by the stockholders, and the said board of directors shall possess all the corporate powers of

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the company." The proof shows that no meeting of the company had been held, for any purpose, for many years, and that very little or no corporate business had been transacted within a number of years before the assignment. It does not show what term of office was determined upon for the directors. It does show, by the testimony of the officers, who the directors were at the time, which was competent for that purpose, especially as the proof also shows that the records were destroyed. One of the directors had died. The president and all the others joined in the execution of the assignment. This seems to be sufficient to transfer the title to the claim to the orator.

The bill alleges that Gazaway B. Lamar received this cotton as executor of C. A. Lamar, and held it as such when it was seized. The answer denies that he was executor of C. A. Lamar or held it as such. The proof does not support the bill, but sustains the answer, on this point. He appears to have received it as surviving partner. This failure to sustain the bill in this respect is argued to be fatal to the right to recover upon the bill. This argument is not considered to be well founded. The orator does not seek to recover through C. A. Lamar, or upon any right of his, or upon any obligation incurred by him. How this cotton came into the hands of Gazaway B. Lamar is wholly immaterial in this case. The statement of it is mere inducement. The material facts are, that the cotton belonged to the Richmond Importing and Exporting Company, that the testator received the avails of it, and that the orator has succeeded to the right of the company to the avails. The bill ought not to fail when the material allegations are proved. The orator appears to be entitled to a decree for the payment of these avails. The avails are the amount received for this cotton, after deducting the expenses belonging to it and the recovery for it. It is stipulated that the expense of recovering the whole sum was \$100,000. The expense of recovering this part may be in proportion, and may not; it is not stipulated that it would be. The fact is to be ascertained.

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The orator claims interest on the avails, and it is included in the prayer of the bill. On the facts stated, the orator is not entitled to interest as such. The testator was not a borrower of the money, nor was he wrongfully withholding it. Still, if these avails were so invested as to bear interest, the orator would be entitled to the interest they bore, as a part of the avails. An account, therefore, is necessary of the expenses and charges belonging to this cotton and to the recovery of the sum received for it, and of the interest received, if any.

Let there be a decree that an account be taken of the charges and expenses chargeable to this cotton, and to the recovery of what was received for it, and of the interest received upon the avails of it, if any, and for the payment of the balance to the orator out of any assets of the estate in the hands of the defendant, with costs.

Joseph B. Stewart, for the plaintiff.

Edward N. Dickerson, for the defendant.

ANDREW B. CRAMER vs. ISAAC S. MACK.

In a suit in a State Court in New York, issue was joined by serving an answer which did not require a replication. Thereupon the plaintiff noticed the cause for trial, and placed it on the calendar in due season for a term. After the commencement of the term, but within 20 days from the service of the original answer, the defendant served an amended answer, having the right to do so as of course, subject to its being stricken out if served for delay and for causing the loss of a term. The amended pleading, if not stricken out, superseded the original answer and nullified the notice of trial. The plaintiff, if the cause had been reached before the amended answer was served, had a right to try the cause, and thereafter the amendment could not be made.

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After the term the defendant filed a petition for the removal of the cause into this Court: *Held*, that the petition was not filed before or at the term at which the cause could be first tried, within the Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471.)

(Before WALLACE, J., Southern District of New York, April 22d, 1882.)

WALLACE, J. The motion to remand this action to the State Court presents the question whether this cause could have been tried at the January term of the Court of Common Pleas for the city and county of New York, within the meaning of that clause of the removal Act of March 3d, 1875, (18 *U. S. Stat. at Large*, 471,) which requires the petition for removal to have been filed "before or at the term at which said cause could be first tried." If the cause could have been tried at that term, the petition was filed too late and the motion to remand must prevail.

Issue had been joined by the service of an answer to the plaintiff's complaint, which answer did not require a replication. Thereupon the plaintiff noticed the cause for trial, and placed it on the calendar in due season, for the January term. After the commencement of the term, but within twenty days from the service of the original answer, the defendant served an amended answer. After this term of the State Court the defendant filed his petition for removal.

By the practice in this State, within twenty days after a pleading is served it may be once amended, as of course, subject to the right of the opposite party to have the amended pleading stricken out by the Court if it is made to appear that the amendment was for the purpose of delay, and that the benefit of a term will be lost thereby. The amended pleading, unless it is stricken out by the Court, supersedes the original pleading and nullifies a notice of trial which may have been served by the adverse party before the amendment. The right to amend is not, *per se*, a stay of proceedings, and, if the cause has been noticed for trial, the party who noticed it may bring on the cause, and, if it is reached

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before an amended pleading is served, the cause may be tried, and thereafter an amendment is of no avail.

It was obviously the intention of the removal Act to preclude a party from resorting to the expedient of a removal in order to deprive his adversary of the opportunity to try the cause, and the decisions in construction of the Act are to the effect that a party loses his right to remove if he permits the term to pass at which he could have placed the cause in a position to be tried upon the merits, if he had conformed to the rules of practice of the State Court. When there is an issue which, by the practice of the Court, can be brought to trial, the cause is triable, and, if noticed for trial, the Court can entertain it, and it matters not whether the parties are otherwise ready for trial or not, or whether the Court will see fit to entertain the trial or not. (*Gurnee v. County of Brunswick*, 1 *Hughes*, 270; *Ames v. Colorado R. R. Co.*, 4 *Dill.*, 261; *Scott v. Clinton & Springfield R. R. Co.*, 6 *Biss.*, 529.) In *Knowlton v. Congress & Empire Spring Co.*, (13 *Blatchf. C. C. R.*, 170,) it was held, that, where either party could notice the cause for trial at a term, that term must be considered the term at which the cause could be first tried; and in *Forrest v. Keeler*, (17 *Blatchf. C. C. R.*, 522,) Judge Blatchford held that the defendant lost his right to remove when, the cause being at issue and triable on the merits, he might have noticed it for trial. Other decisions intimate a severer rule, and hold that, if the cause could have been triable if the party seeking to remove had used due diligence in progressing the cause, the term at which it could have been ready for trial is the term intended by the Act.

The present cause was triable at the January term of the State Court. The defendant had the power and the right to defeat the trial by serving an amended answer. The exercise of that right did not, however, enlarge his time for removal. There was an issue which it was competent for either party to bring to a hearing and which the plaintiff sought to bring to a trial. The plaintiff was prevented from trying the cause by the act of the defendant. It does not avail the defendant

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that the practice of the Court gave him the right thus to prevent the plaintiff from trying the cause.

The motion to remand is granted.

Nathaniel Myers, for the plaintiff.

Hugo S. Mack, for the defendant.

JOHN MATTHEWS

vs.

FERDINAND SPANGENBERG AND OTTO BOETTCHER. IN EQUITY.

The 5th and 7th claims of re-issued letters patent No. 9,028, granted, January 6th, 1880, to John Matthews, for soda-water apparatus, the original patent, No. 50,255, having been granted to him October 3d, 1865, are void for want of novelty.

The 4th, 6th, 8th and 9th claims are valid. The parts patented in them being definitely distinguishable from the parts claimed in the 5th and 7th claims, and having been infringed, and the patentee having made the latter claims by mistake, supposing himself to be the first inventor of the parts claimed in them, without any wilful default or intent to defraud or mislead the public, and not having unreasonably neglected thus far to enter a disclaimer of those parts, it was held that he was entitled to maintain this suit, but without costs, on entering the proper disclaimer.

Some of the defendants' evidence was taken out of time, but, as no motion was filed to suppress it, it was allowed to stand and was considered.

(Before WHEELER, J., Southern District of New York, April 25th, 1882.)

WHEELER, J. This suit is brought upon re-issued letters patent No. 9,028, dated January 6th, 1880, granted to the orator upon the surrender of original letters patent No. 50,255, dated October 3d, 1865, for soda-water apparatus. The defence relied upon is, that the defendants purchased the apparatus used by them of William Gee, who afterwards settled with the orator; that the patent is void for want of novelty; and that they do not infringe. The original patent is not in evidence.

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Some of the defendants' evidence was taken and filed out of time. No motion to suppress it has been filed. The orator objects to its consideration; and the defendants ask that it be considered, or the time extended to cover its taking. As no motion to suppress has been filed, it is allowed to stand and is considered. *Wooster v. Clark*, (9 *Fed. Rep.*, 854,) is relied upon by the orator on this point, but in that case there was a motion to suppress.

The case does not show that the defendants purchased their apparatus of Gee before he settled with the orator, and, therefore, entirely fails to show that he settled with the orator for the sales to the defendants. They stand by themselves, independently of Gee. (*Steam Stone Cutter Company v. Windsor Manufacturing Company*, 17 *Blatchf. C. C. R.*, 24.) That defence fails for want of proof.

The patent has nine claims. The second and third are not in controversy. Upon all the evidence, it is found that the first claim is not infringed; that the fifth and seventh are anticipated by letters patent No. 44,645, dated October 11th, 1864, granted to A. J. Morse, for a syrup fountain; and that the fourth, sixth, eighth and ninth are not anticipated and have been infringed by the defendants.

The parts of the thing patented in the fourth, sixth, eighth and ninth claims are definitely distinguishable from the parts claimed in the fifth and seventh claims; and the orator appears to have made the latter claims by mistake, supposing himself to be the original and first inventor of the parts claimed in them, without any wilful default, or intent to defraud or mislead the public, and not to have unreasonably neglected to enter a disclaimer of those parts, thus far. Therefore, he is entitled to maintain this suit, but without costs, on entering the proper disclaimer. (*Rev. Stat.*, sec. 4,922; *Burdett v. Estey*, 15 *Blatchf. C. C. R.*, 349.)

On filing a certified copy from the Patent Office of the record of a disclaimer by the orator of what is claimed in the fifth and seventh claims, let a decree be entered that the

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fourth, sixth, eighth and ninth claims of the patent are valid, that the defendants have infringed, and for an injunction and an account, without costs.

Arthur V. Briesen, for the plaintiff.

Philip Hathaway, for the defendants.

GEORGE HAYES vs. JOHN SETON. IN EQUITY.

Re-issued letters patent, No. 8,597, granted to George Hayes, February 25th, 1879, for an "improvement in ventilators," the original patent, No. 94,203, having been granted to him August 31st, 1869, are void, because a feature nowhere alluded to in the original patent has been inserted in the re-issue and made an essential part of the invention, and a necessary element in each claim.

Claims 3 and 4 of re-issued letters patent No. 8,674, granted to George Hayes, April 15th, 1879, for an "improvement in sky-lights," the original patent, No. 100,148, having been granted to him February 22d, 1870, and having been re-issued as No. 5,693, December 23d, 1878, are invalid, because of the omission from the latter described in those claims, of a stay-plate, which the original patent describes as an essential feature of the invention. Claim 6 is invalid, because it omits a moulding and a stay-plate, designated in the original patent as essential features of the invention. As to claims 7, 9, 10, 11, 12, 13, 14 and 15, any right which the patentee may have had to secure by letters patent what is covered by those claims was lost by delaying to assert such right for over 9 years from the date of the original patent.

Claim 1 of re-issued letters patent No. 8,675, granted to George Hayes, April 15th, 1879, for an "improvement in sky-lights," the original patent, No. 106,157, having been granted to him August 9th, 1870, considered. Claims 2 and 6 held not to have been infringed.

Claims 1 and 3 of re-issued letters patent No. 8,688, granted to George Hayes, April 29th, 1879, for an "improvement in sky-lights," the original, No. 112,594, having been granted to him March 14th, 1871, are invalid, because for different inventions from those described in the original patent. Claim 2 considered. Claim 5 held to be void.

Claim 3 of re-issued letters patent No. 8,689, granted to George Hayes, April 29th, 1879, for an "improvement in sky-light turrets and conservatories," held not to have been infringed.

(Before BENEDICT, J., Eastern District of New York, April 26th, 1882.)

BENEDICT, J. This action is founded upon five patents for various inventions employed in the construction of skylights, conservatories, and other glazed structures. Infringement of these patents is denied, and the validity of each of the re-issues is contested, upon the ground that the re-issue is not for the same invention as that described in the original patent, and the further ground that it was illegally issued.

The first patent set forth in the bill is re-issue No. 8,597, dated February 25th, 1879. The original patent, No. 94,203, put in evidence by the defendant, was issued August 31st, 1869. In it the invention is stated to consist of a metallic ridge-box, capable of being used as a ventilator, "so constructed as to admit of an ingress of pure air, which, coming in contact with the impure air of the building, is driven into an upper cavity, which, being perforated, gives the egress; the whole arranged so that all leakage is avoided." The method of constructing this ridge-box is set forth in the specification and a drawing connected therewith. The drawing represents the rafters of a building, resting against two ridge-boards, separated so as to leave an opening from the inside of the building, between the ridge-boards. Over this opening, and upon the outside of the roof, is a box or frame, G, perforated at its lower edge so as to admit the outside air to the interior of the box, and having a flange, F, outside of its junction with the roof, to prevent leakage between the roof and the box. Across the top of the box is a grating, J, for the passage of air from the interior of the box into a cap, I, constructed so as to cover the top of the box. This cap extends beyond the sides of the box, and is then perforated to permit the egress of air from the cap. Upon the grating rests a slide, K, perforated to act with this grating, so as to open or close the same, when desired. The single claim of this original is as follows: "The metallic flange, F, the frame, G, the grating, J, the slide, K, and the cap, I, constructed and arranged substantially as shown and set forth, for the purposes set forth." The invention described in this patent, and sought to be secured thereby, is a simple box, intended to act as a

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ridge, and at the same time serve as a ventilator, by allowing air from the outside of the building to enter the box, and, there mingling with the inside air, then to pass up through the box into the cap, and so out by perforations in the cap, as described. If, now, the re-issue be examined, it is observable that a feature nowhere alluded to in the original patent has been inserted, namely, a plate running up inside of and parallel with the sides of the box, and connecting at its foot with the flange outside the box. This inside plate is termed, in the re-issue, "an interior vertical flange," and its function is stated to be to form an air space or flue around the frame on the inside. This is a feature wholly new, and in the re-issue it is made an essential part of the invention, by the terms of the specification. It is also made a necessary element in each claim of the re-issue, by reference to the drawings and the specification. By the addition of this new element a substantial change in the structure claimed to have been invented is effected, and, as there is nothing in the original patent upon which a right to this new structure can be based, the re-issue must be held to cover an invention different from that described in the original, and to be for that reason void.

The next patent set forth in the bill is re-issue No. 8,674, dated April 15th, 1879. The validity of this patent is also disputed. The original patent, No. 100,143, issued February 22d, 1870, described a metallic bar or rafter intended to be used in the construction of glazed roofs. The construction of this rafter is particularly set forth. Its characteristic features are a short metal body, *a*, a stay-plate, *f*, a hollow moulding, *d*, the same being fitted together and arranged so as to form, on the upper side of the rafter, rabbets, *b*, *b*, for the glasses to rest on, and on the under side gutters, *c*, *c*, to catch the drip. No one of the characteristics of this rafter is claimed to have been first invented by the patentee. But he claims to have been the first one to employ them in the manner described, and thereby to have invented a rafter which is new in form and useful in result. The original patent also describes a form of cap-plate, to be fastened to the upper side

of the rafter, above the rabbets, between which and the ledge of the rabbet the glasses are to rest. No new result is claimed to have been attained by the use of this cap-plate, but the combination of the cap-plate with the rafter described is alleged to be new and useful. The original patent also describes a form of metal clip constructed to form a lap under and over the adjacent edges of the glasses of a glazed roof, in a direction crosswise to the rafter, and extending so that each end is covered by the cap-plate attached to the rafter. There are three claims in the original patent: “(1) The metallic bar or rafter, A, formed of a hollow sheet-metal body, a stay-plate, *f*, and hollow moulding, *d*, fitted together and arranged to form rabbets, *b*, *b*, for the glasses, and gutters, *c*, *c*, substantially as specified. (2) The combination of the cap-plate, *d*, with the hollow metal bar or rafter, A, essentially as shown and described. (3) The clip, I, in combination with the cross gutters, *h*, and the main gutters, *c*, *c*, substantially as specified.”

This patent was re-issued as No. 5,693, December 23d, 1873, and again in 1879, the latter re-issue being the patent set forth in the bill. This last re-issue has 15 claims, whereby the scope of the patent is largely extended. Of these the 3d, 4th, 6th, 7th, 9th, 10th, 11th, 12th, 13th, 14th and 15th are alleged to have been infringed. The invention described in the 3d claim of the re-issue consists of a hollow sheet-metal rafter, having a body, *a*, similar to the body of the rafter described in the original patent, rabbets, *b*, *b*, similar to the rabbets on the rafter described in the original, gutters, *c*, *c*, similar to the gutters of the rafter described in the original, and a hollow moulding, *d*, similar to the moulding, *d*, of the rafter described in the original patent. It will be perceived, from the description, that the subject-matter of the claim is a rafter differing from the rafter described in the original patent, in this, that it has no stay-plate, *f*. This stay-plate is, in the original, described as one of the characteristic and essential features of the plaintiff's invention. Its omission from the rafter described in the 3d claim of the re-issue effects a

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substantial change in the combination, and, therefore, is fatal to the claim. The claim, as made, is for a different invention from that described in the original patent, and, for that reason, must be held void.

The 4th claim of this re-issue is also illegal, for the same reason. It covers a rafter differing from the rafter described in the original, in that it has no stay-plate, *f*.

The 6th claim of the re-issue is for a hollow sheet-metal rafter having rabbets and gutters like those of the rafter described in the original patent, and also a cap-plate, *D*, attached. Both the moulding, *d*, and the stay-plate, *f*, which, in the original, are designated as essential features of the invention, are omitted from this claim, and a substantial change in the structure is thereby effected. This claim, therefore, is also void, for the reason that it covers a rafter not to be found in the original patent.

The remaining claims of this re-issue, alleged to have been infringed, in every instance are intended to enlarge the scope of the patent; and, while it may be true in regard to some of them, that the subject-matter of the claim is described or suggested in the original patent, it is evident, on the face of the patent, that there was no intention to assert that any of these matters formed part of the patentee's invention, and no intention on the part of the patentee to claim any exclusive right therein. Any person reading the original patent would be justified in the conclusion that no exclusive right to these matters was claimed by the patentee. Such being the case, according to the decision of the Supreme Court of the United States, in *Miller v. Brass Co.*, (104 *U. S.*, 350,) it is the duty of this Court to declare that any right which the patentee may have had to secure these matters by letters patent has been lost by delaying to assert such right for over nine years from the date of the original patent. Says the Supreme Court: "The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed." This language is applicable

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to the present patent, and, because due diligence was not used to rectify the omission, and to claim these combinations, this Court is compelled, by the authority cited, to hold that these claims are invalid, and the re-issue to that extent void.

The next patent set forth in the bill is re-issue No. 8,675, dated April 15th, 1879. To this re-issue, also, the defence is set up that it is illegal and void. The original patent was No. 106,157, dated August 9th, 1870. It relates to an improvement upon the rafter forming the subject of the patent No. 100,143, already referred to. The improvement is stated to consist in a novel arrangement of stay-plate in the rafter, whereby strength is secured without material addition to the weight; and also to consist in employing a novel construction of end clip; and also to consist in an indirect arrangement of escape opening from the main gutters, to provide for the escape of water, and prevent snow from beating in. A description of these improvements is given in the specification, with references to drawings annexed. The claims of the original patent are three in number, and are as follows: "(1) The arrangement of the vertical stay-plate, *a*, with the shell or body, *A*, of the rafter, moulding, *d*, rabbets, *b*, *b*, and gutters, *c*, *c*, substantially as specified. (2) The clip *G*, formed with corrugation, *b*, made to substitute gutters, and arranged and applied relatively to the glass as described. (3) The arrangement of the end outlets, *f*, *f*, with the hollow body of the lower transom, *F*, and escape apertures, *g*, substantially as specified. These claims, it will be observed, are, first, for a rafter constructed in a certain way; second, for the use of a clip of a certain form, when applied to the glasses of a glazed roof in the manner described; and, third, for the arrangement of outlets for the water to escape from the gutters by outlets under cover of the lower transom, and then by apertures in the end clip at the foot of the roof, arranged intermediate the outlets from the gutters. The elements of these combinations are all old; the combination of elements is what is claimed to be new.

The re-issue has 7 claims, of which the 1st, 2d and 6th are

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alleged to have been infringed by the defendant. The 1st claim of the re-issue, like the 1st claim of the original, is for the combination of the vertical inside plate with a rafter. But, while the rafter in the original has a moulding, *d*, the rafter in the first claim of the re-issue is described as having a high ridge, and no mention is made of the moulding, *d*, unless such mention be effected by the words "formed essentially as shown." If these words do not have the effect to constitute the moulding mentioned in the specification a part of the rafter and an element of the combination, then the claim is void, because for a different structure from that described in the original. If, on the other hand, the words "formed essentially as shown" carry with them every feature of the rafter described, including a "sheet-metal moulding properly secured to the rafter or bar and inside plate, and so connected to the gutters of the rafter as to constitute a brace to prevent their closing together, or a clamp to prevent their spreading, or both," then the first claim of the re-issue is for the same thing as that described in the 2d claim.

The 2d claim of the re-issue appears to be for the same invention described in the original patent, and I, therefore, pass to the question whether it has been shown to have been infringed by the defendant. In my opinion such infringement has not been proved. None of the bars or rafters made by the defendant have a moulding secured by rivets and bolts to the rafter or bar, and attached to the inside stay-plate by suitable bolts or rivets, so as to form a brace or clamp for the gutter. And this difference appears to me to take the defendant's structure out of the scope of the plaintiff's patent. But, if the defendant's rafter be held to be similar in construction to the rafter described in the claim under consideration, then the claim must, in my opinion, be held void, for the reason that a rafter similar to the defendant's, in the features under consideration, is described in Bunnett's English patent of 1856.

The subject-matter of the 6th claim of this re-issue is not found in the structures claimed to be infringing structures. In

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those structures there is but one set of openings, and those from the gutter directly to the outside.

The next patent set forth in the bill is re-issue No. 8,688, dated April 29th, 1879. Claims 1, 2, 3 and 5 are alleged to have been infringed. The subject-matter of the 1st claim of this re-issue differs from anything described in the original, No. 112,594, dated March 14th, 1871, in that one essential feature of the structure claimed in the re-issue is that it is "formed of one piece of folded sheet metal," and another essential feature is that the rafter has an "upward vertical extension forming a ridge." The rafter described in the original is there expressly stated to be formed of two sheets of metal, and the specification nowhere alludes to any "upward vertical extension." These differences have been insisted upon by the counsel for the plaintiff as being important. Moreover, from this first claim of the re-issue is omitted the under cap, which in the original is made an essential feature. These alterations and additions introduced into the re-issue, in my opinion, effect an alteration in the invention, and render the claim void, because for a different invention from that claimed in the original.

The 2d claim of this re-issue is for "the hollow metallic bar or rafter, constructed substantially of plates, *a* and *c*, bent to support or connect each other, and to form gutters, *b*, *b*, arranged in juxtaposition to each other, and under cover of the base or bases which support the glass, as herein set forth." In this claim, as in the original patent, mention is made of one feature of the invention, namely, that the gutters, *b*, *b*, are under cover of the bases that support the glass, so that the gutters offer little or no obstruction to the light passing through the glass. This appears to be the distinctive feature of the rafter sought to be secured by this claim. But, no such feature appears in the devices shown in Exhibit No. 11, opposite the marginal numbers 23 and 24, which are described as the infringing devices of the defendant. I am unable, therefore, upon the testimony, to find that this claim has been infringed, unless it be held that the construction of

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the gutters so as to keep them under cover of the bases is not an essential feature of the invention. But, if it be so held, then I must hold the claim void for want of novelty ; for, the invention described in this claim, so understood, appears in the patent issued to Edward Duisch, August 26th, 1848, set up in the answer and duly proved.

The 3d claim of re-issue No. 8,688, covers a clip, H, constructed of sheet metal, bent to form a groove, *h*, and a rabbet *i*, as set forth. The clip here described differs from the clip in the original patent in this, that a gutter, *k*, is in the original, (see specification, in 2d claim,) made an essential part of the invention. In the specification of the re-issue, and also in the 3d claim of the re-issue, the gutter is made optional. The effect of this change is to expand the patent and bring within its scope a form of clip not described in the original. The claim must, for this reason, be held void.

The 5th claim of this re-issue comes within the rule laid down in *Miller v. Brass Co.*, already referred to, and must be held void upon the authority of that case.

The 5th and last patent set up in the bill is re-issue No. 8,689, dated April 29th, 1879. The 3d claim of this re-issue is the only claim here in question. This claim is for "the swinging sashes, C, provided with exterior and overlapping elastic flanges, *f*, essentially as described." No infringement of this claim appears in the complainant's exhibit "Model of infringing sky-light, August 17th, 1881." The defendant's swinging sash has only a single flange, forming an ordinary joint, without any exterior and overlapping elastic flange, such as is described in the patent.

Upon these grounds the bill is dismissed, and with costs.

J. H. Whitelegge, for the plaintiff.

G. G. Frelinghuysen, for the defendant.

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JULIA ARMSTRONG, AS ADMINISTRATRIX, &C.

v.s.

THE MUTUAL LIFE INSURANCE COMPANY, OF NEW YORK.

By a policy of insurance, issued on an application signed by A., a life insurance company promised to pay "to A., his assigns," on a future day named, \$10,000, "or, if he should die before that time, then to make said payment to his legal representatives." If any claim be made under an assignment, proof of interest to the extent of the claim will be required." A. executed an assignment of the policy to H., and left it with the company, and both were delivered by the company to H. A., before the time named, died, by the hands of H. The administrator of A. sued the company to recover the \$10,000. On the trial, it appeared that H. planned the death of A. before the insurance, induced him to effect it and make the assignment, paid the first and only premium that was paid, and took his life for the purpose of obtaining the money on the policy. There was no evidence of any interest of H. in the life of A. No fraud in A. was alleged. The defendant requested the Court to instruct the jury, that, if the company made no contract with A., or if the real contract was with H., or if the policy was made and issued for the benefit of H., the plaintiff could not recover. Those instructions were not given and no questions were submitted to the jury on those aspects of the case: *Held*, no error.

The branch of the contract which ran to H. and his assigns was assignable, and the other branch was not. The general assignment to H. carried only the assignable branch, and only such interest in the life of A. as could be proved.

(Before WHEELER, J., Eastern District of New York, May 8th, 1882.)

WHEELER, J. This is an action of assumpsit upon a policy of insurance issued by the defendant upon the life of John M. Armstrong, the plaintiff's intestate, and has now, after verdict for the plaintiff and before judgment, been heard upon a motion of the defendant for a new trial, in review of questions of law.

The policy was issued upon an application signed by Armstrong, and, in its operative and material parts in question, ran: "The Mutual Life Insurance Company of New York,

* * in consideration of the application for this policy of

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insurance, * * which * * every person accepting, or acquiring any interest in, this contract, * * warrants * * to be the only statement upon which this contract is made, and * * of the payment * * at the date hereof * * and of the payment * * to be made * * during the continuance of this contract, does promise to pay to John M. Armstrong, of Philadelphia, Penna., his assigns, on the eighth day of December, in the year 1897, the sum of ten thousand dollars, * * at the office of the company in the city of New York, or, if he should die before that time, then to make said payment to his legal representatives.

* * If any statement made in the application for this policy be in any respect untrue, the consideration of this contract shall be deemed to have failed, and the company shall be without liability under it. * * The contract between the parties hereto is completely set forth in this policy and the application therefor, taken together. * * If any claim be made under an assignment, proof of interest to the extent of the claim will be required." Armstrong executed an assignment of the policy to Benjamin Hunter and left it with the company, and both were delivered by the company to Hunter. Armstrong died ; and, from the evidence received, and that offered, it is to be taken that he died by the hand of Hunter, who planned his death before the insurance, induced him to effect it and make the assignment, paid the first and only premium that was paid, and took his life for the purpose of obtaining the money on this and other policies. They were not related in any way, and no evidence was introduced or offered of any interest in fact which Hunter had in the life of Armstrong. The second defence set out in the defendant's pleadings alleges that Hunter, "being or pretending to be a creditor" of Armstrong, did so and so, and the defendant offered evidence to prove the facts set forth in that defence, without offering to prove that he was a creditor any more than that he pretended to be ; and this was not understood to be, and is not now understood to have been, any offer to prove any fact of indebtedness or other interest. The de-

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fendant requested the Court to instruct the jury, that, if the company made no contract with Armstrong, or, if the real contract was between the company and Hunter, or, if the policy was in fact made and issued for the benefit of Hunter, the plaintiff could not recover. These instructions were not given, and no question was submitted to the jury upon those aspects of the case. The principal questions are, whether the facts stated would defeat the plaintiff's recovery, and whether these instructions ought to have been given.

There is no evidence in the case of any intent to defraud or want of good faith on the part of Armstrong, and none was offered to be shown, nor any claim made that there was such. The misconduct and criminality relied upon for defence were wholly on the part of Hunter, and Armstrong was only his victim.

The first two of these instructions could not be given without submitting to the jury questions of contradiction, or variation, of the policy, which would be a subversion of one of the most important principles of the law of evidence relating to the effect of written contracts, that parol proof is not admissible to alter, contradict, enlarge, or vary them; and not only would violate the ordinary presumption of law, that the stipulations of the parties are written down in such contracts as finally settled upon and intended, but also the express provision of this contract, that the whole contract and its inducing statements are contained in itself. The other request would submit the effect of the contract and assignment to the jury, when such construction, when the facts to which the instruments apply are ascertained, is always for the Court. The whole of this part of the case must depend upon the true legal effect of these contracts.

The defendant promised Armstrong to pay his legal representatives ten thousand dollars, if he should die before December 8th, 1897. He did die before that day. The term representatives, or legal representatives, which is the same thing, for, none but legal would be intended, indicated the administrators. (*Wason v. Colburn*, 99 *Mass.*, 342.) The plaintiff

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is the administrator in Pennsylvania, the place of the domicile, and in New York the place of the contract, although some question was made about the effect of the letters in the latter place. She has brought this suit upon this contract, and upon these facts is entitled to recover, unless something further is shown to defeat it. If Armstrong parted with this contract to Hunter, so that his life was insured to Hunter, and to Hunter only, from the issuing of the policy to the day named, it is plain that no one could recover for this death. Not Hunter, for he criminally caused the death, and could become entitled to nothing by his crime. Not the administratrix, for she would have nothing to recover upon, and could acquire nothing from Hunter, for he could confer no greater right than he had. The contract was with Armstrong, and ran to his representative who would be included in him, so it was, doubtless, at his disposal. So, the question is, whether he did dispose of it to Hunter. The payment of the premium by Hunter would not make the insurance his. (*Triston v. Hardey*, 14 *Beav.*, 232; *Ætna Life Ins. Co. v. France*, 94 *U. S.*, 561.) The question must turn upon the construction of the written instruments. Choses in action were not assignable at common law, although for a valuable consideration paid they were assignable in equity. (*Bouv. Bac. Abr., Assignment, D*, and *Obligation, A*; *Winchester v. Hackley*, 2 *Cranch*, 342.) There is, however, no cause of action accrued upon a policy of life insurance until the death insured against happens. Still, there is no question but that the accruing right may, with the consent of the insurer, be transferred, so that, when it does accrue, it will accrue to the assignee, and become a right of action in his favor. Nor but that before it accrues it may be so assigned as to make the assignee an appointee to receive the funds. (*Page v. Burnstine*, 102 *U. S.*, 664.) Nor but that after it has accrued it may be assigned in equity, like other rights of action not made negotiable in terms. These limitations do not apply to contracts made negotiable in terms, like notes or bonds payable to the bearer or to the order of a payee named. These policies commonly run

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to some person and his or her executors, administrators and assigns. There are many cases in which they have been held to be assignable, but stress is laid upon that form. In *New York Life Ins. Co. v. Flack*, (3 *Md.*, 341, 1 *Bigelow Ins. Cas.*, 146,) Le Grand, Ch. J., laid stress upon the word "assigns." In *Pomeroy v. Manhattan Life Ins. Co.*, (40 *Ill.*, 398,) Walker, Ch. J., said: "The policy declares in terms that it is assignable. It provides for the payment of the money to the assured or to her assigns. So far then from such an instrument being prohibited, it is authorized by the terms of the policy." In *Mutual Protection Ins. Co. v. Hamilton*, (5 *Sneed*, 269,) McKinney, J., said: "By the terms of the policy the contract is with the assured, his personal representatives and assigns, and the promise, in fact, and in law, is to pay the money to the personal representative or assignee, as the case may be." And, in *Emerick v. Coakley*, (35 *Md.*, 188,) Grason, J., said: "So far from an assignment being prohibited by the terms of this policy, the amount of the insurance is made payable to her and her assigns." In *Koshkonong v. Burton*, (104 *U. S.*, 668,) the expression of opinion, whether the phrases, payable to the order of some person, or payable to some person, or his order, would, in a statute, include a contract payable to a railroad company or its assigns, was expressly waived, in the opinion of the Court, by Mr. Justice Harlan. A general assignment of all insurance policies, where the assignor has some which are assignable and some not, will not carry those not assignable, nor such as would be made void by assignment. (*Lazarus v. Commonwealth Ins. Co.*, 19 *Pick.*, 81.) This assignment is to be looked at in the light of these principles. One branch of the contract ran to Armstrong and his assigns, the other to his representatives; one was, by its terms, assignable and the other not; and by general words he assigned. The two expressions stand side by side in the instrument, so that their difference is apparent. According to these principles, it would seem to follow, that the assignment was intended to carry the branch made to be carried, and not the

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branch not so made; that the general words of the assignment are restrained by the particular words creating the subject of the assignment. The assignment could not rise higher than the instrument assigned. And, further, the instrument itself limits the rights to be passed to assignees. Such right could not extend beyond an interest in the life of the assured which could be proved. If the interest was that of a creditor, it would be limited by the amount of his provable debt. (*Cammack v. Lewis*, 15 *Wall.*, 643; *Thatch v. Metropole Ins. Co.*, 11 *Fed. Rep.*, 29.) As no debt is shown no interest is shown, and nothing is shown to have passed to the assignee. What did not pass to the assignee was left in Armstrong, and accrued to his representative, the plaintiff. As Armstrong was innocent, no right of his, or of those claiming through him, would be cut off by the wickedness of Hunter.

Other questions were saved by exceptions taken at the trial and allowed, but they have not been argued or relied upon in this hearing.

The motion is overruled, judgment is ordered upon the verdict, and the stay of proceedings is vacated.

Herbert T. Ketcham, for the plaintiff.

Joseph H. Choate and *Prescott Hall Butler*, for the defendant.

JOHN S. PERRY AND GRANGE SARD, JR., AS TRUSTEES, &C.

vs.

THE CO-OPERATIVE FOUNDRY COMPANY AND OTHERS.
IN EQUITY.

Claim 3 of re-issued letters patent No. 6,709, granted to Perry & Co., October 19th, 1875, for an "improvement in coal stoves," the original patent, No. 50,073, having been granted to Zebulon Hunt, as inventor, September 19th,

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1865, namely, "3. The adjoining flues, D and D', situated at the rear of the stove, and having walls built on the casing of the same, in combination with the illuminating doors or windows in the draft-chamber base-section," does not claim a patentable combination, because the flues operate in the same manner whether there are illuminating windows in the place designated or not, and the operation of such windows is the same whether the flues are arranged as described or not.

Claim 4 of re-issued letters patent No. 5,894, granted to John S. Perry, June 2d, 1874, for an "improvement in stoves," the original patent, No. 67,283, having been granted to Charles H. Frost, as inventor, July 30th, 1867, namely, "4. A grate or fire-bed with its central and outer sections made separately, and placed in a plane below the base of the fire-pot or combustion-chamber proper, within the draft-chamber base-section, and isolated from the walls of the same, substantially as shown and described," does not claim any patentable invention, there being no invention in substituting, in the given combination, an old grate made in two parts for another old grate made in one part, preserving the same relation of the grate to the fire-pot and to the ash-pit walls, when no destructive effect in the combination results from the substitution.

Claim 11 of said patent, namely, "11. The combination of mica or other transparent windows in the walls of the draft-chamber base-section, a grate or fire-bed placed in a plane below the base of the fire-pot or combustion-chamber proper, the free open space formed between the same, and the said grate or fire-bed isolated from the walls of the said draft-chamber base-section, substantially as shown and described," does not claim any patentable invention, because a window in an ash-pit cannot modify or affect the action or operation of the grate or of the anti-clinker space, or the isolation of the grate, nor is the operation or use of the windows affected or modified by the existence or non-existence of any of those features.

Claim 4 of re-issued letters patent No. 6,206, Division A, for an "improvement in base-burning stoves," granted to James Spear, January 5th, 1875, the original patent, No. 100,835, having been granted to said Spear, as inventor, March 1st, 1870, and re-issued to him in two divisions, Nos. 5,459 and 5,460, June 17th, 1873, and again re-issued in two divisions, January 5th, 1875, No. 6,206, Division A, and No. 6,207, Division B, namely, "4. The combination of a fire-chamber having its clinker-discharge end E grated or illuminating and projecting downward within the air-chamber S, a grate surface or fire-bed projecting beyond the inside diameter of the grate and clinker-discharge end of the fire-chamber, and the clinker-clearing opening R, substantially as herein described," does not claim a patentable invention, because it was only the substitution, in an existing combination, for a fire-chamber with its clinker-discharge end non-grated, of an existing fire-chamber with a grated clinker-discharge end, the substitution working no change in the operation of the parts.

Claims 6, 7 and 8 of said patent, namely, "6. The combination of the vertical clinker-cleaning opening R, and mica lights *d*", in doors opposite the opening,

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substantially as described." "7. The combination of the vertical clinker-cleaning opening R, mica lights d^2 , and clinker-cleaning doors C, opposite the opening, substantially as herein described." "8. The combination of a fire-chamber, the clinker-cleaning opening R, between the fire-chamber and grate surface, clinker-cleaning doors C, opposite the said opening, and mica lights d^1 , opposite the illuminating section E, of the fire-chamber, substantially as described," do not claim patentable combinations, there being no patentable combination between the mica lights and the other elements in those claims.

Claim 12 of said patent, namely, "12. The combination of a fire-chamber, having its slate and clinker-discharge end contracted and projecting downward, a grate-ring, K, and a clinker-cleaning opening, R, above the ring, substantially as herein described," does not claim any patentable invention, there being no relation or co-action between the lower end of the fire-pot and the laterally projecting grate and the space outside of the grate, which did not exist between the lower ends of prior uncontracted fire-pots and the projecting grates and the outside spaces in prior structures.

Claim 2 of letters patent No. 183,545, for an "improvement in heating stoves," granted to Andrew Dickey and John S. Perry, as inventors, October 24th, 1876, namely, "2. The combination of ascending and descending flues placed in the rear of a stove, a free open space between the top of the grate and the lower end of the fire-pot, sufficiently large to permit the removal of clinkers and other obstructions, illuminating windows opposite said space, and a grate or fire-bed having an open space between it and the walls of the stove, to admit of clinkers and other obstructions being dropped between the grate and said walls of the stove, into the ash-pit, substantially as described," does not claim a patentable combination, but only an aggregation of prior revertible flues with other features before existing in unison in the same stove, those features operating together in the same way whether with or without revertible flues.

(Before BLATCHFORD, J., Northern District of New York, May 8th, 1882.)

BLATCHFORD, J. This suit is brought on four patents: (1.) Re-issued letters patent, No. 6,709, granted to Perry & Co., October 19th, 1875, for an "improvement in coal stoves," the original patent, No. 50,073, having been granted to Zebulon Hunt, as inventor, September 19th, 1865; (2.) re-issued letters patent, No. 5,894, granted to John S. Perry, June 2d, 1874, for an "improvement in stoves," the original patent, No. 67,283, having been granted to Charles H. Frost, as inventor, July 30th, 1867; (3.) re-issued letters patent, No. 6,206, Division A, for an "improvement in base-burning" granted to James Spear, January 5th, 1875, the orig-

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inal patent, No. 100,335, having been granted to said Spear, as inventor, March 1st, 1870, and re-issued to him in two divisions, Nos. 5,459 and 5,460, June 17th, 1873, and again re-issued in two divisions, January 5th, 1875, No. 6,206, Division A, and No. 6,207, Division B; (4.) letters patent, No. 183,545, for an "improvement in heating stoves," granted to Andrew Dickey and John S. Perry, as inventors, October 24th, 1876.

(1.) As to the Hunt patent. The only claim alleged to have been infringed by the defendants is claim 3. That claim is this: "The adjoining flues D and D', situated at the rear of the stove, and having walls built on the casing of the same, in combination with the illuminating doors or windows in the draft-chamber base-section." It is clear that this is not a patentable combination. The flues operate in the same manner whether there are illuminating windows in the place designated or not; and the operation of such windows is the same whether the flues are arranged as described or not. The case is within the principle decided in *Hailes v. Van Wormer*, (20 Wall., 353, 368,) *Reckendorfer v. Faber*, (92 U. S., 347, 357,) and *Pickering v. McCullough*, (104 U. S., 310.)

(2.) As to the Frost patent. The original patent contained only one claim, as follows: "So arranging the cylinder *a*, and the direct and indirect draft openings and passages, that the said cylinder becomes an ascending channel for the escape of the products of combustion when the draft is direct, and a descending channel for the supply of air to the fire when the draft is indirect, substantially as set forth." The re-issue has 16 claims. A disclaimer of claims 2, 3, and 9 of the re-issue has been filed. Infringement is alleged of claims 4 and 11, which are as follows: "4. A grate or fire-bed with its central and outer sections made separately, and placed in a plane below the base of the fire-pot or combustion-chamber proper, within the draft-chamber base section, and isolated from the walls of the same, substantially as shown and described." "11. The combination of mica or other transparent windows in the walls of the draft-chamber

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base-section, a grate or fire-bed placed in a plane below the base of the fire-pot or combustion-chamber proper, the free open space formed between the same, and the said grate or fire-bed isolated from the walls of the said draft-chamber base-section, substantially as shown and described." It is shown that prior to Frost's invention fire grates with their central and outer sections made separately existed; and grates made in one part existed; and grates not touching the walls of the chamber in which they were placed existed; and grates arranged with relation to the fire-pot so as to leave an anti-clinker opening above the grate and below the base of the fire-pot existed; and grates of larger area than that of the base of the fire-pot existed; and illuminating windows in various parts of the walls of a stove existed. Claim 2, so disclaimed, covered the same combination as claim 4, omitting the feature of the separation of the central and outer sections of the grate. There was no invention in substituting, in the given combination, an old grate made in two parts for another old grate made in one part, preserving the same relation of the grate to the fire-pot and to the ash-pit walls, when no distinctive effect in the combination resulted from the substitution. That is this case, as to claim 4. As to claim 11, it is for the combination of transparent windows in the walls of the ash-pit with the disclaimed arrangement in claim 2. A window in an ash-pit cannot modify or affect the action or operation of the grate or of the anti-clinker space or the isolation of the grate, nor is the operation or use of the windows affected or modified by the existence or non-existence of any of those features. There was no invention in claim 11.

(3.) As to the Spear patent. The claims alleged to have been infringed are claims 4, 6, 7, 8 and 12, which are as follows: "4. The combination of a fire-chamber having its clinker-discharge end E grated or illuminating and projecting downward within the air-chamber S, a grate-surface or fire-bed projecting beyond the inside diameter of the grate and clinker-discharge end of the fire-chamber, and the clinker-cleaning

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opening R, substantially as herein described." "6. The combination of the vertical clinker-cleaning opening R, and mica lights d^2 , in doors opposite the opening, substantially as herein described." "7. The combination of the vertical clinker-cleaning opening R, mica lights d^2 , and clinker-cleaning doors C, opposite the opening, substantially as herein described." "8. The combination of a fire-chamber, the clinker-cleaning opening R, between the fire-chamber and grate-surface, clinker-cleaning door C, opposite the said opening, and mica lights d^1 , opposite the illuminating section E, of the fire-chamber, substantially as described." "12. The combination of a fire-chamber having its slate and clinker-discharge end contracted and projecting downward, a grate-ring K, and a clinker-cleaning opening R, above the ring, substantially as herein described."

There existed in prior structures a fire-chamber having its clinker-discharge end grated or illuminating and projecting downward into an air-chamber; a grate-surface or fire-bed projecting beyond the inside diameter of the clinker-discharge end of the fire-chamber; and a clinker-cleaning opening between the grate-surface and the fire-chamber above it. There also existed before, in combination, a fire-chamber with its non-grated clinker-discharge end projecting downward into an air-chamber, a grate-surface or fire-bed projecting beyond the inside diameter of the clinker-discharge end of the fire-chamber, and a clinker-cleaning opening between the grate-surface and the fire-chamber above it. It was no invention to substitute in such combination, for a fire-chamber with its clinker-discharge end non-grated, a fire-chamber with a grated clinker-discharge end. The substitution worked no change in the operation of the laterally projecting grate-surface end of the clinker-cleaning opening in unison with a fire-chamber having its clinker-discharge end projecting downward into the air-chamber. This makes claim 4 invalid.

As to claims 6, 7 and 8, there is no patentable combination between the mica lights and the other elements in those several claims.

Claim 12 remains to be considered. The clinker-cleaning opening is made by having a grate-ring and a space above it between it and the lower end of the fire-pot. The main idea embodied in the claim is the inward contraction of the lower end of the fire-pot. The specification says that the inventor, instead of making the lower section of the fire-chamber cylindrical, makes its clinker-discharge end smaller in diameter than the fire-pot above, so that he can use a broad laterally projecting grate-surface without enlarging the air-chamber below into which such clinker-discharge end projects downwardly, to the extent that would be necessary were the fire-pot of the same diameter throughout. The proof shows several prior instances of fire-pots with their clinker-discharge ends contracted and projecting downwardly, and provided with fire-beds or grates of less area than would have been necessary if the area of the base of the fire-pot had been equal to its area above; and of grates larger in area than the fire-chamber above, with a clinker-cleaning opening between the grate and such fire-chamber. Contracting the fire-pot necessarily allows the grate to be contracted and makes more space than there otherwise would be between the outer circumference of the grate and the wall of the chamber. There is no relation or co-action between the contracted lower end of Spear's fire-pot and the laterally projecting grate and the space outside of the grate, which did not exist between the lower ends of the uncontracted fire-pots and the projecting grates and the outside spaces, in prior structures. In view of all this there was no patentable invention in the idea that contracting the lower end of the fire-pot, with the consequent lessening of the area of the grate, would enlarge the outside space.

(4.) As to the Dickey and Perry patent. The only claim alleged to have been infringed is claim 2, which is as follows: "The combination of ascending and descending flues placed in the rear of a stove, a free open space between the top of the grate and the lower end of the fire-pot, sufficiently large to permit the removal of clinkers and other obstructions,

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illuminating windows opposite said space, and a grate or fire-bed having an open space between it and the walls of the stove, to admit of clinkers and other obstructions being dropped between the grate and said walls of the stove into the ash-pit, substantially as described." This claim is merely for an aggregation of prior revertible flues with the other three features before existing in unison in the same stove, namely, an anti-clinker opening, mica windows and an isolated grate, and does not contain any patentable invention. The last named three features operate together in the same way in a stove without revertible flues and in a stove with them, and no combined patentable result is due to the union.

The bill is dismissed, with costs.

Samuel A. Duncan, for the plaintiff.

Theodore Bacon, for the defendants.

JOHN S. PERRY AND GRANGE SARD, JR., AS TRUSTEES, &C.

vs.

THE CO-OPERATIVE FOUNDRY COMPANY AND OTHERS. IN EQUITY.

Claims 1 and 4 of re-issued letters patent No. 9,247, granted to John S. Perry and Grange Sard, Jr., trustees, June 8th, 1880, for an "improvement in stoves," the original patent, No. 54,988, having been granted to John R. Moore, as inventor, May 22d, 1866, and having been re-issued as No. 6,782, November 9th, 1875, namely, "1. The combination with the grate or fire-bed of a stove, of a downwardly-contracted fire-pot, the two being so arranged relatively to each other as to leave an opening between them, substantially as and for the purpose set forth." "4. The combination, in a stove, of a downwardly-contracted fire-pot and a dumping-grate, the two being arranged relatively to each other so as to leave an opening between them, substantially as and for the purpose set forth," do not claim patentable inventions, there being no invention in combining an old downwardly-contracted fire-pot with an old anti-clinker opening and dumping-grate.

Claim 1 of re-issued letters patent No. 9,252, granted to John S. Perry and

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Grange Sard, Jr., trustees, June 15th, 1880, for an "improvement in stoves," the original patent, No. 89,804, having been granted to Calvin Fulton, as inventor, April 27th, 1869, and having been re-issued as No. 5,907, June 9th, 1874, namely, "1. A stove grate so constructed and arranged relatively to the fire-chamber or fuel-receptacle as to leave between the two and around the edge of the grate a free open space, and to permit of the removal of clinkers and other refuse through such space, by use of the ordinary poker or slicer, substantially as described," does not claim a patentable invention, all that was done being to substitute an existing flat grate for a dished grate, in an existing arrangement of a dished grate and a fire-pot with an anti-clinker opening between them.

(Before BLATCHFORD, J., Northern District of New York, May 8th, 1882.)

BLATCHFORD, J. This suit is brought on two patents: (1.) Re-issued letters patent No. 9,247, granted to John S. Perry and Grange Sard, Jr., trustees, for an "improvement in stoves," June 8th, 1880, the original patent, No. 54,938, having been granted to George R. Moore, as inventor, May 22d, 1866, and having been re-issued as No. 6,732, November 9th, 1875; (2) re-issued letters patent No. 9,252, granted to John S. Perry and Grange Sard, Jr., trustees, June 15th, 1880, for an "improvement in stoves," the original patent, No. 89,304, having been granted to Calvin Fulton, as inventor, April 27th, 1869, and having been re-issued as No. 5,907, June 9th, 1874.

(1.) As to the Moore patent. The claims alleged to have been infringed are claims 1 and 4, which are as follows: "1. The combination, with the grate or fire-bed of a stove, of a downwardly-contracted fire-pot, the two being so arranged relatively to each other as to leave an opening between them, substantially as and for the purpose set forth." "4. The combination, in a stove, of a downwardly-contracted fire-pot and a dumping-grate, the two being arranged relatively to each other so as to leave an opening between them, substantially as and for the purpose set forth." These claims, in view of what existed before, show no patentable invention. An anti-clinker opening between a dumping-grate and the bottom of the fire-pot above it, with the grate larger in area than such bottom, existed before. Downwardly-contracted

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fire-pots existed before. There was no invention in combining an old downwardly-contracted fire-pot with an old anti-clinker opening and dumping-grate. The whole idea is in the anti-clinker opening. No new or different effect, in the combination which results in such opening, exists when the fire-pot above is contracted downwardly from that which exists when the fire-pot above is cylindrical.

(2.) As to the Fulton patent. The only claim insisted on at the hearing as having been infringed is claim 1, which is as follows: "A stove grate so constructed and arranged relatively to the fire-chamber or fuel receptacle as to leave between the two and around the edge of the grate a free open space, and to permit of the removal of clinkers and other refuse through such space, by use of the ordinary poker or slicer, substantially as described." An anti-clinker opening between a dished grate and a fire-pot existed before; and also a flat grate. All that the patentee did was to substitute a flat grate for a dished grate in the arrangement. The relation between the grate and the bottom of the fire-pot so as to leave the space between the two and the space around the edge of the grate, is the same in the two arrangements. The only difference is one of degree, as to the quantity of refuse which the rotation of the grate or the use of a poker will discharge, or one of convenience as to the character of the poker which will be used, and does not involve invention.

The bill is dismissed, with costs.

Samuel A. Duncan, for the plaintiffs.

Theodore Bacon, for the defendants.

Werthein & Gompertz v. The Continental Railway & Trust Co.

NATHAN G. MILLER vs. ELMORE A. KENT.

A plaintiff, by delaying for over a year after the removal of a cause, before moving to remand it, loses his right to insist that the petition for removal was not filed in time.

(Before WALLACE, J., Southern District of New York, May 17th, 1882.)

WALLACE, J. In the absence of any explanation of the delay in moving to remand this action, it should be determined that, by the delay of over a year since the cause was removed to this Court, before making this motion to remand, the plaintiff has lost his right to insist that the petition for removal was not filed in time. Motion denied.

Linus A. Gould, for the plaintiff.

Henry S. Bennett, for the defendant.

WERTHEIN & GOMPERTZ

vs.

THE CONTINENTAL RAILWAY AND TRUST COMPANY. IN EQUITY.

After the time for filing a plea in abatement in the State Court had expired, the defendant removed the suit into this Court, and then filed such plea in this Court: *Held*, that the plea must be overruled.

(Before SHIPMAN, J., Connecticut, May 18th, 1882.)

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SHIPMAN, J. This is a bill in equity which was made returnable before the Superior Court for the county of New London, on September 13th, 1881. If any service of the bill or complaint ever was made, it was made on July 29th, 1881. Upon the return day, the defendant entered its appearance in the State Court, and, without pleading or making other suggestion of a want of jurisdiction in the Court, filed, on September 22d, 1881, its petition and bond for the removal of the cause to this Court at the present term. The petition and bond were accepted, and, upon the second day of this term, the defendant filed in this Court a plea in abatement, for non-service of the complaint. One of the "General Rules of Practice" of the Superior Court of this State, and a rule very rigidly observed, is as follows: "All pleas in abatement, in the Superior Court, must be filed on or before the opening of the Court on the day following the return-day of the writ." By the uniform practice of the State Court, the defendant had, by its appearance and unexcused omission to file a plea in abatement on the second day of the term, waived any right to take advantage, in that Court, of defective or insufficient service. The plea was set down by the plaintiff for argument.

The important point in the case is this: Can a defendant who has, by inaction, lost his right, in the State Court, to object to the defective service of the complaint, and has thereafter removed the case to the Circuit Court, be permitted, in this Court, to plead in abatement such defective service?

Section 6 of the statute of March 3d, 1875, in regard to the removal of causes, (18 *U. S. Stat. at Large*, 472,) provides "that the Circuit Court of the United States shall, in all suits removed under the provisions of this Act, proceed therein as if the suit had been originally commenced in said Circuit Court, and the same proceedings had been taken in such suit in said Circuit Court as shall have been had therein in said State Court prior to its removal." It cannot now be doubted that the Circuit Court takes the case where the positive,

affirmative action of the State Court has left it. If the State Court has made an order, and thereafter the case is removed, it goes into the Circuit Court with the order, if unexecuted, to be executed, and, if executed, to remain a valid order. Thus, in *Duncan v. Gegan*, (101 U. S., 810,) Chief Justice Waite says: "The Circuit Court, when a transfer is effected, takes the case in the condition it was when the State Court was deprived of its jurisdiction. The Circuit Court has no more power over what was done before the removal than the State Court would have had if the suit had remained there. It takes the case up where the State Court left it off." This language had reference to a condition in which the case had been placed by the positive orders or decrees of the State Court, and not to a condition or state in which the case was by reason of the non-action of the removing party. But, I think, if one of the parties had, by his non-action within the time prescribed by the State Court, prevented himself from asserting a defence or an objection to the jurisdiction of the Court, and thereafter, in that Court, such defence or objection could not be considered as existing, that the Circuit Court takes the case in the condition in which the non-action of the party left it. In the present suit, the defendant had, by its conduct, declared that it abandoned the defences usually taken advantage of by dilatory pleas, and, so far as the State Court was concerned, in the absence of an excuse for non-compliance with the rule, was as effectually prevented from making a defence of non-service as if the Court had passed a decree that no dilatory plea would be permitted, and that, for the purposes of the case, good service had been made. The defendant having voluntarily admitted that the action was properly before the State Court, an admission which is perpetual while the case is in that Court, it is not proper that it should now be permitted to assert that the writ had never been served, and that the cause had never legally been in any Court.

If such a plea can be permitted in this case, it must also be permitted in a case which had remained in the State Court three months or six months, provided no pleadings had been

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filed and no admissions had been made. It is not in accordance with orderly practice to permit a defendant who had abandoned, in the State Court, by delay, all his defences of non-service, non-joinder of parties and the like, to remove his case into this Court and then go through the various dilatory pleas in their order. If no Court properly has jurisdiction of the case by reason of non-service of the complaint, but the defendant has chosen, in accordance with the rules of the Court to which the case is brought, to waive the defect and submit himself to the jurisdiction of the Court, the defect should be considered as forever waived.

In *Sayles v. North Western Ins. Co.*, (2 *Curtis' C. C. R.*, 212,) a case removed from a State Court, Mr. Justice Curtis said, *obiter*, upon a motion to dismiss the cause for want of jurisdiction, upon the ground that no service had been made, that the defendant who had removed a case from a State Court to the Circuit Court had, by his petition for removal, in which proceeding he was the actor, voluntarily treated the suit "as properly commenced and actually pending in the State Court, and he cannot, after it has been entered here, treat it otherwise," and that, after removal upon his petition, he cannot be permitted to say, in effect, that there was no suit before the State Court. For the decision of the present case, it is not necessary to take the ground which Judge Curtis was willing to occupy, for, it can well be assumed, that, if the defendant had pleaded in abatement in the State Court, and then had forthwith removed the cause, the petition for removal would not have been an abandonment of or inconsistent with the plea. Inasmuch, however, as the defendant has, by inaction, lost the opportunity of attacking, in the State Court, the validity of the service of the process, and has thereafter removed the case to this Court, I think that it comes in the same condition in which it left the State Court.

The plea is overruled.

J. Halsey, for the plaintiffs.

Lewis V. Stanton, for the defendant.

Fisher v. Meyer.

MORTON C. FISHER v. MORITZ MEYER AND OTHERS.

In an action for a conspiracy, the jury rendered a verdict for a large sum against two of the defendants, and one for \$100 against N. N. moved to set aside the verdict, on the ground that its smallness showed that the jury did not find the issues against him: *Held*, that the motion could not be granted.

(Before SHIPMAN, J., Southern District of New York, May 20th, 1882.)

SHIPMAN, J. This is a civil action to recover damages for a conspiracy. The jury returned a verdict in favor of the plaintiff, for a large sum, against two of the defendants, and for one hundred dollars against the defendant R. S. Newcombe. He now moves to set aside the verdict against him, upon the ground that it is an illogical and inconsistent verdict; that it shows, and the fact was, that the jury did not find that the allegations of the complaint in regard to him were true, for, if they had found that he committed the acts charged in the complaint, they were bound, under the charge of the Court, to render a verdict for a very large sum.

I think that I am obliged to regard the verdict of the jury for the plaintiff as an affirmative finding upon the issues which were presented for their determination. If it is permitted either to assume or to prove that the jury did not find what the verdict says they did find, the result of trials by jury will be thrown into great confusion. Starting from the position that the jury meant to find the issues for the plaintiff, and not merely that a certain sum of money should be paid to him without regard to the cause of action which was set forth in the complaint, it is true that the verdict against Mr. Newcombe was an inconsistent one, because, under the charge of the Court, if he committed the acts charged in the complaint, he was liable in a much larger sum than the jury gave. If the plaintiff had moved to set aside the verdict as against Mr. Newcombe, a serious question would have been presented, for, it is manifest that the verdict was not, in its

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amount, in accordance with the charge. But, if the plaintiff is satisfied with the verdict, I do not think that it should be set aside upon the motion of the defendant. He is not injured by the fact that it was for nominal damages, when it should have been for a very large sum, if the jury found the issue against him; and it is not permitted to me to infer that the verdict was not an affirmative finding upon the issues which were presented.

The motion is denied.

W. G. Wilson, for the plaintiff.

Joseph H. Choate, for the defendant.

CHARLES ROBINSON

vs.

THE NATIONAL STOCKYARD COMPANY.

The question whether a corporation of another State has been properly served with process in a suit in a Circuit Court cannot be raised by a demurrer to the complaint.

(Before WALLACE, J., Southern District of New York, June 8th, 1882.)

WALLACE, J. The defendant demurs to the complaint, and, pursuant to the Code of Procedure of this State, alleges as the ground of demurrer, "that it appears upon the face of the complaint that the Court has not any jurisdiction of the person of the defendant." The point sought to be presented, however, is, that the defendant has not been properly served with process, in that the law of Congress has been disregarded, which provides that no civil suit shall be brought, in any Circuit Court of the United States, "against an inhabitant of the United States, by any original process, in any other district than that of which he is an inhabitant, or in

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which he is found at the time of serving the writ." (*Rev. Stat.*, § 739.)

The complaint avers that the defendant is a corporation organized and existing under the laws of the State of New Jersey, and is a citizen of that State. Upon this averment, the defendant insists that it is to be presumed, not only that the defendant is not an inhabitant of this judicial district, but also that it was not found here when the writ was served.

The demurrer is untenable for two reasons. First, no such presumption can be legitimately indulged. Although a corporation of another State cannot migrate to this State, it may exercise its franchises and transact business here upon such conditions as the laws of this State may impose. It may consent to be "found" here for the purpose of being sued, within the meaning of the Act of Congress. (*Railroad Company v. Harris*, 12 *Wall.*, 65; *Ex parte Schollenberger*, 96 *U.S.*, 369.) The presumption that a corporation cannot be found out of the State which created it is no more cogent than that an individual is not to be found out of the State of which he is an inhabitant; and no one has ever supposed such a presumption obtains when an individual is the party.

Secondly. The point sought to be raised cannot be presented by a demurrer. The statute in question does not affect the general jurisdiction of the Court. It confers a personal exemption or privilege upon a defendant, which can be waived, and is waived by a general appearance in the action. (*Irvine v. Lowry*, 14 *Peters*, 293; *Flanders v. Insurance Co.*, 3 *Mason*, 158; *Kitchen v. Strawbridge*, 4 *Wash. C. C. R.*, 84; *Kelsey v. Pennsylvania R. R. Co.*, 14 *Blatchf. C. C. R.*, 89.) How can it be ascertained on demurrer, whether the party has been properly served with process or not, or whether the personal privilege has been waived? It is not the office of a complaint to exhibit the proceedings which have caused the defendant's appearance in the action. The complaint treats the defendant as present in Court and exhibits the issue between the parties. How the defendant came there is an extraneous matter. If the person selected as a defendant is

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one who is not subject to the jurisdiction of the Court, and this is apparent upon the pleading, the objection may be reached by demurrer. If a party is subject to the jurisdiction, it may be that jurisdiction has not been properly acquired, but this would present a question not of pleading but one of practice. The precise question was ruled in *Nones v. Hope Mutual Life Ins. Co.*, (5 How. Pr. Rep., 96,) where it was held that the defendant could not raise by a demurrer under the Code, upon the ground assigned here, the question whether he had been properly served with process.

This defendant is subject to the jurisdiction of the Court. If the writ was irregularly served there was an adequate remedy by a motion to quash.

Judgment is ordered for the plaintiff. Leave is granted the defendant to answer within twenty days, upon payment of costs of the demurrer.

Camillus G. Kidder, for the plaintiff.

Frank G. Haughwout, for the defendant.

ALBERT HALE

vs.

THE CONTINENTAL LIFE INSURANCE COMPANY. IN EQUITY.

A Connecticut corporation was sued in a State Court in Vermont, by a citizen of New Hampshire, by process served on a statutory agent required by the laws of the State for the purpose. The suit having been removed into this Court, the defendant demurred to the bill for want of sufficient jurisdiction, acquired by the service: *Held*, that the appearance and demurrer established the jurisdiction.

An endowment policy on a life, with a right to share in profits, to be applied towards premiums, is not made void by misrepresentations of the insurer's agent as to what the profits would amount to.

Equity has cognizance of a suit to account for such profits.

(Before WHEELER, J., Vermont, June 14th, 1882.)

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WHEELER, J. The bill alleges, in substance, that the orator was induced to take an endowment policy upon his life in the defendant company, with a right to share in profits, and to pay premiums thereon, partly in money and partly by his notes, through various representations made by the defendant's agent, to the effect that the profits would amount to enough to pay and cancel the notes, and otherwise as to what the insurance would amount to; that the time has elapsed and the defendant insists upon taking the amount of the notes from the amount of the policy, and refuses to pay what the agent represented the insurance would amount to upon the payments made; and prays that the transaction may be declared to be void, the notes decreed to be given up, the amount of premiums paid decreed to be refunded, with interest, and for general relief.

The plaintiff is a citizen of New Hampshire, the defendant of Connecticut, and the suit was brought in the State Court of Chancery, and has been removed to this Court. The service of process was made upon a statutory agent required by the laws of the State for that purpose. The defendant demurs to the bill for want of sufficient jurisdiction acquired by the service, and for want of equity, and the cause has been heard upon the demurrer.

The jurisdiction is to be measured by that of the State Court of Chancery. That Court is a Court of general equity jurisdiction and has full cognizance of all such cases as this, if any Court of Equity would have, between parties properly before it. As the defendant appeared and demurred, the parties are before the Court and jurisdiction has attached, and there can be no question remaining upon the demurrer except as to the equity of the bill, and that question is to be attended to.

The misrepresentations relied upon to avoid the contract were wholly as to what would be done thereafter, and not as to any past or then present fact. The orator had some insurance upon his life during the running of the policy; his claim now is that it does not amount to so much as the

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defendant represented it would, and as he expected. The fraud, if there is any, did not exist at the time of the making of the contract, and could not vitiate it. Such fraud would not work backwards. The insurance which the orator has had cannot be restored. There is no way to protect and preserve the rights of both parties but to carry out the contract according to its legal effect, as affected by such representations, estoppels, or additional contracts, as may be shown. The bill essentially lacks equity, in this aspect. The question remains whether there is any other ground stated for equitable relief, for, if there is, the bill ought to be retained, to prevent multiplicity of litigation,

As the bill stands, the orator is entitled to a share in the profits, to be applied on his notes. The share belonging to him is, apparently, a proper subject of accounting. The taking that account and applying the amount to which the orator is entitled to the satisfaction of the notes would be a proper subject for equitable cognizance. On that ground it appears that the bill should be retained.

The demurrer is overruled, the defendant to answer over by the next rule-day but one.

Gilbert A. Davis, for the orator.

Charles W. Porter, for the defendant.

WILLIAM E. DODGE AND OTHERS vs. AUGUSTUS SCHELL.

P. employed D., who was not an attorney at law, to prosecute a claim of his against the Government, to recover back duties illegally exacted, agreeing to pay him for his services a sum equal to one-half of the recovery, he to bear all the expenses. He employed attorneys and brought suit, in the name of P., against a collector of customs. For 12 years, and until he died, he had exclusive control of the suit. He made substitutions of attorneys and defrayed all expenses. After his death, his executrix controlled the suit, and substituted an attorney, and a judgment for over \$17,000 was recovered in

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favor of P. Then the Court denied a motion made by the defendant to vacate the appearance of the attorney substituted by the executrix. Then P. succeeded in ejecting such attorney, by the aid of the defendant's attorney, during the pendency of a writ of error. The judgment being affirmed, and the clerk refusing, on the mandate, to recognize any attorney but the one so ejected, P. moved to vacate the appearance of such attorney. The motion was granted, on P.'s paying to the executrix one-half of the amount of the judgment, without prejudice to his right to recover at law the whole or any part thereof.

(Before WALLACE, J., Southern District of New York, June 15th, 1882.)

WALLACE, J. This is a motion by the plaintiffs to vacate an appearance by an attorney in their behalf, as unauthorized. The attorney does not dispute the 'plaintiffs' right to substitute another attorney in his place, but insists they should not be permitted to do so until they fulfil their obligations to one whom the present attorney immediately represents.

Prior to 1864, Phelps, Dodge & Co., the plaintiffs, made an agreement with one Douglass, by which they employed the latter to prosecute a claim of theirs against the Government, growing out of alleged illegal exactions of duties and fees. By this agreement, Douglass undertook to "endeavor to establish the claim by legal decisions or otherwise." He was to be paid for his services a sum equal to one-half of the recovery, and was to bear all the costs and expenses of the proceedings. In 1864, he employed attorneys and brought suit, in the name of the plaintiffs, against the collector of the port of New York. From that time until 1876, when he died, he had the exclusive control of the suit. Substitutions of attorneys had been made by him and he had defrayed all the expenses. After his death, his executrix assumed control of the suit, and, under her administration, the present attorney was substituted as plaintiffs' attorney, and a judgment for \$17,498 was recovered for the plaintiffs. Until this judgment was recovered, the plaintiffs took no part in the proceedings, and apparently manifested no interest therein. Their first intervention in the suit was an effort to wrest its control from the executrix. A motion was made, ostensibly

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by the defendant in the suit, but apparently at the instigation or in the interest of the plaintiffs, to vacate the appearance of the attorney substituted by the executrix, upon the ground that the agreement between the plaintiffs and Douglass was champertous and void, and, if not, because the executrix had no power to appoint an attorney for the plaintiffs. This motion was heard before my predecessor in this Court and denied. Notwithstanding this, the plaintiffs succeeded, through the co-operation of the defendant's attorney, in ejecting the attorney from the suit during its pendency upon a writ of error from the judgment. Upon the affirmance of the judgment, however, when they applied to enter the mandate in this Court, the clerk of this Court refused to recognize the right of any attorney to appear for them except the present attorney. Hence this motion.

The plaintiffs now insist that their contract with Douglass was one for his personal exertions, and that by his death before entire performance they are released from all obligation to his executrix; that his interest did not survive his death; and that his executrix was not authorized to assume charge of the suit and appoint the present attorney.

That the executrix of Douglass has a valid claim against the plaintiffs for the value of his services up to the time of his death, the entire performance of the contract on his part being prevented by his death, is established by many authorities, among which are *Wolfe v. Howe*, (20 *N. Y.*, 197,) and *Spalding v. Rosa*, (71 *N. Y.*, 40.) It is more doubtful whether the executrix, upon Douglass' death, had the right to control the further prosecution of the action. But, after she was permitted to do so by the plaintiffs for a considerable period of time, and by her exertions and at her expense the judgment was obtained which the plaintiffs now seek to control, the objection to her conduct seems an ungracious one and should not be willingly enforced. The question of her authority to appoint the attorney must have been passed upon by Judge Blatchford, on the former motion to vacate the appearance, and been determined affirmatively; otherwise, the motion

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would have prevailed. Whether this authority was held to be within the scope and contemplation of the original contract between the plaintiffs and Douglass, or to be implied from the subsequent conduct of the parties, does not appear; nor is it material now. It suffices that there are no clamorous equities, in the present application, to urge a reconsideration of that adjudication. For thirteen years the plaintiffs acquiesced in what was done by Douglass and his executrix, but, from the time they ascertained that a large judgment had been recovered, they have seemingly been unwilling to recognize the agreement. They now present affidavits, in which, upon information and by innuendo, they impute fraudulent conduct to Douglass, not towards themselves, but towards the Government. They claim that the judgment would not have been affirmed upon the writ of error except for the exertions of counsel employed by themselves; but, it appears that competent counsel were employed by the executrix and ignored by the plaintiffs. They represent themselves willing to pay a reasonable compensation to the executrix; but, at the same time, they are insisting that they are under no legal obligation. They have made no definite proposition of payment.

Notwithstanding all this, the plaintiffs have the right to collect the judgment themselves, and for that purpose to appoint such attorney as they desire. They did not transfer the cause of action to Douglass, nor did the agreement effect an equitable assignment to Douglass of half of the proceeds of the suit. The suit now being at an end, the executrix has no interest in controlling its further disposition. She has, however, the right to assert any lien upon the judgment which exists by virtue of the agreement and the services rendered under it.

If Douglass had been an attorney, the agreement and services would have created a lien. There is no magic in the name "attorney," which conjures up a lien. It is the nature of the services and the control, actual or potential, which the mechanical or professional laborer has over the object in-

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trusted to him, which determines whether a lien is or is not conferred. The services which Douglass was employed to render, and did render, were, in character, attorney's services. As he appointed and discharged attorneys, he had, through them, the same control over the suit as if he had been an attorney himself. It is said, by Best, Ch. J., in *Jacobs v. Latour*, (5 Bing., 130 :) "As between debtor and creditor the doctrine of lien is so equitable that it cannot be favored too much." The remark is peculiarly applicable in the present case.

It would not be proper to determine now, or by any proceeding which cannot be reviewed, the amount of the lien to which the executrix is entitled. But, for present purposes, it should be held that she is not to be turned over to a suit at law, to receive that measure of compensation, at the end of the litigation, to which she is entitled now before surrendering her lien. It may be that the plaintiffs have equities and legal rights with which the Court has not been impressed, and from which they should not be definitely precluded by the present decision. It may ultimately appear that the executrix should not receive the whole compensation contemplated by the agreement; but the burden should rest upon the plaintiffs, who are seeking to dispossess her of a lien, to show that she is not entitled to the sum which they promised to pay when their claim should be established.

It is, therefore, ordered, that the plaintiffs' motion be granted, upon the payment to the executrix of Douglass of one-half of the amount of the judgment, without prejudice to the right of the plaintiffs to recover at law, if they can show themselves entitled, the whole sum, or such part thereof as may be just.

John E. Parsons, for the motion.

W. N. Cromwell, opposed.

Claffin v. McDermott.

HORACE B. CLAFLIN AND OTHERS

vs.

CHARLES F. McDERMOTT AND OTHERS. IN EQUITY.

A creditor's bill, founded on a judgment recovered against a debtor in a State Court in California, will not lie in a Circuit Court of the United States in New York, to set aside a fraudulent transfer of personal property made by the debtor in California, by means of collusive judgments and sales under executions thereon, no judgment having been obtained, or execution issued, in such Circuit Court, or in any State Court of New York.

(Before WALLACE, J., Southern District of New York, June 15th, 1882.)

WALLACE, J. The bill in this case is filed to set aside the transfer of certain personal property, made at San Francisco, California, by Kennedy & Durr to McDermott, by means of collusive judgments and sales under executions issued thereon, the complainants being creditors of Kennedy & Durr, and having recovered judgment in a State Court in California, against Kennedy and Durr, upon which an execution has been returned unsatisfied.

By a demurrer the question is presented whether the bill can be maintained here, no judgment having been obtained, or execution issued, in this Court, or in any Court of this State.

Actions like the present, in aid of the execution at law, are ancillary to the original suit, and are, in effect, a continuance of the suit at law, to obtain the fruit of the judgment, or to remove obstacles to its enforcement. Because this is the nature of such an action it has been decided that such a suit may be maintained in a Federal Court although all the parties reside in the State where it is brought, the judgment in the original suit having been recovered in the Federal Court in which the creditor's suit is brought. (*Hatch v. Dorr*, 4 *McLean*, 112.) It is, therefore, difficult to under-

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stand how such a suit can be maintained in any Court which does not exercise an auxiliary jurisdiction over the Court in which the original suit was brought.

Authorities are found, however, upon both sides of the question which is thus presented. In *Tarbell v. Griggs*, (3 *Paige*, 207,) the Court of Chancery of this State refused jurisdiction of a creditor's bill filed to obtain satisfaction of a judgment obtained in the United States Circuit Court for the Southern District of New York, upon which an execution had been returned unsatisfied. The judgment was treated as a foreign judgment, and as standing on the same footing with a judgment of the Court of another State. In *Davis v. Bruns*, (23 *Hun*, 648,) there was a similar adjudication. There, the plaintiff brought his action in the Supreme Court of this State, to set aside an alleged fraudulent transfer of real estate, having obtained a judgment against the grantor in the United States District Court for the Southern District of New York, and an execution on the judgment having been returned unsatisfied. In both of these cases it was held that the plaintiff's remedy at law had not been exhausted by the issuing and return of an execution upon a foreign judgment.

On the other hand, in *Wilkinson v. Yale*, (6 *McLean*, 16,) a creditor's bill was maintained in the United States Circuit Court, founded upon a judgment of the State Court of the State in which the Federal Court was sitting. The decision was placed upon the power of the Court to adopt a remedy given by the law of the State, when the remedy was one appropriate for the exercise of a Court of equity; but it was also assumed that the bill could be maintained irrespective of the State statute.

The cases in the Courts of New York seem most consonant with this principle. Obviously, the complainants are merely creditors at large of the defendants in the California judgment. The judgment of another State has no force in this, save what it derives from the laws of this State and the provision of the Constitution of the United States which relates to its effect as evidence. It ranks here as a simple contract debt. It does not have the force and operation of a

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domestic judgment, except for the purposes of evidence, beyond the jurisdiction where it is obtained. (*McElmoyle v. Cohen*, 13 *Peters*, 312.) It will not be contended that a creditor at large can invoke the jurisdiction of equity to enforce his claim, unless upon some of the recognized grounds of trust or administration of equitable assets. Unless some of these grounds exist, the remedy of the creditor is at law; and equity will not assist him until that remedy is exhausted. The remedy at law cannot be exhausted by the recovery of a judgment in a foreign jurisdiction, and by fruitless efforts to enforce it there. Except as a binding adjudication between the parties upon the subject-matter of the suit, the judgment of one of our sister States has no operation here upon the rights or the remedies of the parties to it. It cannot be a foundation for a creditor's bill here, any more than a judgment recovered in England or in Canada. It must be sued over here before it becomes a judgment for the purposes of any remedy here at law or in equity.

This conclusion is reached with less reluctance, in view of the practical objections which would exist if foreign judgment creditors were permitted to resort to this jurisdiction to remove obstacles in the way of their legal remedies. These obstacles always exist in the jurisdiction where the judgment is obtained. Frequently, their removal involves the consideration of the force and effect of remedies and rights created by local law, which are more appropriately adjudicated by the local tribunals. The present case affords an illustration in point. This Court is asked to examine into a fraudulent perversion of the proceedings of a Court of a distant State and set aside transfers based upon those proceedings, when the actors, the transactions, and the property are all within that State. Such a jurisdiction should not be willingly assumed.

The demurrer is sustained.

Charles W. Gould, for the plaintiffs.

Everett P. Wheeler, for the defendants.

Jacobson v. Allen.

AUGUSTUS JACOBSON, AS RECEIVER, &C.

vs.

JOHN ALLEN, AS EXECUTOR, &C., AND OTHERS. IN EQUITY.

A receiver of "all the estate, property and equitable interests" of an insolvent banking corporation, created by the State of Illinois, cannot enforce against a stockholder in the corporation the liability imposed by the statute of Illinois on each stockholder for double the amount of his stock, such liability being one in favor of creditors of the bank and not in favor of the corporation.

(Before WALLACE, J., Southern District of New York, June 20th, 1882.)

WALLACE, J. Without passing upon subordinate questions raised by the demurrer, the bill must be held bad because the right of action sought to be enforced does not exist in favor of the complainant.

The defendants are sued as stockholders of the Bank of Chicago, an insolvent corporation of the State of Illinois, and the bill seeks to charge them with a liability imposed by one of the sections of the incorporating Act, which provides that "each stockholder shall be liable to double the amount of stock held or owned by him, and for three months after giving notice of transfer." The bill alleges, that, in a suit brought by a creditor of the bank in the Superior Court of Cook County, Illinois, the complainant was duly appointed, by that Court, "receiver of all the estate, property and equitable interests of said bank," and duly qualified, and has ever since acted as such receiver.

Unless the right of action to recover the statutory liability of stockholders was part of the "estate, property or equitable interests" of the bank, it did not pass to the receiver under his appointment. Not only because of the allegation of the bill, but also from the inherent nature of a receiver's title, the complainant did not acquire the right to en-

force the statutory liability if it existed only in favor of creditors of the bank and not in favor of the corporation.

It is not contended that the corporation could have enforced this liability against the stockholders, but the position is taken, that, upon the insolvency of the corporation, a fund arises, by force of the statutory provision, for the benefit of the creditors of the corporation, which is to be deemed part of the equitable assets of the corporation. Undoubtedly, such provisions are intended to create a fund for the benefit of creditors, in case of the insolvency of the corporation; but, whether the creditors can resort to the fund jointly or only severally, and whether the right of the creditor is one at law or one to be enforced in equity, and in subordination to the rights of the whole body of creditors, depends, in each case, upon the terms of the particular statute. Obviously, the fund resembles an asset of the corporation more nearly when, by the terms of its creation, it constitutes an equitable fund for the common benefit of all the creditors, than it does when it is secured to the creditors severally and at law.

Under this particular statute, it has been determined, by the Courts of Illinois, that a creditor of the corporation may sue individually and at law, (*McCarthy v. Lavasche*, 89 Ill., 270;) and, under a similar statute, it was held by the same Court, that the creditor's right of action was not divested by the appointment of a receiver of the corporation. (*Arenz v. Weir*, 89 Ill., 25.) Undoubtedly, if the liability were merely a several one in favor of the creditors, no one creditor could be divested of his right of action by any proceeding or judicial decree to which he was not a party; and, therefore, a receiver appointed in a suit brought by one creditor against the corporation could not acquire the rights of the other creditors. (*Wincock v. Turpin*, 96 Ill., 135.) It has not been definitely determined by the Courts of Illinois that a suit might not be maintained in equity by all the creditors, or one in behalf of all, to recover of the stockholders, when the liability is imposed in the terms employed in the present

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statute. If the question were to be determined irrespective of the adjudications of that State, it would hardly be deemed doubtful that the Act creates a fund which may be pursued in equity, for the common benefit of all the creditors. (*Briggs v. Penniman*, 8 Cow., 387; *Mathez v. Neidig*, 72 N. Y., 100; *Terry v. Little*, 101 U. S., 216.)

Assuming that such is the character of the fund, it still remains for the complainant to maintain that it is property or assets of the corporation and passes to him by virtue of his appointment as receiver. No case is cited to support this contention. In *Weeks v. Love*, (50 N. Y., 571,) it is said, *obiter*, that the stockholders' liability may be treated as corporate property. That was an action at law, by a creditor against the stockholder, in which it was sought to be maintained that the creditor must resort to equity; but the action was sustained. Numerous authorities recognize the right of a receiver or assignee in bankruptcy to sue for the recovery of unpaid stock; but, in these cases, the corporation could have maintained the action. So, also, the right of such an officer is maintained, to recover assets of the corporation which the corporation could not have recovered because it would have been estopped from asserting its own fraudulent or illegal conduct in the disposition of the assets. These authorities fall short of the present point.

The receiver of an insolvent corporation makes his title through the corporation. He cannot, through his appointment, acquire that which the corporation never had. He represents the creditors of the corporation in the administration of his trust, but his trust relates only to the corporate assets. As trustee for creditors, he represents them in following the assets of the corporation, and can assert their rights in cases where the corporation would not be heard. He is not a trustee for creditors in relation to assets which belong to them individually or as a body. (*Bristol v. Sanford*, 12 Blatchf. C. C. R., 341.) As is said in *Curtis v. Leavitt*, (15 N. Y., 44,) "he is, by law, vested with the estate of the corporate body and takes his title under and

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through it. It is true, indeed, that he is declared to be a trustee for creditors and stockholders; but this only proves that they are the beneficiaries of the fund in his hands, without indicating the sources of his title or the extent of his powers."

The liability of the stockholders to creditors may be regarded as a collateral statutory obligation of the shareholders for the benefit of the creditors, by which the former become sureties to the latter for the debts of the corporation. (*Hecks v. Burns*, 38 *N. H.*, 145.) It matters not whether it is an obligation to each creditor severally or to all jointly; in either case the character of the obligation is the same. Neither a receiver, nor an assignee in bankruptcy, nor an assignee under a voluntary general assignment for the benefit of creditors, each of whom represents creditors as well as the insolvent, acquires any right to enforce a collateral obligation given to a creditor, or to a body of creditors, by a third person, for the payment of the debts of the insolvent.

The demurrer is sustained.

Thomas Thacher, for the plaintiff.

Henry W. Johnson, Michael W. Divine, William W. MacFarland and Edward Patterson, for the defendants.

ANSON SEARLS

vs.

CHARLES C. BOUTON AND OTHERS. IN EQUITY.

The second claim of re-issued letters patent No. 9,297, granted to Anson Searls, July 18th, 1880, for an improvement in whip-sockets, the original patent, No. 150,195, having been granted to him April 28th, 1874, is void, under the cases of *Miller v. Brass Co.*, (104 *U. S.*, 850,) and *James v. Campbell*,

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(*Id.*, 356,) because the claim of the original was limited to a bell-shaped top and the claim of the re-issue is not so limited.

The question of delay in the re-issue held to be open for consideration under the answer.

(Before WHEELER, J., Southern District of New York, June 22d, 1882.)

WHEELER, J. This cause (*ante*, p. 426,) has now been further heard as to the validity of the re-issued patent involved therein, No. 9,297, dated July 13th, 1880, the original of which, No. 150,195, was dated April 28th, 1874, for an improvement in whip-sockets, as affected by the original patent, now in evidence. The only question is whether the original will sustain the re-issue.

It is argued for the orator that the only form of this question raised by the answer is, whether the re-issue is for the same invention as that described in the original, and that no question of laches can properly be considered, because no delay is alleged. Without considering whether it is necessary to set that defence up separately in the answer in order to raise that question, it is sufficient now to notice, that, in this answer, it is alleged that the original patent was not surrendered because it was invalid or inoperative by reason of claiming too much, and that in the re-issue the claims have been broadened so as to cover more than the orator had the right to claim as new. This seems to sufficiently put in issue the propriety and lawfulness of the enlargement of the claims and the scope of the patent at the time and in the manner in which it was done.

The original patent was for a whip-socket having a bell-shaped top, and a rubber disc for steadying the whip, fitting into an inner groove near the top in the bell-shaped part, and appears to cover no whip-sockets not having such a shaped top. The re-issue is for such whip-sockets generally, without any limitation to that form of top. The patent is, to that extent, and, perhaps, in some other particulars, enlarged in the re-issue. That brings this case within the principles of

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Miller v. Brass Co., (104 U. S., 350,) and *James v. Campbell*, (*Id.* 356,) as now understood.

Let the decree heretofore ordered be so modified as to dismiss the bill as to this patent.

J. P. Fitch, for the plaintiff.

N. Davenport, for the defendants.

EDWIN D. BRAINARD vs. FREDERICK CRAMME. IN EQUITY.

Claim 4 of re-issued letters patent No. 8,099, granted to Edwin D. Brainard, as assignee of Frederick Hinckel, February 26th, 1878, for an improved machine for washing shavings in breweries, the original patent, No. 85,528, having been granted January 5th, 1869, namely, "A vessel capable of rotation on its axis, in combination with a perforated pipe for producing jets of water within such vessel, substantially as described," is substantially identical with claim 1 of the original, namely, "A hollow perforated shaft, in combination with the cylinder and the frame arranged and operating substantially in the manner and for the purpose described," and is valid, although, in the original, the cylinder is described as suspended horizontally on the shaft, and as rotating by the revolution of the shaft, while in the re-issue it is not stated to be suspended horizontally, but to be so constructed as to admit of a rotating or reciprocating action.

The re-issue containing claims for the process worked out by the apparatus, which claims were not in the original, the plaintiff was allowed to recover on claim 4 of the re-issue, without costs, on filing a disclaimer as to the claim for the process.

(Before WALLACE, J., Southern District of New York, June 26th, 1882.)

WALLACE, J. The doubtful question in this case is whether the re-issued patent on which this action is founded is for the same invention as that described and claimed in the original. The original patent, No. 85,528, bears date January 5th, 1869, and is for an improved machine for washing shavings in breweries. As described in the specification, the invention consists of a hollow perforated shaft in combination

with a hollow cylinder, hung together in a frame, for the purpose of discharging a fresh current of water in jets upon the contents of the cylinder while it revolves. The frame is described merely as a strong rectangular frame supported on legs. The cylinder is made with open staves or perforated sides, and is suspended horizontally in the frame, on a hollow shaft. The shaft extends through the cylinder and is perforated with a series of holes on all sides. One end of the hollow shaft is fitted to run in a thimble, on which is screwed a pipe for conveying water into the shaft; the other end of the shaft is closed and carries a crank. The cylinder has a removable cover. In operation, the shavings to be washed are put into the cylinder, the cover is fastened and the shaft is revolved by turning the crank; the cylinder rotates upon the shaft and the current of water introduced into the perforated shaft is discharged in jets upon the shavings, as their surfaces are presented by the revolution of the cylinder. The dirty water escapes through the openings of the cylinder at its lower side. The patentee states, in his description, that cylindrical washing machines are in use, and he disclaims the same as his invention. The first claim is, "A hollow perforated shaft, in combination with the cylinder and the frame arranged and operating substantially in the manner and for the purpose described."

The re-issued letters patent, No. 8,099, granted to the plaintiff as assignee of Frederick Hinckel, bear date February 26th, 1878; and herein the patentee attempts to secure to himself both a process and the apparatus for carrying out the process, for washing shavings in breweries. The apparatus is described substantially as in the original patent, except that, in the original, the cylinder is described as suspended horizontally upon the hollow shaft, and as rotating by the revolution of the shaft, while in the re-issue the cylinder is not stated to be suspended horizontally, but to be so constructed as to admit of a rotating or reciprocating action. Considerable new matter, however, descriptive of the process, is introduced. Two of the claims relate to the process. The third and fourth relate to the apparatus and are as follows:

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“Third. The combination of a vessel capable of rotation on its axis with means for producing jets of water within it, substantially as described. Fourth. A vessel capable of rotation on its axis, in combination with a perforated pipe for producing jets of water within such vessel, substantially as described.”

So far as the re-issue is an attempt to secure to the patentee the process for the treatment of brewers' shavings, it is entirely inoperative. The process, as described and claimed therein, is merely for the treatment of the shavings by the employment of the described apparatus. It is difficult to appreciate any practical benefit which is obtained by the patentee by calling his patent a process patent instead of one for the machine. And it is conceded that, as everything essential to the process was pointed out in the original patent nine years before the re-issue, and in the meantime other inventors have occupied the ground covered by the general subject-matter of the invention, what was therein pointed out and not claimed is to be deemed abandoned to the public, within the recent decisions relative to re-issues. As to the claims for the process, the complainant proposes to file a disclaimer.

The claims in the re-issue relating to the apparatus, considered literally, are broader than the claim in the original. Indeed, they describe the functions rather than the mechanism of the apparatus. But, they are to be construed with reference to the specification, and so, if consistent with the language used, as to secure to the patentee the invention which is described. They are not to be construed, if the language will reasonably bear such an interpretation, so as to embrace any invention broader in its scope than that in the original patent.

In view of the state of the art, and of the apparatus described in the original patent and shown in the drawings, the patent was for a new combination of old parts, which consisted in locating the hollow perforated shaft within a hollow cylinder having openings in its sides, and suspended horizon-

tally in a frame, so that cylinder and shaft rotate together, by turning the crank of the shaft.

The gist of the invention was in the adaptation of the several parts for the specific purpose desired. The peculiar materials to be washed required special instrumentalities. A machine for cleaning rags, containing a revolving horizontal cylinder mounted on hollow axles, through which water can be conveyed to the contents of the cylinder and can escape through perforated plates at the end, is shown in the English patent to Foudrinier, of 1854. But in this patent there is not shown a hollow shaft running into the cylinder, to discharge jets of water upon the contents of the cylinder.

A machine for forcing liquids into the contents of a vessel capable of rotation on its axis, through a perforated vertical shaft, is shown in the English patent to Givine, in 1851. But the contents are placed in cages of wire gauze and the vessel itself is tight. These two English patents present the nearest approximation, in the prior state of the art, to the present. They are not anticipations; neither of them would satisfactorily do the work required of a machine for washing brewers' shavings. There can be no doubt that it required thought and inventive faculty to organize the distinctive features of these prior inventions into the present mechanism, so as to adapt them to the special work to be done.

Reverting, now, to the claims of the re-issue relating to the apparatus, the doubt which they suggest is, whether they are not to be construed as broad enough to embrace a cylinder which is not horizontally suspended and which is not rotated by means of the hollow shaft. The vessel capable of rotation on its axis, and the perforated pipe for producing jets of water within such vessel, are clearly referable to the cylinder and the shaft described in the specification; but the doubt is, whether the specification of the re-issue does not describe a cylinder which need not be horizontally suspended, and which will admit of a reciprocating as well as a rotating action upon the shaft. Considered in its entirety, it would seem, from the specification, that the horizontal cylinder is

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indispensable to the efficiency of the mechanism ; and there is nothing in the description which refers to any means for conveying reciprocating action to the cylinder. In the absence of anything in the proofs to indicate any reason for an expansion of the claim, and in view of the apparent necessity of employing a cylinder which is suspended horizontally and is rotated by the shaft, the conclusion is reached, that the fourth claim of the re-issue can be sustained as substantially identical with the first claim of the original patent.

The defendant has appropriated the invention thus secured to the complainant, and it may be that the desire to protect the complainant against the piracy of his invention has led to undue liberality in the construction of the re-issue. Precedents are not wanting, however, to justify such a broad construction. *Swain Turbine & Manufacturing Co. v. Ladd*, (2 *Banning & Arden Pat. Cas.*, 488,) is in point, where a more nebulous claim than the present was sustained, by limiting it to the particular mechanism described. This case was affirmed by the Supreme Court. (102 *U. S.*, 408.)

It is not intended to intimate that the defendant's patent is not a valid one. Very possibly his mechanism is an improvement upon the complainant's, but this will not protect him from the charge of infringement.

The complainant will have a decree for an injunction and accounting, but without costs, upon making due proof, on notice to the adverse party, of the filing of a disclaimer as to the claims for the process, according to law.

Andrew J. Todd, for the plaintiff.

Edward Fitch, for the defendant.

Ransom v. Geer.

AARON P. RANSOM AND WARREN A. RANSOM, EXECUTORS, &C.

vs.

DARIUS W. GEER. IN EQUITY.

G., a co-executor with A. and W., borrowed the funds of the estate, and gave bonds and mortgages therefor to himself and his co-executors, as obligees and mortgagees. On a sale of the mortgaged property under a foreclosure of the mortgages, there was a deficiency. On a settlement of their accounts, the executors were authorized to retain a certain sum as commissions, one-third of which was the share of G. The co-executors brought this bill in equity for a decree to apply to the debt of G. his share of commissions: *Held*, that the bill would lie, the sole remedy being in equity.

Held, also, that the plaintiffs were entitled to the share of a composition in bankruptcy payable by G., to be computed on such deficiency; and that the debt was not discharged by the composition, because there had been no payment or offer to pay according to the composition.

(Before WALLACE, J., Southern District of New York, June 27th, 1882.)

WALLACE, J. The complainants' bill is filed upon the theory that they are entitled to invoke the jurisdiction of equity to set-off the cross demands between themselves and the defendant.

The complainants and defendant were co-executors and trustees under the will of Jonathan D. Ransom, deceased, and, upon several occasions, the defendant borrowed a portion of the trust funds and executed and delivered his three several bonds and mortgages therefor. The defendant was named as one of the obligees in the bonds, and as one of the mortgagees in the mortgages executed by him. He failed to make payment, and the mortgages were foreclosed in the Court of Chancery of New Jersey, and the mortgaged premises were sold under the decree, on the 7th day of October, 1879. The sale failed to satisfy the mortgages and a deficiency arose in the sum of \$21,290 40.

The bill alleges, and the answer admits, that, under the

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decree of the Surrogate of the city and county of New York, the accounts of the executors and trustees have been finally settled, and that they are authorized to retain out of the funds remaining in their hands the sum of \$14,034 60, as commissions, of which the share of the defendant is one-third, or \$4,678 20; that the defendant's share still remains undrawn; and that he refuses to apply such sum towards the payment of his indebtedness to the estate and is insolvent. The defendant insists that the facts do not present a case for equitable cognizance and that the complainants' remedy is at law.

Upon the facts alleged and proved the complainants are not required to maintain the suit upon the theory that equity will set-off the cross demands of the parties because of the insolvency of the defendant. The defendant is both an obligor and an obligee in the bonds, and could not be both plaintiff and defendant in an action at law founded upon them. (*Moffatt v. Van Mullingen*, 2 *Chitty's R.*, 539; *Teague v. Hubbard*, 8 *B. & C.*, 345; *Smith v. Lusher*, 5 *Cow.*, 688.) The remedy of the co-obligors is in equity. (*Bradford v. Williams*, 4 *How.*, 576.) As is stated in *Broom on Parties*, (sec. 134,) owing to the community of interest, no action lies at law by one executor or administrator against his co-representative, but the remedy is in equity. See, also, *Smith v. Lawrence*, (11 *Paige*, 206.) In *Warner v. Spooner*, (3 *Fed. Rep.*, 890,) the right of a bankrupt to prove against his estate a demand in favor of an estate of which he is an administrator, is placed upon the equitable jurisdiction possessed by Courts of bankruptcy.

The complainants are, therefore, properly here to recover the deficiency arising upon the sale of the mortgaged premises, and, as they have in their hands the funds out of which the defendant's commissions are payable, they can retain the sum due as his share and apply it to reduce his indebtedness to the estate.

It is insisted in defence of the action, that the defendant is discharged from his indebtedness to the estate by his com-

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position proceedings in bankruptcy. So far as the rights of the parties depend upon the effect of the composition, it must be held, on the authority of *Paret v. Ticknor*, (16 *N. B. R.* 315,) and *In Re Colby*, (*MS., U. S. Dist. Court, Southern Dist. of New York*,) that the executors are entitled to be paid the composition percentage upon the amount of the indebtedness for which their security proved to be insufficient.

The defendant, while alleging the composition proceeding as a bar to the action, does not allege or prove that he has ever offered to pay the complainants according to the terms of the composition resolution. The creditors' debt is not discharged by the resolution only. It is discharged only when the terms of the composition are carried out. (*In re Reiman*, 12 *Blatchf. C. C. R.*, 562; *In re Hatton*, *L. R.*, 7 *Ch. App.*, 723; *Edwards v. Coombe*, *L. R.*, 7 *Com. Pleas*, 519; *Goldney v. Lording*, *L. R.*, 8 *Q. B.*, 182.) The bankruptcy Court, in the exercise of its supervisory jurisdiction, can enforce the composition as against creditors or as against the debtor, but even that Court will not restrain a creditor from pursuing his action to recover his debt, when the debtor has failed to carry out the provisions of the composition. In the present case, the defence assumes the aspect of an accord without a satisfaction.

The sum due to the executors as unsecured creditors was not established until the sale of the mortgaged premises, October 7th, 1879. That was a judicial sale, to which the defendant was a party, and he is precluded from asserting that the sum realized was not a fair sum. Doubtless, a tender of performance of the composition resolution by the defendant at that time, or within a reasonable time after, would have satisfied the law. Whether, in view of the subsequent delay, the Court of bankruptcy would interpose to require the executors to accept the composition percentage and would have stayed this action to recover the indebtedness, is a question which does not require decision here; this Court has not the power to do so. For present purposes, the defendant is to be considered as seeking to avail himself of a discharge without

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having performed the conditions essential to its efficacy as a defence; and a Court of equity can no more qualify or enlarge its operation than could a Court of law.

A decree is ordered for the complainants, adjudging due to them from the defendant the sum of \$21,290 40, with interest from October 7th, 1879, and authorizing the complainants to apply thereon the sum of \$4,678 20, the defendant's share of the commissions, in discharge of the liability of the complainants' estate to the defendant personally, with costs to the complainants.

John Notman, for the plaintiffs.

David J. H. Willcox, for the defendant.

WILLIAM GARDNER AND OTHERS

vs.

MARTIN HERZ AND JOHN K. MAYO. IN EQUITY.

Claim 2 of re-issued letters patent No. 9,094, granted, February 24th, 1880, to Oliver L. Gardner, William Gardner, and Jane E. Gardner, assignees of George Gardner, for an improvement in chair-seats, namely, "A chair-seat made of laminæ of wood glued together, with the grains in one layer crossing those of the next, concave on the upper surface, convex on the lower surface, and perforated, as a new article of manufacture, substantially as set forth," (the original patent, No. 127,045, having been granted to George Gardner, May 21st, 1872, and re-issued as No. 7,203, July 4th, 1876,) does not claim any patentable invention, the form of the seat being old, the material being old, and the method of imparting the form to the material being old.

(Before WALLACE, J., Southern District of New York, June 27th, 1882.)

WALLACE, J. This action is brought to restrain the infringement of re-issued letters patent No. 9,094, dated February 24th, 1880, granted to Oliver L. Gardner, William Gardner, and Jane E. Gardner, assignees of George Gardner,

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for an improvement in chair-seats. The re-issue contains two claims, of which the second only need be stated, which is: "A chair-seat made of laminæ of wood glued together, with the grains in one layer crossing those of the next, concave on the upper surface, convex on the lower surface, and perforated, as a new article of manufacture, substantially as set forth."

The original patent, No. 127,045, was granted to George Gardner, May 21st, 1872, and contained but a single claim, as follows: "As a new article of manufacture, a chair-seat constructed of veneers of wood, with the grains running crosswise of each other, and glued together, all substantially as set forth and for the purpose specified." This patent has been twice re-issued, the first re-issue, No. 7,203, bearing date July 4th, 1876. The first re-issue has been before this Court upon a motion for a preliminary injunction founded upon it, (*Gardner v. Herz*, 16 *Blatchf. C. C. R.*, 303,) and it was decided by Judge Blatchford, upon that occasion, that none of the claims of that re-issue were valid, except the sixth, which was not in controversy and, therefore, was not considered. The second claim of that re-issue was as follows: "As a new article of manufacture, a bottom for a seat frame, constructed of two or more veneers or thin layers of wood, with the grain of the one layer crossing that of the other, said layers being secured together by an adhesive substance, and having perforations formed therein for the purpose of ventilation or ornamentation, substantially as set forth." On that occasion, Judge Blatchford held that the claim of the original patent was anticipated by a patent granted to John K. Mayo, one of the present defendants, December 26th, 1865, and re-issued to him and two others, August 18th, 1868, in 8 divisions. This patent was for an improvement in the manufacture of material, which consisted in cementing together a number of scales or veneers of wood, with the grain of the successive pieces running crosswise or diversely, so as to form a firm material adapted for the construction of various articles, including chairs and settees. In division E

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of the re-issue, the specification states: "In the chair, fig. 2, the bottom, B, may be formed of flexible material, made up by the union of two or more thin layers of wood having the grain crossed or diversified in direction, and united by suitable cement." The specification also states, that, "by adopting the well-known process of wet and dry heating in the course of manufacture, the several scales of wood may be brought to such a state of pliability as to assume any desired form, by compression in a matrix or upon formers." Upon the occasion referred to, Judge Blatchford likewise held, that there was no patentable novelty in the second claim of the first re-issue of Gardner's patent, in view of the patents prior to Gardner's, one to Tice and one to Cochran, for perforated chair-seats of metal or gutta-percha. It follows, therefore, that the only question not heretofore decided by this Court, and now open, relating to the present re-issue, is whether the concavity of form which is an element of the new claim in this re-issue will support the patent.

Chair-bottoms made of board and softened by steam and pressed to a concave shape in a mould, so that the form of the seat will conform to the shape of the person who may occupy it, are shown in the letters patent issued to Z. B. Bellows, bearing date March 15th, 1859. So, also, the concave or dishing form of chair-seats had been adopted long before Gardner's patent, in ordinary chair-seats. In the specification of the present re-issue the inventor states that he does not lay any claim to the veneers crossing each other and glued together, as these have been used for various purposes and have become public property, and that he does not claim the pressing of a chair-seat into the concave form by dies.

If there was no patentable novelty in using the perforations of the metal or gutta-percha chair-seats in the veneer seat by Gardner, neither can there seem to be any in employing a well-known form of chair-seat in his veneer seat. As it had been pointed out by Mayo that the material used is pliable and can be pressed into any desired form, and as the re-issue disclaims the pressing of a chair-seat into a concave

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form, and as chair-seats had been so formed, it is difficult to see how there was any invention in Gardner's chair-seat. Gardner merely applied a process that was old to a material that was old, to obtain an old form. Considered as a combination, it is hardly possible to believe that the perforations or the concavity performed any new functions in the Gardner seat. An ingenious theory has been presented, to the effect that the perforations and concavity co-operate, in Gardner's seat, to prevent warping and curling of the material used. If this is true, the same elements were combined in the Bailey chair back and performed there the same functions they perform in the Gardner seat. It may be that the Gardner seat is mechanically a better seat than any which preceded it, but his improvement is not a patentable one.

It is strenuously insisted, that the popularity and success achieved by the Gardner seat, beyond those of his predecessors, affords cogent evidence both of the utility and patentable novelty of his invention. The answer to this argument is, that the success of his seat is probably due to a feature which is not suggested in the original patent, that is, its adaptability for use by unskilled workmen. His seats, as now made, can be fitted without mechanical skill to a bottomless chair, and are largely used to repair chairs in which the original seats have been worn out, and can be so used without any special skill. They are, also, largely sold to chair-manufacturers, because they can be easily adapted to chairs of different sizes and seats of different forms. But, the chair-seat described in Gardner's original patent, and shown in the drawings, did not practically possess this characteristic of adaptability, but was a frame seat, which could only be fitted to a chair by a skilled laborer. Such a chair-seat would fail to meet the peculiar want which the present chair-seat supplies. Considered as a new article of manufacture, if the complainant's chair-seat has no frame, and its novelty and utility consist in its adaptability to be sold separate from the frame, and to be readily applied by any person to any chair, then the re-issue is for a different invention from that disclosed in the original patent.

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In conclusion, in view of the former decision of this Court, the complainant can only succeed upon the theory that, by imparting a concave form to his chair-seat, he has imparted sufficient patentable novelty to his article to sustain a patent; and this when such a form of chair-seat was old, the material used was old, and the method of imparting the form to the material was old. This theory cannot stand.

The bill must be dismissed.

George Gifford, for the plaintiffs.

James P. Foster, for the defendants.

THE COLLINS COMPANY

vs.

OLIVER AMES & SONS CORPORATION. IN EQUITY.

Prior to 1834, S. W. Collins, D. C. Collins and another, copartners as Collins & Co., made edge tools, using as a trade-mark "Collins & Co." In 1834 they assigned to the Collins Manufacturing Company, a corporation, the right to such trade-mark. In 1843 the right to make all articles of metal was conferred on the corporation and its name was changed to the Collins Company, the plaintiff. It always stamped "Collins & Co." on its productions. In 1856 the firm of Oliver Ames & Sons began to put the stamp and label "Collins & Co." on shovels made by it, and sent to Australia. The plaintiff had not up to that time made shovels, but it had a market in Australia for the articles it made and stamped "Collins & Co." The object of Oliver Ames & Sons in putting the stamp "Collins & Co." on the shovels was to avail themselves of the credit and reputation and market which the plaintiff had established for itself, for articles stamped "Collins & Co." The plaintiff, at the time of bringing this suit, had not sent or sold any shovels to Australia. The defendant, in succession to Oliver Ames & Sons, continued to do what the latter so began to do in 1856: *Held*, that the acts of Oliver Ames & Sons and of the defendant were always unlawful.

The plaintiff having had, from 1843, the right to make all articles of metal, and having gone on, from that time, both before and after 1856, extending its manufacture beyond edge tools into digging tools, such as picks and hoes, and

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having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging tool such as the shovel on which, in 1856, Ames & Sons put the mark "Collins & Co." does not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff's trade in respect to such shovels.

(Before BLATCHFORD, J., Southern District of New York, July 8d, 1882.)

BLATCHFORD, J. Prior to May, 1834, Samuel W. Collins, David C. Collins and John F. Wells, as copartners under the name of Collins & Co., had been carrying on, in the State of Connecticut, the business of making and selling axes and other edge tools. They had been in the habit of using as a trade-mark the words "Collins & Co.," stamped on the articles which they made. They failed in business. In May, 1834, the Legislature of Connecticut created a corporation by the name of "The Collins Manufacturing Company," to be located in the town of Canton, in that State, "for the purpose of manufacturing edge tools." In October, 1834, the copartners in said firm assigned to said corporation "the reputation and good-will of the business heretofore carried on by the said firm of Collins & Co., of manufacturing and vending axes and other edge tools, also the right to stamp the name of Collins & Co. on the articles manufactured by the said corporation." From that time until April 3d, 1835, the corporation had Samuel W. Collins and David C. Collins in its employ. On the latter date each of those persons executed an agreement with the corporation, whereby he agreed to continue in its employ for 5 years from September 27th, 1834, and it agreed to employ him for that time, and he assigned to the corporation "the reputation and good-will of the business heretofore carried on by Collins & Co., of manufacturing and vending axes and other edge tools, also the sole and exclusive right to stamp the name of Collins & Co., Hartford, on the articles manufactured by said corporation," and he agreed not to sell any axes or other edge tools having on them the name of Collins or Collins & Co., except such as should be made by said corporation, its successors or as-

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signs. The consideration of each agreement was an annual salary and certain shares of the capital stock of the corporation. In May, 1843, the Legislature of Connecticut altered and enlarged the charter of the corporation, so that it should have "power to manufacture iron and steel and other metals, and any articles composed of said metals, or either of them," and enacted that the name of the corporation should be "The Collins Company," instead of "The Collins Manufacturing Company," these provisions being conditioned on their acceptance by the corporation at a future meeting of the same, duly convened. In October, 1844, such a meeting was duly convened, and at it the stockholders accepted the said alterations of the charter. The capital stock of the corporation was originally \$300,000. The Legislature increased it in 1863 to \$500,000, and in 1866 to \$1,000,000.

The factories of the corporation have always been at Collinsville, in the town of Canton, in Hartford county, Connecticut, about 16 miles from Hartford. The manufacturing business of the old firm of Collins & Co. had been carried on at Collinsville. It had an office in Hartford. The charter of the corporation was obtained for the benefit of the creditors of the firm, and the property of the firm passed into the possession of the corporation and became a part of its capital stock.

The complaint in this suit alleges that the plaintiff corporation has, from its organization, been engaged in making "axes, hatchets, adzes, picks and other agricultural and mechanical tools and implements;" that it has always used as its trade-mark the name of "Collins & Co.," but has placed and now places that name upon such goods only as have obtained a high standard of excellence; that said trade-mark name was intended to and did inform purchasers that the goods upon which it appeared were of the manufacture of the plaintiff exclusively; that its goods, made at Collinsville, have been and are almost exclusively sold on commission in the city of New York, by a firm there called Collins & Co., which has existed since 1849; that the goods of the plaintiff "have been and are sold in large quantities in all parts of this

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country, in Mexico, in most countries of South America, and in the West India Islands, in England, Germany, Russia and other countries of Europe, and also in parts of Asia and Africa and in Australia; that the plaintiff, for more than 30 years last past, has gradually increased and extended its manufacture, from "axes, hatchets, broad axes, picks, mattocks and other similar tools and implements," "so as to include therein other mechanical and agricultural tools and implements, such as hoes of various descriptions, machetes, and other cane cutting implements for use in the West Indies and South America, and also, about the year 1857, special implements and tools for digging Peruvian guano, and, soon afterwards, other implements and tools, such as spades and plows"; that, for more than 10 years last past, it has made and sold shovels of various forms, patterns and descriptions, and its trade, especially for export, in such shovels, has been, and is now, successful and profitable; and that the best qualities of the said tools and implements of the plaintiff's manufacture have been and are stamped or branded with the said name and words "Collins & Co.," and the shovels so made and sold by it have been and are now stamped or branded and labelled with the said name and words "Collins & Co."

The defendant is a corporation created by the State of Massachusetts, having its factories at North Easton in that State, and largely engaged in making shovels, spades, scoops and other similar implements and tools. The complaint alleges, that, in the autumn of the year 1879, the plaintiff for the first time discovered that shovels had been and were being sold in the city of New York, having stamped or branded upon the iron the name and words "Collins & Co.," "Cast Steel," and that upon the handles thereof were pasted or fastened labels which had the following words printed or engraved thereon:

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“ Best Cast Steel,
Manufactured and Warranted
by
Collins & Co.,
North Easton,
Mass.,
U. S. A.” ;

that the said shovels were in fact made and so stamped or branded and labelled by the defendant and not by the plaintiff; that said shovels were sold by the defendant in the city of New York; that the statement and representation contained in and made by said stamps or brands and labels, that the said shovels were made by “Collins & Co.,” is false; that no such firm as “Collins & Co.” is or has been engaged in any such manufacture at North Easton, Massachusetts; that no firm in the country in the same business bears the name of “Collins & Co.” other than that represented by the plaintiff or its said commission house of Collins & Co. of New York; that the shovels made by the defendant, and so branded, stamped and labelled “Collins & Co.,” have been and are now being sold by it in the city and State of New York, and elsewhere in the country, and considerable quantities thereof have been exported to foreign countries, such as Australia, South Africa and elsewhere; that the use of the name of “Collins & Co.” on shovels or any other articles by the defendant is unauthorized; that said name has been taken and is so used by the defendant to induce purchasers to believe that said goods were and are made by the plaintiff, that the effect of such use and misrepresentation by the defendant is also to defraud the plaintiff in its trade and to injure its reputation; that, in December, 1879, the defendant was requested by the plaintiff to discontinue the use of the name of “Collins & Co.” on shovels, tools and implements made and to be made by the defendant, but it refused to do so; that the defendant makes and sells shovels with the name of “Collins & Co.” thereon, and said shovels are of an inferior quality to those of the plaintiff, and also of an inferior quality to those

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of the defendant upon which it uses its own name, and the reputation and trade of the plaintiff are injured by the said acts of the defendant; and that the plaintiff has thereby sustained damages to a large amount. The prayer of the complaint is, that the defendant be enjoined from stamping or branding the name or words "Collins & Co." or "Collins" on any shovels or implements of its manufacture, and from placing any labels with the name or words "Collins & Co." or "Collins" on any shovels or implements of its manufacture, and from selling or disposing of any shovels or implements with the name "Collins & Co." or "Collins" thereon, and from using in any manner the name or words "Collins & Co." or "Collins" as a trade-mark upon any shovels, implements or other articles, and from using in any manner the plaintiff's trade-mark of "Collins & Co." or the name of "Collins." It also prays for an accounting and for \$10,000 damages. This suit was brought in the Supreme Court of New York and was removed into this Court. The complaint was put in in the State Court. The answer and the replication to it were put in in this Court. The answer states that it treats the complaint as a bill of complaint.

The answer denies that the reputation of any goods of the plaintiff's manufacture has been injured or impaired by any imitation or infringement by the defendant, and that the defendant has imitated or infringed any of the goods or marks or trade-marks of the plaintiff. It avers that the defendant and its predecessors are, and have been for upwards of 75 years, largely engaged in the business of manufacturing shovels, spades, scoops, and similar implements and tools. It admits and avers that, in the autumn of 1879, as well as for upwards of 23 years before that time, shovels of the manufacture of the defendant and its predecessors were being and had been sold in the city of New York, having stamped or branded on them the name and words "Collins & Co., Cast Steel," or put in similar words, and having pasted or fastened on the handles thereof labels which had the following words, or such or similar words, printed or engraved thereon: "Best Cast

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Steel, Manufactured and Warranted by Collins & Co., North Easton, Mass., U. S. A.;" and that such shovels, bearing such marks and labels thereon, were in fact manufactured, and so stamped and branded or labelled, by the defendant and its predecessors, as well as by other manufacturers, and not by the plaintiff. It avers that the defendant and its predecessors had been in the habit of manufacturing shovels, and stamping, branding, and labelling them with the said words, or with such or similar words, from time to time since the year 1856, and that the plaintiff and its predecessors have known that fact for many years last past, and since about the time of the use thereof by the predecessors of the defendant, in the year 1856. It admits and avers that the defendant and its predecessors have made such shovels from time to time since the year 1856, as aforesaid, and that no such firm as "Collins & Co." is or has been engaged in any such manufacture at North Easton, in Massachusetts; that the shovels made by the defendant, and so branded, stamped, and labelled "Collins & Co.," have been and are now being sold by it in this country, and that large quantities thereof have been exported to foreign countries, such as Australia, South Africa, and elsewhere; that such sale and export have been going on in the usual and ordinary course of business of the defendant and its predecessors, for 25 years or thereabouts; and that neither the plaintiff, nor the Collins Manufacturing Company, nor any firm of Collins & Co., ever manufactured any shovels branded, stamped, or labelled with the name of Collins & Co., or any shovels whatsoever, until long after such shovels of the defendant, so branded, stamped and labelled, had been introduced into the market and sold and exported to a large amount, and had acquired a high reputation in consequence of the quality of the material of which they were manufactured, and the care and skill exercised in the manufacture and selection thereof, or ever manufactured or sold any such shovels until within the last few years, if at all. It denies that the use by the defendant of the name "Collins & Co." on shovels or any other articles upon which such name may

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be used by it, is unauthorized or involves any false representation in respect thereto, or that said name has been taken, or has been or is used, by the defendant, to induce purchasers to believe that said goods were or are manufactured by the plaintiff, or that the effect of such use, or of any representations by the defendant in respect thereto, is either to deceive purchasers or the public, or to defraud the plaintiff in any way, or to injure any good name or reputation which it may have. It avers that, in using the same, the defendant used only its own trade-mark, to which it became entitled by reason of the use of such mark by it and its predecessors upon its and their shovels since the year 1856. It admits that, in December, 1879, the defendant was applied to by the plaintiff to discontinue the use of the name of "Collins & Co." upon its shovels, and that it refused to discontinue such use thereof, asserting that it had the lawful right to use such name upon the shovels manufactured and sold by it. It admits and avers that the defendant makes and sells, and it and its predecessors have, for nearly 25 years, made and sold, considerable quantities of such shovels with the name of "Collins & Co." thereon; and that such designation is used by it upon a quality of shovels inferior to the very superior grade of shovels upon which it uses its own name. It denies that such shovels are of an inferior quality to any shovels manufactured by the plaintiff, that the reputation of the plaintiff or its trade is injured or impaired by any acts of the defendant, or that the plaintiff has thereby sustained any damages. It avers that, if the plaintiff is now manufacturing any shovels and is stamping the same with the brand of "Collins & Co." and selling the same either for domestic consumption or export, it is wrongfully acquiring great benefit and advantage from the use which the defendant and its predecessors have heretofore made of such title of "Collins & Co." upon shovels of its and their manufacture, and is infringing upon rights which the defendant has heretofore acquired by such use of such name in connection therewith. It avers that, in the year 1856, Oliver Ames, Oakes Ames and Oliver Ames,

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Jr., of North Easton, in the State of Massachusetts, were doing business as copartners under the firm name of Oliver Ames & Sons, and were engaged, as they and their predecessors, for upwards of 50 years, had been, in the manufacture, at said North Easton, of shovels and spades; that for the very highest grade of shovels manufactured by the said firm, which was of superior excellence and comprised only shovels and spades selected with great care from the production of their factories, the name of O. Ames was used as the trade-mark of the said firm; that for grades of the shovels and spades manufactured by said firm which, although inferior to the first grade above mentioned, were superior to most of the shovels and spades manufactured by other persons or parties, other names and trade-marks were applied, which were selected for the purpose; that, in the month of April, 1856, the name "Collins & Co." was by said firm stamped upon and used to designate certain of the shovels which were manufactured by it; that, since that time, the said name of "Collins & Co." has been, from time to time, stamped by the said firm and its successors, including the defendant, upon shovels and spades manufactured by it and them; that such firm and its successors, including the defendant, have thereby acquired a right to the use of such name upon and in connection with the shovels and spades manufactured by said firm and its successors, including the defendant; that such firm of Oliver Ames & Sons continued until the year 1876, new members being admitted to such firm from time to time, and the original members thereof having died; that such firm continued, notwithstanding such changes in the membership thereof, to carry on its business of the manufacture of shovels and spades without interruption, and to own and enjoy the marks and trade-marks thereof, and to carry on the business of manufacturing shovels and spades at the same place, and in the same factories, and with the same establishment, until the said year 1876, when the defendant, then a corporation under the laws of Massachusetts, succeeded to and became, by transfer from the said firm, the owner of all its rights, prop-

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erty, marks and trade-marks, including the right to the use of the name or mark "Collins & Co." upon shovels, and the brands, stamps and labels theretofore used in connection therewith by the said firm; that the defendant thereby acquired the right of the said firm to the use of the said name, brands, stamps and labels, and has since continued to exercise the right to the use thereof, which has now been enjoyed by the defendant and its predecessors for nearly 25 years; that, if the firms of Collins & Co., and the Collins Manufacturing Company, and the plaintiff, exist and have existed, they have all acquiesced in and assented to the use by the defendant and its said predecessors of the name of the said "Collins & Co." and the brands, stamps and labels above mentioned, in connection with shovels, in the like manner to that in which the same are now used by it in connection therewith, and have ratified and approved the same and are estopped now from objecting thereto; that neither of said firms of Collins & Co., nor the said Collins Manufacturing Company, nor the plaintiff, made any use of the name "Collins & Co." upon or in connection with any shovels manufactured by it or them, or either of them, or ever manufactured any shovels upon which it or they or either of them could or might have used such name, until such use thereof had for many years been made by the predecessors of the defendant and by the defendant; and that any attempted use of the name "Collins & Co." by the plaintiff, after the acquisition by the defendant of the rights which it had so acquired in respect to the use of such name or mark, was and is an infringement upon the rights of the defendant to the use of such name or mark upon and in connection with shovels manufactured by it.

The circumstances under which the firm of Oliver Ames & Sons, the predecessor of the defendant, began to use the mark "Collins & Co." on shovels, were these: On the 21st of March, 1856, John W. Quincy, a merchant in the city of New York, wrote the following letter to Oliver Ames & Sons:

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“ MESSRS. OLIVER AMES & SONS :

“ *Gent.*—A party here has an order from Australia for the following shovels; they must be exactly to order, as to *weight* and *size*. His order is for *Collins'* shovels, but I have no doubt that your shovels are wanted. I gave him your list prices and 5 per cent. for cash. These parties' names are J. & R. Osborn, and if they write you please turn them over to me, or give them 5 per cent. for cash. I expect my advertisements brought them, and I want to make part of advertisements out of these folks. Their order runs thus :

“ 100 dozen best and lightest bright D handled shovels, C. S., well packed in cases; should weigh only 3½ lbs.; handles to measure 23 to 24 inches *only*.

“ 25 dozen C. S. spades, with extra long strap and side strap, if made so.

“ 12 dozen long handle shovels, square.

“ 12 dozen do. do. do. round.

“ The above is exact copy of order and the party wishes us to furnish the price of each. As the first lot of 100 doz. are lighter than your regular shovels, I told him I would write you and get an answer at once direct, and inform him.

“ Please say how soon you can furnish them if wanted, and the probable cost of packing. Your immediate answer will oblige
Yours truly,

“ NEW YORK, March 21, 1856. JOHN W. QUINCY.”

On the 24th of March, 1856, Oliver Ames & Sons replied to Mr. Quincy by a letter, but neither it nor a copy of it is produced. To that letter Mr. Quincy replied as follows, March 26th, 1856 :

“ NEW YORK, March 26th, 1856.

“ MESSRS. OLIVER AMES & SONS :

“ *Gent.*—Your favor of the 24th inst. is at hand. The party gave me the order; he thinks the 100 dozen shovels are to be *square* point, as the order does not say round point. Please send them as per our letter of the 21st inst. :

“ Please have a label made for them thus :

“ Made expressly for C. G. Stevens.

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and get a stamp *for the shovels* Collins & Co., and keep the stamp for our use, as we expect to get further orders for them; or, if you prefer it, I will get them made here and sent to you. We would like the shovels made and forwarded as soon as practicable.

“To be packed in boxes and strapped as usual for shipping. These boxes are to be shipped to England and put in custom-house (bond) there and then they go to Australia free of duty. It costs less to ship this way than to pay *duty* direct to Australia; you will, therefore, have them packed right. Yours truly, JOHN W. QUINCY.”

Mr. Quincy was at that time, and before and after, a dealer in the shovels made by Oliver Ames & Sons. The shovels so ordered were made by Oliver Ames & Sons, and were stamped or branded “Collins & Co.” by them. At that time the selling firm of Collins & Co. existed in New York. The plaintiff did not at that time make shovels, but the articles which it did make were sent to Australia, and it had an established reputation for the excellent quality of such articles. The shovels then and theretofore made by Ames & Sons had the reputation of being the best shovels made.

It is very clear that when Quincy stated to Ames & Sons that the order he had received was for “Collins’ shovels,” he understood, and he meant that Ames & Sons should understand, and they did understand, that the order, as given, was for shovels made or to be made by the Collins Company, that is, the plaintiff. But Quincy knew that the plaintiff made no shovels, and that Ames & Sons did make shovels. So he showed to those who came to him the shovel list of Ames & Sons. For some reason, a party in Australia, wanting shovels, had ordered “Collins’ shovels,” although there were none. Other articles of the plaintiff’s manufacture were found in Australia, of high repute and good quality, articles of steel, kindred in character to shovels. It would be natural to think that, as other good articles of steel were of the Collins’ make, the way to surely get a good shovel was to get one of the Collins’ make, and it would be natural to assume that there

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were Collins' shovels. The letter of Quincy shows that he informed those who came to him with the order that there were no Collins shovels, and also informed them that he proposed that the order should be filled with shovels made by Ames & Sons. This was very well and, so far, was fair dealing. The proposal was acquiesced in, for the arrangement was that Quincy should write to Ames & Sons and obtain the prices at which the articles would be furnished. It would appear that Ames & Sons, in reply, desired to know whether the order was given absolutely or not to Quincy; for, Quincy replied that the party had given the order to him. He then requested Ames & Sons to fill it, and also directed that, besides the label "Made expressly for C. G. Stevens," which it must have been intended should be pasted on the wooden part of each shovel and each spade, each shovel of the 100 dozen order should have on it, impressed on the metal, the mark "Collins & Co.," to be made by a stamp. As it was understood that these articles were to go to Australia, both Quincy and Ames & Sons must have had some object in view connected with Australia. Quincy states, in his second letter, that he wishes the stamp to be kept for his use in filling further orders for like shovels, meaning, further orders from Australia. He and the defendant could have intended nothing but that the idea which had come from Australia that there were Collins' shovels, though incorrect in fact, should become to the minds of people in Australia a realized idea, by their seeing on shovels the stamp "Collins & Co.," and deriving therefrom the belief that the same Collins & Co. which had made the axes and other articles before familiar to them had made these shovels. It appears that the axes and other articles made by the plaintiff, and which before that time were known and used in Australia, were stamped "Collins & Co." Therefore, although the shovels made by Ames & Sons under this order, and subsequently, and stamped "Collins & Co.," and sent to Australia and elsewhere, may intrinsically have been of high quality, yet the only object of the defendant in putting the stamp "Collins & Co." upon them must have been

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to avail itself of the credit and reputation and market which the plaintiff had established for the articles it made and sold with the stamp "Collins & Co." upon them. There was no other purpose in this. Clearly, those who purchased shovels made by Ames & Sons, and stamped "Collins & Co.," would believe that such shovels were made by the plaintiff, for there was no other Collins & Co. than the plaintiff. This was an unlawful appropriation of the plaintiff's trade-mark. It is true that the plaintiff up to that time had made no shovels. It is also true that Ames & Sons and the defendant have built up a business in shovels stamped "Collins & Co." But the plaintiff had a right to make shovels, and it had made kindred articles of metal, and its good name and reputation in its business were wholly connected with the use, in its trade, of the mark "Collins & Co." Quincy's first letter shows that the nature of the plaintiff's trade was such that persons in Australia desiring shovels, expected to find shovels made by the plaintiff, which shovels if found, would have borne the stamp "Collins & Co." If, when the inquiry was made of Quincy, he had produced the shovels, the make of Ames & Sons, already made and stamped "Collins & Co.," in the same condition as when they were afterwards made on the order, the purchaser would have believed that the shovels were the make of the plaintiff, that being what the order really asked for, if nothing had been said or shown to indicate that they were not made by the plaintiff. As the fact was, the impression produced in Australia, by the shovel itself, with the stamp "Collins & Co.," was the same, although the persons who visited Quincy were informed that the shovels were the make of Ames & Sons.

It is true that the plaintiff's business in shovels has been very small, while that of Ames & Sons and the defendant has been very large. It is also true that the plaintiff has never sold or sent any shovels to Australia. It is also true that Ames & Sons and the defendant have put the stamp "Collins & Co." on only a particular description of shovel or spade, in all 52,000 dozen since 1856, while their make of

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shovels for the last 10 years has been from 100,000 dozen to 120,000 dozen a year. The 52,000 dozen have gone abroad wholly, largely to Australia. But, the question of profit to the defendant or damage to the plaintiff is aside from the question of the right of the plaintiff to its trade-mark. In view of the circumstances under which Ames & Sons adopted the mark "Collins & Co." on the shovels, it must be held that they had no right to adopt it and that its use by them was always unlawful.

The animus of the defendant is shown in the representation, in the label on the shovel, that "Collins & Co." is a firm making shovels at North Easton, and that the shovel stamped "Collins & Co." was made by that firm at that place. To the user or purchaser of the individual shovel in Australia, the mark "Collins & Co." on the steel or the wood would be all that was needed to induce him to believe that he was using or buying a shovel made by the same "Collins & Co." which made the excellent edge tools, while in the United States it could be asserted that every dealer would know that there was no firm of "Collins & Co." at North Easton, making shovels, and so that representation would there deceive no one, and would not there induce the belief that the shovels were made by the plaintiff.

It is strongly urged, on the part of the defendant, that a mark or stamp, to be a trade-mark, must be the mark of an existing trade; that the mark "Collins & Co." on shovels, when adopted by Ames & Sons, became the mark of a trade in shovels, carried on by Ames & Sons; that the plaintiff had no trade in shovels at the time; that the mark "Collins & Co." thus became the mark of Ames & Sons' trade in shovels, and the property of Ames & Sons in respect to shovels made by them, by prior right; that any use of that mark on shovels afterwards, by the plaintiff, became wrongful as against Ames & Sons or the defendant; and that the plaintiff has no right in the premises which it can enforce against the defendant. This view is specious but unsound. The plaintiff, having, from 1843, the right to make any article of iron, steel, or

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other metal, and having gone on, from that time, both before and after 1856, extending its manufacture beyond edge tools into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging tool such as the shovels on which, in 1856, Ames & Sons put the mark "Collins & Co.," does not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff's trade in respect to such shovels.

The plaintiff is entitled to a decree for a perpetual injunction, as prayed in the bill, and for an accounting before a master as to profits and damages, and for the costs of the suit.

John Sherwood, for the plaintiff.

William M. Evarts and *Charles C. Beaman, Jr.*, for the defendant.

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vs.

THE PHENIX INSURANCE COMPANY, OF BROOKLYN.

An average bond, after reciting that a vessel, with a cargo, had been stranded, and that the Coast Wrecking Company's vessels and men were sent to her, and her cargo was being discharged, authorized the vessel's owners to settle the salvage for any sum agreed upon between the salvors and underwriters, or to be awarded by a Court, and stated that losses and expenses had been and might be incurred, which, according to the usage of the port of New York, might constitute a general average, to be apportioned on vessel, freight and cargo, and other charges incurred might be due from specific interests, and thereby the signers agreed with J. & H., average adjusters, "that the loss and damage aforesaid, and other incidental expenses thereon," should be paid by them ratably, according to their interests in vessel, freight, and cargo, if stated and apportioned by J. & H., in accordance with the established usage and laws of the State in similar cases. A libel in Admiralty, founded on the bond, was filed by the salvors and J. & H., against an insurer of cargo, a signer of the bond. The libel, in reciting the bond, recited it as one applying

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to an apportionment of only general average expenses. But, the bond was in evidence, and in the answer the respondent submitted to the Court the question of the proper amount of salvage. There was no exception to the joining of the two claims in one libel. The respondent objected that the Admiralty had no jurisdiction, because the suit was one for general average charges; that there were no general average expenses, because the voyage of the vessel was abandoned; and that the claim of J. & H. was not one of Admiralty jurisdiction: *Held*,

- (1.) The bond covered the services and disbursements of J. & H.;
- (2.) It covered general average losses and expenses and other charges in respect to salvage and rescuing the cargo, and the services and expenses of J. & H.;
- (3.) The services and expenses covered by the bond were those which, if performed and incurred by the owner of the vessel, would have been within his duty to save the cargo, and such duty would have extended to the services and disbursements of J. & H., which would have been maritime;
- (4.) The bond was an express contract for a maritime service.

As salvage, 50 *per cent.* of the value of the property saved was awarded.

The equipment and readiness of the vessels of the Coast Wrecking Company to save property, considered, in fixing the amount.

(Before BLATCHFORD, J., Eastern District of New York, July 8th, 1882.)

THIS was a libel *in personam*, filed in the District Court. After a decree for the libellants, (7 *Fed. Rep.*, 236,) the respondent appealed to this Court. This Court found the following facts: "The libellant the Coast Wrecking Company, at the times hereafter mentioned, was a corporation created by the State of New York and authorized to own and hire vessels and use them in salvage services. It had a capital of \$222,000 invested in steamers and wrecking material, and a storehouse, and from 33 to 35 men constantly employed, with an experienced superintendent receiving a salary of from \$4,500 to \$9,000 a year, and its men and vessels were always ready to start at an instant's notice for the relief of a vessel in distress. The Phenix Insurance Company, the respondent, was and is a corporation authorized to carry on, and carrying on, the business of marine insurance. The libellants Johnson, Higgins and Krebs, were carrying on the business of average adjusters in the city of New York, as copartners, under the firm name of Johnson & Higgins. On the 1st of January, 1879, the steamship Vindicator sailed from Fall River, Massachusetts, with a general cargo of merchandise on board, bound to Philadelphia. On the 4th of January the Vindicator

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stranded on the shore of Long Island, near Moriches, and became in great danger of ultimate total destruction, with her cargo. She was stranded just inside the outer bar, heading towards the beach, with her stern to the inside of the outer bar, very low down in the water, listed to port about 45 degrees, and covered completely with ice. The place where she lay was about 70 miles from the nearest harbor, and was one of the worst spots on the Long Island shore for rendering assistance. The weather was very cold, and ice formed all over the vessel. The lower hold was entirely full of water, and in the between decks the water was as high inside as it was outside, and she was completely full at high water, on the port side. The Coast Wrecking Company, through its system of shore agents, received, at New York, on the day that the vessel was stranded, notice of the fact through a telegram from its coast patrol. On the same day the Company sent out, from New York, its steamer Relief, and the schooner John Curtin, with men and materials for the relief of the vessel and her cargo. The Relief and the John Curtin arrived alongside of the Vindicator at 3 o'clock on the morning of January 5th. Mr. Clyde, the owner of the Vindicator, arrived on board of her early on that morning, and conferred with her master, and with the agent or the Coast Wrecking Company, in regard to saving the property. A steam pump was put at work at 6 o'clock P. M., and was kept at work through the night, and on the morning of the 6th another large steam pump was put in, and both pumps were worked during the night of the 6th, but they had no effect in reducing the water in the vessel, and work with them was discontinued. On the evening of the 5th, the schooners S. L. Merritt and H. W. Johnson, owned or controlled by the Coast Wrecking Company, were sent to the Vindicator by that Company. On the morning of the 6th the Company commenced discharging the cargo of the Vindicator into schooners. The schooners, as fast as they were filled, were taken to a storehouse on Staten Island, owned by the Company, and their cargoes were there unloaded. The crew of the Vindi-

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cator were discharged on the 6th of January. The Coast Wrecking Company, by its representatives, employed laborers from the neighboring settlements, who assisted the officers and crews of the Relief and of the schooners in discharging the cargo. A few days after the discontinuance of the pumping the Coast Wrecking Company made an examination of the outside of the Vindicator, through divers, and found nothing on the outside to show any breaks along the seams. Before the 29th of January nearly all of the cargo was out of the vessel and in the storehouse at Staten Island. Some cargo was taken from the Vindicator on the 30th and 31st of January and on the 1st and 2d of February. On the 8th of February an examination of her hull, inside and out, was made by divers. Her keel was found to be broken in several places and her bottom to be badly injured under her boilers. It was then determined that she could not be saved, and the Relief returned to New York with the John Curtin, on the 9th of February, taking with her strippings of the Vindicator, worth several hundred dollars. On the 12th of February, the Vindicator broke up and came on shore. Among the cargo of the Vindicator were 341 bales of print goods, consigned to the Eddystone Manufacturing Company; 8 cases and 8 boxes of yarn, consigned to Hale & Co; and 12 cases and 2 boxes of hats, consigned to Lippincott, Mitchell & Co. All of these goods were insured by the Phenix Insurance Company, and the consignees of them abandoned them to that Company shortly after the stranding of the Vindicator, and that Company accepted the abandonment. On the 10th of January, 1879, the Phenix Insurance Company, with other owners of cargo, signed an average bond, of which the following is a copy, the part put in brackets in this copy being in writing in the original, and the rest being a printed form, there being no brackets in the original: 'Average Bond. Whereas the [steamer Vindicator] whereof [Rogers is] master, having on board a cargo of merchandise, sailed from the port of [Fall River] during the month of [January inst.] bound for [Philadelphia,] and in the due prosecution of her

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said voyage [encountered heavy weather, and got ashore near Moriches, Long Island, where she now lies. When news of the disaster was received at New York, the Coast Wrecking Company's vessels and men were sent to the steamer and the cargo is now being discharged and sent to New York. The owners and agents of the steamer Vindicator are hereby authorized to settle the salvage for any sum that may be agreed upon between the salvors and underwriters in New York or Philadelphia interested, or, in the event of a suit, for such sum as may be awarded by Court] by which means certain losses and expenses have been incurred, and other expenses hereafter may be incurred, in consequence thereof, which, according to the usage of this port, may constitute a general average, to be apportioned on the said vessel, her earnings as freight, and the cargo on board said vessel, and other charges thus incurred may apply to and be due from specific interests: Now we, the subscribers, owners, shippers, consignees, agents or attorneys of certain consignees of said vessel and cargo, do hereby, for ourselves, our executors and administrators, severally and respectively, but not jointly, or one for the other, covenant and agree to and with [Johnson & Higgins] that the loss and damage aforesaid, and other incidental expenses thereon, as shall be made to appear to be due from us, the subscribers to these presents, either as owners, shippers, consignees, agents or attorneys of certain consignees of said vessel or cargo, shall be paid by us respectively, according to our parts or shares in the said vessel, her earnings as freight, and the said cargo, as shall belong or be consigned to us, or shall belong or be consigned to any person or persons with whom we are copartners, agents or attorneys, or in any manner concerned therein, provided such losses and expenses beforementioned be stated and apportioned by Henry W. Johnson, A. Foster Higgins [and Wm. Krebs] average adjusters, in accordance with the established usage and laws of this State in similar cases. And we do further bind ourselves to furnish promptly, on request of said adjusters, all such information and documents as they may require from us to

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make said adjustment. And for the true performance of all and singular in the premises, we do hereby severally bind ourselves, our respective heirs, executors and administrators, to the said [Johnson & Higgins] in the penal sum of [ten thousand (\$10,000)] dollars, lawful money of the United States. In witness whereof we have to these presents set our hands, in the city of New York, this [tenth] day of [January] in the year of our Lord one thousand eight hundred and seventy-[nine.]' The Vindicator was a large and valuable ocean steamer, built of iron. The total value of the cargo saved was \$41,340 07, in its damaged condition. The total value of the strippings saved from the wreck was \$718 62. There was no freight saved. The cargo saved was owned by 124 different interests. The principal interest in the saved cargo was that of the Phenix Insurance Company. Of the 341 bales of print goods consigned to the Eddystone Manufacturing Company and insured by the Phenix Insurance Company, 339 were saved, of the value, as damaged, of \$12,442 14. A part of the yarn insured by the Phenix Insurance Company was saved, of the value, as damaged, of \$163 36. A part of the hats insured by the Phenix Insurance Company was saved, of the value, as damaged, of \$23 80. Of the 339 bales of print goods saved, all but 51 were out of the Vindicator and in the schooners on the 15th of January, and were in the store at Staten Island on the 16th and 17th. On the 20th, 42 more were taken out of the Vindicator, and were in said store on the 22d, and the remaining 9 bales were taken out of the Vindicator on the 26th and were in said store before the 23th. The yarn and the hats were in said store on or before the 22d. The services of the Relief extended over 37 days. She had a crew of 14 men, all told, was fitted with steam pumps, and was worth, with her outfit, about \$65,000. The schooner John Curtin was in service 37 days. She had a crew of 6 men, all told, and was worth about \$3,000. She was owned by Captain Merritt, the superintendent of the Coast Wrecking Company, and performed

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hard service, being always near the Vindicator and being used as a lighter between the Vindicator and the other schooners. Her owner chartered her, with her crew, to the Coast Wrecking Company, for \$40 a day. She was not to share in the salvage. Twenty-one days of her service were prior to the 27th of January. The schooner H. W. Johnson was in service 18 days, all prior to January 23d. She had a crew of 7 men, all told, and with her working equipment was worth about \$12,000. She was owned by the Coast Wrecking Company. The schooner S. L. Merritt was in service 13 days, all prior to the 19th of January. She had a crew of 6 men, and a wrecking equipment, and with her equipment was worth about \$12,000. She was owned by Captain Merritt and he chartered her to the Coast Wrecking Company for \$40 a day and her equipment for \$15 a day. She was not to share in the salvage. The Coast Wrecking Company also sent two divers from New York, to whom they paid wages ranging from \$5 to \$10 a day each. They sent also 3 foremen, 2 engineers and 2 firemen, who were paid \$5 or \$6 a day each. They also sent one man in their regular employ, whose wages were \$60 a month, and 10 wreckers, who were paid \$2 a day each. All the other labor and assistance that were given to the Vindicator and her cargo were obtained from the neighboring settlements, and were paid for by the Coast Wrecking Company. Laborers to the number of 44 were employed on the 6th of January; 42 on the 7th; 37 on the 15th; 28 on the 5th; and 21 each on the 11th and 25th. On the 6th 14 laborers worked all night; on the 7th 11 worked half of the night; on the 13th 17 worked half of the night; and on the 19th 4 worked all night. The wages of these men were paid by the Coast Wrecking Company and were \$2 a day with board and \$2 50 a day without board. None of these employees share in the salvage. On the 7th of January the schooner S. L. Merritt deposited a cargo of merchandise from the Vindicator in the store at Staten Island. On the 8th the schooner John Curtin deposited there a cargo of merchandise. On the 12th the schooner S. L.

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Merritt deposited there another cargo. On the 14th the schooner H. W. Johnson deposited there a cargo. From that time on a cargo was deposited there every 2 or 3 days, until the 22d of January. The cargoes were in good order except being wet. The total expenses of the Coast Wrecking Company for the hire of the schooner John Curtin, and the hire of the schooner S. L. Merritt, and for the superintendents, foremen, divers, engineers, laborers and others employed by them at the Vindicator, and for all other charges of every kind, except the wages of the crews of the Relief and the H. W. Johnson, and the expenses of running the Relief, were \$7,870 40. Of this sum \$5,666 was incurred prior to the 22d of January, and \$6,284 prior to the 26th. From the time the Relief went to the assistance of the Vindicator until all her cargo had been saved and she had gone to pieces, on February 12th, work was done, night and day, when work was possible, for the preservation of the property, by the Coast Wrecking Company and its employees. The labor of saving the cargo was dangerous for the men and vessels employed, the weather was stormy and no port of refuge was near. The cargo had to be got out by divers and this was rendered more difficult owing to the ship having settled in the sand and being hogged, which jammed everything between the decks. All of the cargo which was saved was brought to New York and delivered to the owners except a small part unidentified, which, with the savings of the wreck, was sold. After the Coast Wrecking Company took charge of the Vindicator, the libellants Johnson & Higgins were employed by her owners to render, and they did render, the necessary services at New York, in corresponding with the consignees, ascertaining the valuations, and identifying the cargo, and taking general charge of the interests of all concerned, and their services in this regard, including their statement and apportionment hereafter mentioned, in respect to the cargo delivered to the respondent, were reasonably worth the sum of \$1,223 82. This does not include any commission to them for collecting and paying the salvage. On the 9th of

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January, they issued the following circular to the shippers and consignees of the Vindicator's cargo: 'New York, January 9th, 1879. The steamer Vindicator, from Fall River for Philadelphia, went ashore near Moriches, L. I., where she now lies. Assistance has been sent to her, and her cargo is being discharged and sent to New York. To enable us to identify and deliver cargo we need a copy of your invoice. Will you please send it to us as soon as possible, and state where you are insured and in what company. Any information in regard to cargo saved can be obtained from the undersigned. Johnson & Higgins.' A copy of this notice, which had been sent to the Eddystone Manufacturing Company, was forwarded by it to the Phenix Insurance Company, and was received by the latter company on the 11th of January. Johnson & Higgins paid to the storekeeper on Staten Island \$100 for receiving, identifying and delivering the cargo. They paid to a professional appraiser \$275 for appraising it. They made an elaborate statement in the form of a general average statement, in which they apportioned the charges of the Coast Wrecking Company for salvage and special disbursements, and their own disbursements and charges, among the owners of cargo and the wreck. Such disbursements and charges were in accordance with the established usage and laws of the State of New York in similar cases, and the losses, expenses, disbursements and charges which they so stated and apportioned were stated and apportioned by them in accordance with the established usage and laws of the State of New York in similar cases. They have already received on account of their disbursements, charges and services, from the owners of the Vindicator and from other owners of cargo, about \$3,000. The Coast Wrecking Company has agreed with all parties interested except the respondent, upon a salvage of 50 *per cent.* and has received the sum of \$14,465 16 for such salvage. The value of the property exposed to loss in rendering the salvage service was \$92,000. The equipment of the Coast Wrecking Company is kept up at a large expense, and is in active service only

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about one-quarter of the time, and during the intervals of rest the men are fed and paid at an average expense of \$50 a month for wages and \$25 a month for keep, for each man. A reasonable salvage reward for the services performed by the Coast Wrecking Company, in respect to the property received by the respondent, is 50 *per cent.* of the value of such property, which salvage really amounts to \$6,314 65, but it was taken in the Court below at \$6,314 10."

George A. Black, for the libellants.

Thomas E. Stillman, for the respondent.

BLATCHFORD, J. It is objected by the respondent that the claim made in the libel is founded wholly on the bond signed and is set up as a claim for general average charges, and that no suit to recover such charges can be maintained in the Admiralty. It is also objected that the bond provides only for the payment of such losses and expenses, incurred and to be incurred, as may constitute a general average, when stated according to the established usage and laws of the State of New York; and that there were no general average expenses incurred, inasmuch as the voyage of the *Vindicator* was abandoned, and all community of interest between vessel, freight and cargo was destroyed. It is true that the libel is based on the bond or agreement, and that, in reciting the agreement, it recites it as one applying to an apportionment of only general average expenses. But the agreement is in evidence, and in the answer the respondent submits to the determination of the Court the question of the amount of compensation to be awarded to the Coast Wrecking Company for salvage. The answer alleges that the claim of Johnson & Higgins is not one of Admiralty jurisdiction, but there is no exception to the joining of the two claims in one libel. I concur with the District Judge in the view that the agreement covers the expense of the services rendered by Johnson & Higgins, and their disbursements made in connection with

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the cargo, although the case may not be one of general average. The bond or agreement covers general average charges, but it goes farther. It recites general average losses and expenses, and then it recites that there may be other charges incurred in respect to salvage and discharging the cargo and sending it to New York, which may apply to and be due from specific interests, according to the usage of the port of New York. The signers then agree to pay "the loss and damage aforesaid and other incidental expenses thereon," according to their interest in vessel, freight and cargo, provided "such losses and expenses aforementioned" be stated and apportioned by Johnson & Higgins in accordance with the established usage and laws of the State of New York in similar cases. This includes the expenses, disbursements, charges and services sued for by Johnson & Higgins, because they were incidental to ascertaining and adjusting the proportionate share chargeable to the cargo, of the expenses incurred in saving and discharging the cargo and delivering it, in addition to embracing such expenses.

As to the Admiralty jurisdiction, the services and expenses covered by the agreement are those which, if performed and incurred by the owner of the vessel, would have fallen within the line of his duty to take care of and save the cargo. Such duty would have extended to all the disbursements and services of Johnson & Higgins. They would have been maritime in their nature, and their character is not changed or affected because the ship-owner put Johnson & Higgins in his place and the liability of the owners of cargo to the ship-owner became evidenced by a written obligation in favor of Johnson & Higgins. This is an express contract for a maritime service. Every thing that was done was incident to saving and delivering the cargo.

The propriety and lawfulness and reasonableness of the charges made by Johnson & Higgins are attacked, but there is no evidence opposing that of Mr. Krebs in their favor.

As to the amount of salvage to be awarded to the Coast Wrecking Company, it is contended by the respondent, that

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all the services rendered at the wreck after January 26th were for the benefit of the vessel alone and with the hope of saving her, and not for the benefit of the cargo of the respondent; and that the cargo cannot be made to pay for unsuccessful efforts to save the vessel. It is also urged that the 50 *per cent.* salvage awarded by the District Court was too large. But, even if the services in regard to the cargo be considered by themselves, it is impossible to determine what particular services were rendered in respect to the cargo of the respondent. The service in regard to all the cargo was a continuous service, and every part of the cargo was interested in the whole of it, and should bear its due proportion of the whole expense of saving all that was saved. The only proper or possible mode of fixing the salvage is to award a percentage of the value of the property saved. The District Court has fixed that at 50 *per cent.*, on a full and careful consideration of all the evidence. That rate was adopted, without litigation, by all the owners of cargo except the respondent. Not only is the service in the particular case to be regarded, but the compensation is to be looked at as it may induce aid by competent salvors to other property in distress; and the equipment of the Coast Wrecking Company with steamers and pumps and wrecking material and skilled men, and its readiness to act on a moment's notice, must be considered, involving as that does large investments and expenses which go on as well while there is no employment. Even the award of 50 *per cent.* in respect to the respondent's property will not give more than \$12,000 compensation, beyond expenses, for saving over \$40,000 worth of property. This is liberal, as it ought to be, but I concur with the District Court, that it cannot, in view of all the circumstances, be considered excessive.

The libellant the Coast Wrecking Company is entitled to a decree against the respondent for the sum of \$6,314 10, with interest on said sum, at the rate of 6 *per cent. per annum*, from May 2d, 1881, the date of the decree of the District Court awarding to it that sum; the libellants the

The Robinson Tobacco Company v. Philips.

members of the firm of Johnson & Higgins are entitled to a decree against the respondent for the sum of \$1,223 82, with interest on said sum, at the rate of 6 *per cent. per annum*, from December 4th, 1879, the date of the filing of the libel; and the libellants are entitled to a decree against the respondent for their costs in the District Court, taxed at \$117 47, and for their costs in this Court, to be taxed.

THE ROBINSON TOBACCO COMPANY

vs.

CHARLES S. PHILIPS AND ANOTHER. IN EQUITY.

Where an equity suit is set down for hearing on the pleadings, the plaintiff cannot, on the hearing, introduce in evidence documents which are not made, by proper reference, a portion of the bill.

(Before WALLACE, J., Southern District of New York, July 10th, 1882.)

WALLACE, J. This cause having been set down for hearing upon the pleadings, on the motion of the defendant, and because of the complainant's default in taking proofs as required by the rules, the complainant cannot be permitted to introduce exhibits and documents, upon such hearing, which are not made, by proper reference, a portion of its bill.

The order setting down the cause upon the pleadings was made expressly to preclude the complainant from introducing evidence which it was its duty, under the Rules, to proffer in time to permit the defendant to reply to it.

The bill is dismissed, with costs.

Worth Osgood, for the plaintiff.

Hubert A. Banning, for the defendants.

APPENDIX.

I.

RULES.

Rules of the Circuit Court of the United States for the Southern District of New York, adopted since the publication of the nineteenth volume of these Reports.

OCTOBER, 1st, 1888.

At the jury terms for trials of issues in which the United States is not a party or interested, a day calendar shall be made from causes on the general calendar. The first twelve causes on the calendar shall comprise the day calendar for the first day of the term. For each subsequent day, six causes, to be selected by the clerk from all causes noticed for the day calendar, according to their order on the general calendar, shall comprise the day calendar. Causes that have not been placed upon the day calendar may be reserved for a future day, by filing a consent of the attorneys, specifying the day, with the clerk, but will not have priority over causes previously placed on the day calendar, unless the Court, for special reasons, so directs. Causes will be placed on the day calendar upon the notice of either party filed with the clerk by 3 o'clock P. M. of the preceding day. A copy of the day calendar for each succeeding day shall be conspicuously posted by the clerk, in the Court room, by 4 o'clock P. M. After the day calendar is thus posted, no change shall be made, and each cause must be disposed of for the term, when reached, unless, for sufficient cause shown, the Court may otherwise direct. Causes not reserved by consent, or noticed for the day calendar before causes having a later date of issue shall have been placed thereon, shall be deemed passed for the term.

OCTOBER 1st, 1888.

When a cause has been removed from a State Court, either party may forthwith cause a copy of the record to be filed in this Court, and thereupon may notice the cause for trial in this Court, although the term has commenced; and, upon filing a note of issue, may place the cause upon the calendar, as of the date when the record was filed. Such cause will not be placed on the calendar until five days after the filing of the note of issue. When the cause has been duly noticed for trial in the State Court before removal, no new notice of trial in this Court will be required, but the party filing a note of issue shall, on the day of filing the same, serve notice thereof on the adverse party.

Rules of the Circuit Court of the United States for the Northern District of New York, adopted since the publication of the eighteenth volume of these Reports.

JUNE 27th, 1882.

A term of this Court having been appointed by law to be held in the City of Syracuse, in the County of Onondaga, on the third Tuesday of November in each year, It is Ordered, that the Clerk of this Court and the Commissioner of Jurors, on or before the first day of October, 1882, select the names of at least four hundred jurors, residents of Onondaga County, qualified to serve as grand and petit jurors, in the manner provided by the general Rule of this Court regulating the selection and drawing of jurors to serve in this Court; and that thereafter names of persons to serve as grand and petit jurors at said term shall be selected at the time and in the manner provided in said Rule. It is further ordered, that the Marshal prepare a suitable jury box for Onondaga County.

MARCH 21st, 1883.

The Rule heretofore adopted regulating the selection and drawing of jurors to serve in this Court is hereby amended so as to read as follows:

"Suitable boxes will be provided by the Marshal and delivered to the Clerk for the safe keeping of the names of persons to be selected as eligible to serve as grand and petit jurors. One such box shall be provided and designated for each of the several counties within the district where stated terms of the Court are required by law to be held. Before the first Tuesday in April and the first Tuesday in May, in each year, the Clerk of the Court and the Commissioner of Jurors shall select the names of not less than four hundred persons, from the residents of each of said counties in which a stated term of this Court is required by law to be held, qualified to serve as grand and petit jurors. Such names shall be selected without reference to party affiliations. No person shall be eligible to serve as a grand or petit juror at any term of this Court unless he is at the time a resident of the county in which such term is held. The name of each person so selected shall be written upon a separate ballot, with his place of residence and occupation. The first name shall be selected by the Clerk and deposited by him in the box designated for the proper county, and the second name shall be selected and deposited by the Commissioner of Jurors; and thereafter the Clerk and the Commissioner of Jurors shall alternately select and deposit a name in the box until the required number shall be completed. If at any time less than three hundred names remain in the box, the Clerk and Commissioner of Jurors shall replenish the quota in the manner aforesaid. This provision, however, shall not be deemed to have any reference to the annual filling of the boxes for the several counties, which must contain, on the first Tuesday in May of each year, not less than four hundred names. The several boxes shall be locked and retained in the custody of the Clerk, and the keys shall be kept by the Commissioner of Jurors. The names of all persons who may be required to serve as grand or petit jurors at any term of this Court shall be drawn publicly by the Clerk from the box for the county in

which such term is to be held, and at the close of such term the ballots containing the names of persons who actually served as jurors, or who proved to be ineligible to serve as jurors, shall be destroyed by the Clerk. The Clerk shall post upon the outer door of the Clerk's office notice of the time and place for drawing jurors, at least ten days prior to the drawing, except when jurors are summoned during a session of the Court."

All Rules inconsistent with this Rule are hereby abrogated.

MARCH 21st, 1888.

Whereas, Charles A. Doolittle has tendered his resignation as United States Commissioner of Jurors, for the United States Circuit Court for the Northern District of New York, It is Ordered, that the said resignation be and the same is hereby accepted, and it is further ordered that William Townsend, Counsellor at Law, of the City of Utica, be and he is hereby appointed as such Commissioner.

Rule of the Circuit Court of the United States for the District of Connecticut, adopted since the publication of the eighteenth volume of these Reports.

JULY 12th, 1888.

In pursuance of the provisions of the second section of the Act of Congress of the United States, entitled "An Act making appropriations for certain judicial expenses of the Government for the fiscal year ending June 30th, 1880, and for other purposes," approved June 30th, 1879, It is Ordered, that suitable boxes will be provided by the Marshal and delivered to the Clerk for the safe keeping of the names of the persons to be selected as eligible to serve as grand and petit jurors. One said box shall be provided and designated for the counties of Hartford, Tolland, Windham and New London, which said counties shall be known as Sub-District No. 1, and another box shall be provided and designated for the counties of New Haven, Middlesex, Fairfield and Litchfield, which said counties shall be known as Sub-District No. 2. The Jury Commissioner and Clerk of this Court shall, as soon as practicable after the entry of this order, and annually thereafter, in the month of August of each year, select to serve as grand and petit jurors in this Court, and place in the boxes so provided as aforesaid, the names of at least four hundred persons for each Sub-District, each of which persons shall possess the qualifications prescribed in Section 800 of the Revised Statutes, being the qualifications set forth in "An Act relating to Jurors," passed by the General Assembly of the State of Connecticut, approved March 25th, 1880, and shall be electors of said State, and residents of said respective Sub-Districts. Each name shall be written on a separate slip of paper, with the person's place of residence, and the said Clerk and the said Commissioner shall each alternately place one name in said respective boxes, commencing with said Clerk, without reference to party affiliations, until the required number shall be completed. If at any time less

than three hundred names remain in the box, the Clerk and the Commissioner shall replenish the quota in the manner aforesaid. The boxes shall be locked and retained by the Clerk and the key shall be kept by the Commissioner. The names of all jurors, grand and petit, to serve at any term of this Court, shall be drawn publicly by the Clerk from the box for the Sub-District in which the term is to be held, and from the names placed therein, and at the close of each term the ballots containing the names of persons who actually served as jurors, or who proved to be ineligible as jurors, shall be destroyed by the Clerk. The Clerk shall post upon the outer door of the Clerk's office notice of the time and place of drawing jurors at least three days prior to the drawing, except where jurors are summoned during a session of Court. All Rules inconsistent with this Rule are hereby abrogated.

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ATTORNEY.

1. P. employed D., who was not an attorney at law, to prosecute a claim of his against the Government, to recover back duties illegally exacted, agreeing to pay him for his services a sum equal to one-half of the recov-

ery, he to bear all the expenses. He employed attorneys and brought suit, in the name of P., against a collector of customs. For 12 years, and until he died, he had exclusive control of the suit. He made substitutions of attorneys and defrayed all expenses. After his death, his executrix controlled the suit, and substituted an attorney, and a judgment for over \$17,000 was recovered in favor of P. Then the Court denied a motion made by the defendant to vacate the appearance of the attorney substituted by the executrix. Then P. succeeded in ejecting such attorney, by the aid of the defendant's attorney, during the pendency of a writ of error. The judgment being affirmed, and the clerk refusing, on the mandate, to recognize any attorney but the one so ejected, P. moved to vacate the appearance of such attorney. The motion was granted, on P.'s paying to the executrix one-half of the amount of the judgment, without prejudice to his right to recover at law the whole or any part thereof. *Dodge v. Schell*, 517

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1. A schooner and a steamer collided. The schooner's side lights were burning, but not properly, and were not seen from the steamer, though those on her were vigilant. The steamer did all that it was incumbent on her to do, when she discovered the schooner's light. The schooner did not exhibit any lighted torch, although she saw the approach of the steamer: *Held*, that the schooner was wholly in fault. *The Narragansett*, 87

CONSTITUTIONAL LAW.

1. The Act of the Legislature of New York, passed May 31st, 1881, (*Laws of New York*, 1881, chap. 432, p. 590,) imposing a duty of \$1 for each alien passenger arriving at the port of New York from a foreign port, and appropriating the money to "the execution of the inspection laws of the State of New York" by the Commissioners of Emigration, is in conflict with the exclusive power of Congress, under the Constitution of the United States, to regulate commerce. *The People v. Compagnie Générale*, 296
2. The "inspection laws" referred to are the provisions of the Act of the Legislature of New York, passed May 28th, 1881, (*Laws of New York*, 1881, chap. 427, p. 585,) for inspecting the persons and effects of all persons arriving by vessel at the port of New York from a foreign country. *id.*
3. The Act of May 31st, 1881, is not valid as a statute laying an impost, or a duty on imports, for executing inspection laws, under Article 1, section 10, of the Constitution of the United States, because the Act of May 28th, 1881, is not an inspection law. *id.*

4. What are "inspection laws," defined. *id.*

5. Although, by section 10, of Article 1, of the Constitution of the United States, State inspection laws are made subject to the revision and control of Congress, this Court has authority to decide whether a particular law is an inspection law or not. *id.*

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CONTRACT.

See RAILROAD.

COPYRIGHT.

1. The title deposited with a view to a copyright for a book was this: "Over One Thousand Recipes. The Lake-Side Cook Book; A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. Chicago: Donnelley, Loyd and Company, 1878." The book was published with this title page: "The Lake-Side Cook Book No. 1. A Complete Manual of Practical, Economical, Palatable and Healthful Cookery. By N. A. D.," followed by the imprint of the place of publication and the name of the proprietor and the notice of copyright, on the title page: *Held*, that the omission, in the title page of the published book, of the words "Over One Thousand Recipes," and the addition, in it, of the words "No. 1" and "By N. A. D." were immaterial, and that the title published was deposited, in compliance with § 4,956 of the Revised Statutes. *Donnelley v. Ivers*, 381
2. Y. took out a copyright, in 1880, on a chromo-lithographic print, entitled "Gambrinus and his followers," as proprietor, he being a citizen of the United States. The chromo was designed in Europe, by an alien, and printed there. Y. showed no title derived from the author: *Held*,

(1.) The chromo was the subject of a copyright;

(2.) Y., not being the author or deriving title from him, could not, under § 4,952 of the Revised Statutes, lawfully obtain a copyright for the chromo;

(3.) The author, not being a citizen of or resident in the United States, could not obtain a copyright for the chromo as author, and, therefore, Y. could not, as proprietor;

(4.) A chromo is a "print," within § 4,971 of the Revised Statutes. *Yuengling v. Schile*, 452

CORPORATION.

See JURISDICTION, 7.
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COSTS.

1. In the Second Circuit, actual disbursements necessarily incurred in a suit, in addition to fees paid for exemplifications and copies of papers, under § 983 of the Revised Statutes, are taxed in favor of the prevailing party. *Gunther v. Liverpool, &c., Ins. Co.*, 390
2. Accordingly, in a suit at law, \$1 paid for serving the summons by which the action was commenced was allowed as a disbursement. *id.*
3. Money paid to a stenographer for a copy of the minutes of the testimony given on the trial was not allowed. *id.*
4. Interest on the verdict from the day it was rendered to the day of rendering judgment was allowed. *id.*

See PATENT, 107, 110, 130.
SALVAGE, 8.

CRIMINAL LAW.

1. A person was, on an examination on a criminal complaint, committed by a Commissioner to await the action of the grand jury. On a *habeas corpus* and a *certiorari*, the Court allowed

the accused to depart without giving any recognizance, subject to the issuing of a new warrant of arrest, if ordered by the Court. After the lapse of five months, the Court was asked by the accused to determine whether the evidence before the Commissioner was sufficient to warrant his commitment. Meantime a grand jury had met and been discharged, without indicting the accused, and no information had been filed against him. He was not in actual or constructive custody: *Held*, that the Court would not determine the said question, and that, if desired, an order would be entered discharging the accused, because no indictment or information had been filed against him. *In re Esselborn*, 1

2. An indictment, under § 3,266 of the Revised Statutes, charged, in one count, the unlawful use of a still, for the purpose of distilling spirits, on premises where ale was made, and, in another count, substantially a like offence. The defendant was found guilty on one count, and not on the other, and was sentenced to be imprisoned and fined. At a subsequent term he moved to vacate the judgment, on the ground that the same offence was charged in the two counts, and that the verdict on the first count was made void by that on the second; *Held*, that the motion must be denied, because,

(1.) Under the Rules of the Court the motion was too late;

(2.) The term at which the judgment was entered having expired, the Court had no power to vacate it;

(3.) The question raised was adjudicated by the passing of sentence;

(4.) The offences charged in the two counts were two different offences. *United States v. Malone*, 187

3. Knowledge is not made, by § 3,266, an ingredient in the offence, and, therefore, it need not be averred in the indictment. *id.*

4. Evidence that the accused devised a scheme to put counterfeit money in circulation, by sending through the mail, to one B., a letter calculated to induce B. to purchase counterfeit money at a low price, for the purpose

- of putting it off as good, and that, in order to carry said scheme into effect, he placed in a post office a letter addressed to B., for the purpose of inducing B. to purchase counterfeit money at a low price, in order that he might put it off as good money, for its face value, is sufficient to establish an offence under § 5,480 of the Revised Statutes, although no evidence is given to show an intention in the accused to defraud B., or any other particular person. *United States v. Jones*, 235
5. The *corpus delicti*, in such offence, is the mailing of the letter in execution of the unlawful scheme. *id.*
 6. On the trial, the Court refused to permit the jury to inspect a copy of the letter proved to have been mailed, which copy the accused made in the presence of the jury: *Held*, no error. *id.*
 7. The Court also refused to permit an expert in handwriting to say whether the original letter put in evidence by the Government, and the copy of it made by the accused in the presence of the jury, were in the same handwriting: *Held*, no error. *id.*
 8. Where a motion to quash an indictment is made after plea, and so much time has elapsed since the date of the alleged offence that it is too late to frame a new indictment, the motion must fail unless the indictment discloses defects that would be clearly fatal after verdict. *United States v. Bartow*, 849
 9. It is made an offence, by § 5,209 of the Revised Statutes, for a cashier of a national bank to make any false entry in any report or statement of the association, with intent to defraud the association, or to deceive any officer of the association or any agent appointed to examine the affairs of any such association; and an indictment under that section is bad which avers only an intent to deceive the Comptroller of the Currency. *id.*
 10. An indictment under that section charged the making a false report of the condition of the bank, and had in it the words, "whereby, by means of a false entry therein by him made." It not being clear that that language would be held insufficient to support a conviction for making a false entry in the report, the question was left to be raised on a motion in arrest of judgment, and a motion to quash was denied. *id.*
 11. A motion to quash an indictment, made after plea, cannot prevail unless the insufficiency of the indictment is so palpable that no judgment can be rendered after conviction. *United States v. Bartow*, 351
 12. A report of the condition of a national bank, made by its cashier to the Comptroller of the Currency and verified by his oath, is a declaration, within § 5,392 of the Revised Statutes. *id.*
 13. An indictment under that section charged the taking of a false oath to a report to the Comptroller of the Currency, but did not specifically aver that the report was made on the requirement of the Comptroller, or according to a form prescribed by him, but averred that the report was made to the Comptroller, "and verified as aforesaid, as by law required." It not being clear that such averment was not sufficient, after verdict, to warrant judgment on the conviction, a motion to quash the indictment was denied. *id.*
- ## D
- ### DUTIES.
1. Under §§ 2,927 and 2,928 of the Revised Statutes, there can be an appraisement for an abatement of duties, on account of damage to goods sustained during the voyage of importation, after the goods have been entered at the Custom House and the estimated amount of duties thereon have been paid. *United States v. Phelps*, 129
 2. Hay is not a manufactured article, under § 2,516 of the Revised Statutes, and so subject to a duty of 20

per centum ad valorem, but is a raw or unmanufactured article, under that section, and so is subject to a duty of 10 *per centum ad valorem*. *Frazee v. Moffitt*, 267

8. The protest in this case was "against any greater rate of duties * * * than at the rate of ten *per centum ad valorem*, for the reason and on the grounds that no higher rate than ten *per centum* can lawfully or properly be charged on hay imported." The collector had liquidated the duties at 20 *per cent.*, under § 2,516: *Held*, that the protest was sufficient, under § 2,931. *id.*

E

EQUITY.

1. The bill in this case was sustained, on demurrer, as a bill by second mortgage bondholders of a railroad company against the mortgagor and a trustee in the mortgage, to foreclose the mortgage. *Webb v. Vermont Central R. R. Co.*, 218
2. It is a sufficient reason for the bondholders to proceed in their own names and behalf, making the trustees defendants, that the trustees have acquired adverse interests, and stand in a hostile position, so that they cannot maintain the plaintiffs' rights without attacking their own. *id.*
3. A demurrer to the bill by the trustees of a prior mortgage and by parties in possession under them was sustained, because the bill was not framed as a bill to redeem the prior mortgage. *id.*
4. W. contracted with K., that K. should conduct a litigation on behalf of W., as counsel, and receive $\frac{1}{2}$ of the avails thereof for so doing. K. contracted with M. and H., that they should assist K. in the litigation, and share equally with him in the $\frac{1}{2}$. The litigation was conducted by them with the knowledge of W. until he received a sum as its avails. M. assigned his share of the avails to B. B. sued W. and K. in a State Court of New York to recover such share. The suit was removed into this Court. B. filed a bill in equity in this Court setting up the above facts. It was demurred to on the grounds (1) that there was no privity of contract between W. and M., or between W. and B.; (2) that W. was only liable to K.; and (3) that the remedy of B. was at law: *Held*, that the demurrer must be overruled. *Benedict v. Williams*, 276
5. The distinctions between legal and equitable procedure being abolished in the State Courts of New York, and the right of B. being a purely equitable right, he can, in this Court, proceed in equity. *id.*
6. A creditor's bill, founded on a judgment recovered against a debtor in a State Court in California, will not lie in a Circuit Court of the United States in New York, to set aside a fraudulent transfer of personal property made by the debtor in California, by means of collusive judgments and sales under executions thereon, no judgment having been obtained, or execution issued, in such Circuit Court, or in any State Court of New York. *Clafin v. McDermott*, 522
7. G., a co-executor with A. and W., borrowed the funds of the estate, and gave bonds and mortgages therefor to himself and his co-executors, as obligees and mortgagees. On a sale of the mortgaged property under a foreclosure of the mortgages, there was a deficiency. On a settlement of their accounts, the executors were authorized to retain a certain sum as commissions, one-third of which was the share of G. The co-executors brought this bill in equity for a decree to apply to the debt of G. his share of commissions: *Held*, that the bill would lie, the sole remedy being in equity. *Ransom v. Geer*, 585
8. *Held*, also, that the plaintiffs were entitled to the share of a composition in bankruptcy payable by G., to be computed on such deficiency; and that the debt was not discharged by the composition, because there had been no payment or offer to pay according to the composition. *id.*

See EVIDENCE.

INSURANCE (LIFE), 4.

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PLEADING.

PRACTICE, 1, 2, 5, 7.

SEQUESTRATION.

ESTOPPEL.

See EVIDENCE, 2.

EVIDENCE.

1. A bill in equity will lie, under § 866 of the Revised Statutes, to obtain a direction that the testimony of a witness be taken *in perpetuam rei memoriam*, where the plaintiff alleges that he is using a process to the use of which the defendant claims an exclusive right under a patent, that the patent is void for want of novelty, that, in case the defendant sues the plaintiff for infringement of said patent, the plaintiff relies, for his defence, on the testimony of the witness, that the witness had made public use, in the United States, of the said process, for upwards of 12 years before said patent was issued, that said witness is upwards of 90 years of age, that the defendant does not sue the plaintiff for infringement, and that the plaintiff cannot bring his rights to a judicial determination. *New York & Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.*, 174

2. B. sued S., in this Court, in equity, for the infringement of a patent. On an issue as to novelty the Court decided in favor of S., and held that the bill must be dismissed. Afterwards B. sued S. again, in this Court, in equity, for the infringement of the same patent. S., in his answer, set up, as an estoppel, the former suit. No decree had in fact been entered in it. Proofs were taken in the second suit, in which it was assumed by both parties that there had been a decree in the first suit. At the hearing of the second suit B. objected that there had been no decree in the first suit. The Court, on the motion of S., then signed and entered a decree in the first suit, and allowed it to be

put in evidence on the part of S., in the second suit, and held that it was a bar to the second suit. *Barker v. Stowe*, 185

3. The modes of taking testimony in equity cases explained. *Bischoffsheim v. Baltzer*, 229

4. The provision of Rule 68, in Equity, for taking testimony in an equity case, after it is at issue, by deposition, according to the Acts of Congress, is still in force. *id.*

5. Where testimony in a foreign country can be taken orally, it ought not, except for special reasons, to be taken otherwise. *id.*

6. The plaintiff in an equity suit having applied for an order for a commission to examine himself on written interrogatories to be annexed to the commission, on an affidavit showing that he expected to prove by himself the material averments in the bill, or many of them, the Court allowed the defendant to cross-examine him orally. *id.*

7. Where an equity suit is set down for hearing on the pleadings, the plaintiff cannot, on the hearing, introduce in evidence documents which are not made, by proper reference, a portion of the bill. *Robinson Tobacco Co. v. Philips*, 589

See CRIMINAL LAW, 4 to 7.

MONEY HAD AND RECEIVED.

MUNICIPAL BOND, 2, 6.

NEGLIGENCE, 1, 3, 4.

PATENT, 2, 97, 98, 110.

EXECUTOR.

See EQUITY, 7, 8.

F

FEES.

See COSTS, 1 to 3.

FOREIGN INSURANCE COMPANY.

1. Under the provisions of the Act of

the Legislature of New York, passed May 11th, 1865, (*Laws of New York*, 1865, chap. 694, p. 1,408,) a Virginia insurance corporation deposited, in 1878, with the insurance superintendent of New York, certain bonds. In 1879, it withdrew its agency from New York. In 1881, all its risks outstanding in New York were cancelled. Prior to that the bonds had been attached in New York in a suit brought there by a Rhode Island corporation on a policy of insurance, which suit was removed into this Court. The defendant moved to set aside the levy under the attachment: *Held*, that the motion must be granted. *Providence & Stonington S. S. Co. v. Virginia F. & M. Ins. Co.*, 405

I

INDICTMENT.

See CRIMINAL LAW, 2, 3, 9, 10, 11, 13.

INJUNCTION.

See PATENT, 3 to 5.

INSPECTION.

See CONSTITUTIONAL LAW.

INSURANCE (FIRE).

1. A policy of fire insurance on a hotel, owned by the plaintiff, provided that it should be void if the premises should be used so as to increase the risk, within the control of the assured, without the assent of the insurer, or if the assured should keep gasoline or benzine without written permission in the policy, and that neither benzine nor gasoline should be stored, used, kept or allowed on the premises, temporarily or permanently, for sale or otherwise, unless with written permission endorsed on the policy, "excepting the use of refined coal, kerosene or other carbon oil, for lights, if the same is

drawn and the lamps filled by day light;" otherwise, the policy to be void. There was written in the policy: "Privilege to use gasoline gas, gasometer, blower and generator being underground, about 60 feet from main building, in vault, no heat employed in process;" and "privilege to keep not exceeding 5 barrels kerosene oil on said premises." There was an oil room in the basement of the hotel, in which materials for lighting were kept. The hotel was run by the wife of W., W. being her agent in its management. It was destroyed by a fire which took in the oil room between sundown and dark, from a light carried in there by servants, by direction of W., for the purpose of drawing oil sent for from a neighboring hotel. The answer set up, as defence, that the conditions of the policy were broken, by keeping or allowing benzine on the premises, and thereby increasing the risk, without consent or permission, but did not otherwise set out any breach by drawing oil after daylight, or by other light. On the trial the defendant gave evidence to show that W. had procured benzine and put it in the oil room for use in lighting the premises, and that this was the same as gasoline, and was what was sent for from the other hotel, and was being drawn and took fire from the light, and caused the loss, and that its presence increased the risk. The evidence also went to show that W. procured the benzine to use at a picnic and not for the purposes of the hotel. The plaintiff gave evidence to show that no benzine was brought there, and that, if there was, it was without the authority or knowledge of the plaintiff, and that kerosene was what was being drawn when the fire took. There was evidence that, in the use of gasoline gas, in apparatus such as is described in the permission, it is usual to store gasoline in the generator. The Court charged the jury that, if the benzine was there and was procured and placed there by W. in the course of his business of managing the hotel for his wife, to whom the plaintiff had committed the use of the premises, and storing it in the oil room would not be within what would be understood

and expected to be done in the exercise of the privilege granted to use gasoline, the plaintiff could not recover; but that, if the benzine was not there, or was placed there by W. without the plaintiff's knowledge, for some outside purpose, not connected with the management of the hotel, nor within his authority as agent of his wife for that purpose, or if it was to be understood and expected, from the permission, that the gasoline or benzine might be stored in the oil room, in the usual place for storing such things, and it was so stored there, the plaintiff could recover: *Held*, no error. *Gunther v. Liverpool, &c., Ins. Co.*, 362

2. The defendant requested the Court to direct a verdict for the defendant on the ground that drawing the oil after daylight was gone, by artificial light, avoided the policy, and to charge the jury that the plaintiff was not entitled to recover if benzine was there and increased the risk. The Court refused to comply with such requests: *Held*, no error. *id.*

INSURANCE (LIFE).

1. By a policy of insurance, issued on an application signed by A., a life insurance company promised to pay "to A., his assigns," on a future day named, \$10,000, "or, if he should die before that time, then to make said payment to his legal representatives. If any claim be made under an assignment, proof of interest to the extent of the claim will be required." A. executed an assignment of the policy to H., and left it with the company, and both were delivered by the company to H. A., before the time named, died, by the hands of H. The administrator of A. sued the company to recover the \$10,000. On the trial, it appeared that H. planned the death of A. before the insurance, induced him to effect it and make the assignment, paid the first and only premium that was paid, and took his life for the purpose of obtaining the money on the policy. There was no evidence of any interest of H. in the life of A. No fraud in A. was alleged. The de-

fendant requested the Court to instruct the jury, that, if the company made no contract with A., or if the real contract was with H., or if the policy was made and issued for the benefit of H., the plaintiff could not recover. Those instructions were not given and no questions were submitted to the jury on those aspects of the case: *Held*, no error. *Armstrong v. Mutual Life Ins. Co.*, 498

2. The branch of the contract which ran to H. and his assigns was assignable, and the other branch was not. The general assignment to H. carried only the assignable branch, and only such interest in the life of A. as could be proved. *id.*
3. An endowment policy on a life, with a right to share in profits, to be applied towards premiums, is not made void by misrepresentations of the insurer's agent as to what the profits would amount to. *Hale v. Continental Life Ins. Co.*, 515
4. Equity has cognizance of a suit to account for such profits. *id.*

INSURANCE (MARINE).

1. A valued marine policy of insurance insured a vessel for one year. In the printed part of the policy there was a warranty by the assured not to use certain specified ports and places, and certain waters, and, among them, the West India Islands during certain months, and ports and places in Texas, except Galveston, and foreign ports and places in the Gulf of Mexico and any of the West India salt islands, and not to load more than her registered tonnage with heavy cargo or grain on any one passage. On the margin of the face of the policy, written at a right angle to the printed lines, were these words: "To be employed in the Coasting Trade, on the United States Atlantic Coast," in one line. Underneath that line, and in one line parallel with it, were these written words: "Permitted to carry Grain and heavy cargoes, over tonnage on coastwise voyages, and to use Gulf

Ports not west of New Orleans." The vessel was wrecked by running on shore at a place west of New Orleans, while on a voyage from Maine to a port in the Gulf of Mexico west of New Orleans: *Held*,

(1.) That the use of Gulf ports in the United States not west of New Orleans was not forbidden by the printed clauses, and the use of them was not allowed by the written words, "the Coasting Trade, on the United States Atlantic Coast;"

(2.) That the policy permitted the employment of the vessel in the coasting trade on the United States Atlantic Coast proper, excluding the Gulf, but with the added permission, that she might use ports in the Gulf not west of New Orleans, and might enter the Gulf for the purpose of proceeding to such ports, with a view to use them;

(3.) That the loss was not covered by the policy. *New Haven Steam Mill Co. v. Security Ins. Co.*, 192

INTEREST.

1. On the 1st of March, 1881, a judgment was docketed in this Court, in favor of the plaintiffs, and against the defendant, for a sum of money, in a suit against a late collector of the port of New York, to recover back money paid to him for customs duties, and by him paid into the Treasury, in the performance of his official duty. Prior to that, and at the trial of the action, the Court, under § 989 of the Revised Statutes, made a certificate of probable cause. The Government paid to the plaintiffs the amount of the judgment, but refused to pay any interest on such amount. The United States' attorney then applied to the Court to require the plaintiffs to execute a full satisfaction piece of the judgment, or to make an order that full satisfaction of the judgment be entered on the records of the Court: *Held*, that the judgment was satisfied and that the clerk must make all proper entries to that effect in the records of the Court. *White v. Arthur*, 287

2. The question of the payment of interest by the United States consid-

ered, and the legislation and practice on the subject reviewed. *id.*

3. Whatever may have been the practice under the permanent appropriation in the Revised Statutes, and under statutes prior to the appropriation bill of 1878, it is clearly expressed in the appropriation bills of 1878, 1879, 1880 and 1881, that, where there are judgments against collectors of customs for duties paid under protest, interest accruing after judgment, on the amount of the judgment, or on the duties improperly paid, is not to be paid by the Government, either from the permanent appropriation or from the special appropriations. *id.*

4. Where there has been a certificate of probable cause, under § 989, there can be no execution against the collector, and he is not liable, under the judgment, for interest on it. *id.*

See Costs, 4.

MONEY HAD AND RECEIVED.

INTERPLEADER.

1. H., on behalf of G., sold to a national bank a promissory note, not due, and received from the bank the purchase price, and delivered the note to the bank. H. gave to G. a cheque for the proceeds, less \$3 77 commission. Before the cheque was paid, the said bank learned that when the note was sold its maker had suspended payment, and notified H. of the fact and tendered back the note and demanded back the purchase money. H. then stopped payment of the cheque, and G. brought this suit against H., on the cheque, to recover its amount. The said bank claimed from H. the entire proceeds. H., then, on notice to said bank and to the attorney for G., applied to this Court to substitute said bank in place of H., as defendant in this suit, and to discharge H. from liability to either G. or said bank, concerning the claim sued on, on H. paying the money into Court. The application was granted, as being a practice provided for in a suit at law, by § 820 of the New York Code of Civil Pro-

cedure, and adopted by § 914 of the Revised Statutes, and H. was ordered to pay into Court the entire proceeds. *Harris v. Hess*, 253

2. The said bank having, after notice of said application was served on it, sued H. in a Court of the State of New York, to recover the money so paid by it to H.: *Held*, that the bringing of such suit did not affect the jurisdiction of this Court to grant the application. *id.*

J

JUDGMENT.

See CRIMINAL LAW, 2.
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INTEREST.

JURISDICTION.

1. To a bill in equity brought in the Circuit Court for the District of Vermont, alleging that the plaintiff was a citizen of Massachusetts and the defendant a citizen of Vermont, the defendant pleaded that he was a citizen of New Hampshire; *Held*, that the plea was bad. *Brooks v. Bailey*, 85
2. The Act of March 3d, 1875, (18 U. S. Stat. at Large, 470, § 1,) extends the jurisdiction to suits between citizens of different States, without requiring either party to be a citizen of the State where the suit is brought. *id.*
3. S. granted an exclusive license, in writing, to a company, to make and sell a patented article during the term of a patent, returns of sales to be made monthly, and license fees paid monthly, S. to have a right to terminate the license by a written notice to the company, on the failure to make returns and payments for 3 consecutive months. S. duly served notice of the termination of the license, but the company continued to use the patented invention, and S. brought this suit for infringement. The parties were citizens of

the same State. In A.'s answer, the company alleged that the contract was not lawfully terminated, and, also, that it had not sold any of the patented articles, and was not making and selling them: *Held*, that this Court had jurisdiction of the suit. *Smith v. Standard Laundry Machinery Co.*, 360

4. The case distinguished from *Wilson v. Sandford*, (10 How., 99,) and *Hartell v. Tilghman*, (99 U. S., 547.) *id.*
5. The provision of § 5 of the Act of March 3d, 1875, (18 U. S. Stat. at Large, 472,) that the Circuit Court shall dismiss a suit if the parties have been improperly or collusively made or joined for the purpose of creating a case cognizable under said Act, construed. *Fountain v. Town of Angelica*, 448
6. In this case the suit was dismissed, it appearing that the plaintiff had no substantial interest in the coupons sued on. *id.*
7. A Connecticut corporation was sued in a State Court in Vermont, by a citizen of New Hampshire, by process served on a statutory agent required by the laws of the State for the purpose. The suit having been removed into this Court, the defendant demurred to the bill for want of sufficient jurisdiction, acquired by the service: *Held*, that the appearance and demurrer established the jurisdiction. *Hale v. Continental Life Ins. Co.*, 515

See EQUITY, 2, 6.
INTERPLEADER, 2.
MUNICIPAL BOND, 3.
PLEADING, 9 to 12.
REMOVAL OF SUIT.
SALVAGE, 4.

L

LACHES.

See REMOVAL OF SUIT, 10.

LIEN.

See SEQUESTRATION.

M

MANHATTAN RAILWAY COMPANY.

See RAILROAD.

METROPOLITAN ELEVATED RAILWAY COMPANY.

See RAILROAD.

MONEY HAD AND RECEIVED.

1. G. recovered from the United States, by suit in the Court of Claims, money as the proceeds of cotton seized in the Southern States and sold. G. having died, L., his executor, was sued by M., to recover some of the money, as the proceeds of cotton which belonged to his assignor, a Virginia corporation. The proceeds being identified: *Held*:

(1.) Although the corporation was engaged in running the blockade, and in aiding the rebellion, it could have recovered itself, as it did not appear that the cotton was received by G. under any arrangement that it should be unlawfully used;

(2.) The assignment of the claim by the corporation to M. was valid;

(3.) The failure of the plaintiff to maintain an immaterial issue was disregarded, the material allegations of the bill being proved;

(4.) M. was not entitled to interest on the avails, unless it was received. *McCay v. Lamar*, 474

MORTGAGE.

See EQUITY, 1 to 3.

MUNICIPAL BOND.

1. By § 1 of the Act of the Legislature of New York, passed April 5th, 1871, (*Laws of New York*, 1871, vol. 1, chap. 298, p. 586,) the New York

and Oswego Midland Railroad Company was authorized to extend and construct its road from the city of Auburn, or from any point on said road easterly or southerly from said city, "upon such route and location and through such counties as the Board of Directors of said company shall deem most feasible and favorable for the construction of said railroad, to any point on Lake Erie or the Niagara river." It was also provided, that any town "in any county through or near which said railroad or its branches may be located" might aid the construction of the said railroad and its branches and extensions, by the issue and sale of its bonds, which were to be issued and executed by commissioners to be appointed by the county judge of the county in which the town was situated. In November, 1871, the Board of Directors of the company passed a resolution determining "that the construction and extension of the said railroad westerly commence at and from the village of Cortland in the said county: of Cortland, and thence to Lake Erie or the Niagara river." In October, 1871, commissioners were appointed for the town of Lansing, in Tompkins county, by the county judge of that county. In December, 1871, maps were filed in the office of the clerk of that county, locating parts of the "Auburn branch" of the road through the town of Lansing, and the road was made through that town to and through the adjoining town in another county, and on, for 26 miles in all, to a point in a farming community, unconnected with any other road, and began to run in the fall of 1872. In January, 1872, and afterwards, bonds of the town of Lansing were issued to the company, to the amount of \$75,000. and it received in exchange a certificate for 750 shares, of \$100 each, of the stock of the company: *Held*, that the "western extension" had nothing to do with the Auburn branch; that the resolution of the company was insufficient to authorize the issuing of any bonds by said town; that the said maps did not locate any part of the "western extension;" that there was no power in any town

to issue any bonds until all the counties through which the road was to pass had been designated by the directors; and that the absence of such location was fatal to the bonds even in the hands of a *bona fide* holder of them, although the town had paid some coupons on the bonds and had retained the certificate of stock. *Mellen v. Town of Lansing*, 278

2. An Act authorizing the commissioners of a town to borrow money and issue its bonds provided that the power conferred by the statute should only be exercised on the condition that the consent should first be obtained, in writing, of tax-payers appearing on the last assessment roll, representing a majority of the taxable property of the town, proof of which should be by the acknowledgment or proof thereof filed in the town and county clerk's offices and annexed to a copy of the assessment roll. The bonds of the town were issued, payable to bearer, and reciting that they were issued in pursuance of the Act. The plaintiff sued the town on some of the bonds, and at the trial proved that he obtained the bonds from a bank, and that its attorney, before the bank purchased them, examined a certified copy of the consent and assessment roll and ascertained therefrom that a majority of the persons on the roll had consented, and that the bank then bought the bonds and paid value for them, without notice of any defence. The defendant then offered in evidence a certified copy of the consent roll of the town, and a certified copy of the assessment roll, to show that the consent of a majority in value of the tax-payers was not obtained. The Court excluded the evidence. *Held*, no error. *Carrier v. Town of Shawangunk*, 307

3. The plaintiff purchased coupons from municipal bonds, at the suggestion of those who formerly owned them, with a view to collecting them in this Court, when it was supposed a recovery could not be obtained upon them in the State Courts. The former owners guaranteed the collection of the coupons. The plaintiff

was protected from costs if he was defeated, and he was not to pay for the coupons until two years and a half after the time of the purchase: *Held*, that he could maintain a suit against the town on the coupons, being the owner of them, and that his intent in acquiring them was immaterial. *McCall v. Town of Hancock*, 344

4. This Court held, in *Foots v. Town of Hancock*, (15 Blatchf. C. C. R., 343,) that a *bona fide* holder of coupons from bonds issued by the town of Hancock could recover on them notwithstanding the irregularities which took place in the issuing of the bonds. Afterwards, the Court of Appeals of New York, in *Cagwin v. Town of Hancock*, (84 N. Y., 532,) decided to the contrary: *Held*, that that decision of the State Court not having been made at the time the bonds were issued, and before the rights of purchasers had arisen, this Court was not bound to follow it. *id.*
5. The case of *Town of Venice v. Murdock*, (92 U. S., 494,) is controlling upon this Court in reference to the bonds of the town of Hancock, those bonds having been issued under a statute which authorized the commissioners of the town to issue the bonds only on the assent of a majority of the taxables, and which declared that the fact that such majority had been obtained should be "proved" by the affidavit of one of the assessors of the town. *id.*
6. The plaintiff is entitled to judgment although he failed to show that the requisite number of taxables had assented to the issuing of the bonds. *id.*

N

NATIONAL BANK.

See CRIMINAL LAW, 12.
TAX, 1, 8.

NAVIGATION.

See COLLISION.

NEGLIGENCE.

1. R., a passenger on a railroad car, was injured by the explosion of the boiler of the locomotive used to push the train, and sued the railroad company for negligence. At the trial he rested by proving the explosion. The employees of the defendant testified to due care in managing the boiler at the time of the explosion, that the boiler had recently been repaired and tested and found safe, and that the explosion resulted from a hidden flaw in the iron of the boiler, which could not be seen. The jury were instructed that they might infer negligence, upon the theory that the explosion would not have taken place unless the boiler had been in a defective condition, or unless there had been some omission or mismanagement on the part of those in charge of it at the time: *Held*, no error. *Robinson v. N. Y. Central & H. R. R. Co.*, 388
2. The jury were also instructed, that it was incumbent on the defendant, as a passenger carrier, to see to it, by every test recognized as necessary by experts, that the boiler was in a safe condition, but that it was not liable for a defect which could not be discovered by such tests: *Held*, no error. *id.*
3. As the testimony to rebut the presumption of negligence proceeded from persons who would be guilty of a criminal fault unless they vindicated themselves from such presumption, a question of credibility was presented for the jury, and they might disregard such testimony. *id.*
4. Negligence may be inferred from the fact of the explosion of a steam-boiler on a vessel, even where the defendant is under no contract obligation to the plaintiff. *Rose v. Stephens & Condit Transp. Co.*, 411
5. S. and others were sued personally and also in their representative capacity as executors and trustees under a will, for damages caused by the fall of a building owned by them as such executors and trustees, and which had been leased by them. A

verdict was had for the plaintiff, establishing that the building was unsafe at the time it was leased and that it fell without any contributory fault in the lessees or in the plaintiff. The plaintiff occupied an adjoining building: *Held*,

(1.) That the action could not be maintained against the defendants in their representative character, and the process, pleadings and proceedings must be amended by striking out the description of the defendants' official character, without the granting of a new trial;

(2.) That the defendants were liable as individuals for negligence in authorizing and sanctioning the acts of the tenants in the use of the property. *Boston Beef Packing Co. v. Stevens*, 448

NEW TRIAL.

1. In a suit to recover damages for personal injuries, the complaint alleged that the plaintiff had sustained severe injuries, and claimed \$5,000 damages. After a verdict for the plaintiff, the defendant moved for a new trial because of newly-discovered evidence relating to the extent of the plaintiff's injuries. It did not appear that before the trial the defendant had made any investigation as to the character or extent of those injuries. The motion was denied. *Rose v. Stephens & Condit Transportation Co.*, 465

See PRACTICE, 11.

NEW YORK ELEVATED RAILROAD COMPANY.

See RAILROAD.

P

PATENT.

1. Invention.
2. Novelty, (1.)
3. Abandonment.
4. Caveat.
5. Application.
6. Disclaimer.

7. Re-issue.
8. Assignment.
9. License.
10. Infringement, (2.)
11. Suit in Equity.
12. Injunction, (3 to 5.)
13. Patent for a Design.
14. Particular Patents.
 - (1.) McKean, Jackson and Brown—Bushing, (6 to 8.)
 - (2.) McCloskey—Soft-metal trap, (9, 10.)
 - (3.) Meyer and Neubauer—Wire-cage, (11, 12.)
 - (4.) Maxheimer—Bird-cage, (13 to 16.)
 - (5.) Gray—Head-covering, (17, 18.)
 - (6.) Mallory—Hat, (19 to 21.)
 - (7.) Averill—Paint, (22 to 24.)
 - (8.) Hetherington—Artificial honey-comb foundation, (25.)
 - (9.) Siedler—Plug tobacco, (26 to 29.)
 - (10.) Knibbs—Steam fire-engine pump, (30 to 34.)
 - (11.) Strobridge—Coffee-mill, (35 to 39.)
 - (12.) Meyer and Evans—India-rubber shoe, (40, 41.)
 - (13.) Davis—Box-loop, (42 to 47.)
 - (14.) Schuessler—Buckle-fastening, (48 to 50.)
 - (15.) Loercher—Harness-buckle, (51, 52.)
 - (16.) Holmes—Take-up for loom, (53, 54.)
 - (17.) Western Electric Mfg. Co.—Insulating telegraph wire, (55, 56.)
 - (18.) Barker—Bucket for chain-pump, (57 to 59.)
 - (19.) Coes—Wrench, (60, 61.)
 - (20.) Campbell and Clute—Burr for knitting-machine, (62 to 64.)
 - (21.) Searls—Whip-socket, (65, 66.)
 - (22.) Schneider—Shade-holder for lamp, (67.)
 - (23.) Hart—Neck-tie (68, 69.)
 - (24.) Wells—Fur hat-body machinery, (70, 71.)
 - (25.) Ives & Miller—Wagon-hub; Miller—Carriage-axle, (72, 73.)
 - (26.) Bruce—Printing-types, (74 to 76.)
 - (27.) Lindsay—Sleeve-supporter, (77 to 82.)
 - (28.) Cross—Fountain-pen, (83 to 85.)

- (29.) Textor—Design for newel-post, (86 to 88.)
- (30.) Naylor—Tin-lined lead pipe, (89 to 95.)
- (31.) Searls—Whip-socket; Searls—Whip-socket, (96 to 99.)
- (32.) Hoe and Tucker—Printing-press, (100 to 106.)
- (33.) Tyler—Cheese-hoop, (107.)
- (34.) Blake—Sewing a shoe; Blake—Shoe sewed, (108, 109.)
- (35.) Matthews—Soda-water apparatus, (110 to 112.)
- (36.) Hayes—Ventilator; Hayes—Sky-light, (3 patents; Hayes—Sky-light turret and conservatory, (113 to 117.)
- (37.) Perry & Co.—Coal-stove; Perry—Stove; Spear—Case-burning stove; Dickey and Perry—Heating stove, (118 to 124.)
- (38.) Perry and Sard, trustees—stove; Perry and Sard, trustees—Stove, (125, 126.)
- (39.) Searls—Whip-socket, (127, 128.)
- (40.) Brainard—Machine for washing shavings, (129, 130.)
- (41.) Gardner, Gardner and Gardner—Chair-seat, (131.)

1. *Invention.*

See 9, 38, 39, 48, 65, 66, 75, 76, 85, 90, 93, 103, 107, 113 to 126, 131.

2. *Novelty.*

1. An English provisional specification is not a patent, within § 4,920 of the Revised Statutes. *Coburn v. Schroeder*, 392

See 7, 14, 15, 18, 21, 25, 28, 29, 32, 38, 41, 46, 47, 51, 52, 55, 56, 65, 66, 78, 81, 84, 92, 105, 106, 110.

3. *Abandonment.*

See 33, 34, 79, 80.

4. *Caveat.*

See 108.

5. *Application.*

See 104.

6. *Disclaimer.*

See 107, 110, 180.

7. *Re-issue.*

See 6, 11, 12, 22 to 24, 37, 40, 44, 45, 54, 62, 63, 69, 73, 92, 97, 107, 113, 114, 116, 127, 128, 130.

8. *Assignment.*

See 94.

9. *License.*

See JURISDICTION, 3, 4.
95, 99.

10. *Infringement.*

2. In this suit, brought for the infringement of two letters patent for designs, one for a "lace purling" and the other for a "fringed lace fabric," the plaintiff introduced in evidence the patents and a "nubia" sold by the defendants, but examined no witness as to identity of design. The defendants introduced no testimony. In view of the decision in *Gorham Co. v. White*, (14 Wallace, 511,) and of the simple character of the designs of the patents, and of the absence of any testimony on the part of the defendants, the Court compared the nubia with the patents, as to design, and determined the question of identity from such comparison. *Jennings v. Kibbe*, 353

See 4, 8, 16, 36, 48 to 53, 59 to 61, 64, 67, 68, 70 to 72, 82, 91, 94, 102, 115, 117.

11. *Suit in Equity.*

See PLEADING, 1, 2.
PRACTICE, 7.
3 to 5.

12. *Injunction.*

3. It being doubtful whether there was

any invention in forming the bottom of a starch tray of sheet metal, it having before been made of wood and lined with metal, a preliminary injunction on a patent for so forming the bottom was refused. *N. Y. Grape Sugar Co. v. American Grape Sugar Co.*, 386

4. It would seem that the presumption arising from the grant of a patent, especially when not of recent date, ought to be a sufficient ground for granting a preliminary injunction against an infringer who does not attack the patent. *id*

5. Where a plaintiff had bought a patent and proposed to use it not by manufacturing under it, but by selling licenses, but had not established any license fee, and the defendant was responsible, and serious consequences to him would arise from granting a preliminary injunction, it was refused. *id*.

13. *Patent for a Design.*

See 86 to 88.

14. *Particular Patents.*

(1.) *McKean, Jackson and Brown—Bushing.*

6. Re-issued letters patent No 8,483, granted November 12th, 1878, to William C. McKean, George H. Jackson, and Jefferson Brown, Jr., for an "improvement in bushings for faucet holes," the original patent, No. 141,473, having been granted to Samuel R. Thompson, August 5th, 1873, are for an invention not described in the original, the original being for a particular form of wooden bushing, encased in an iron one, and the re-issue being for any form of wooden bushing in an iron one. *New York Bung and Bushing Co. v. Hoffman*, 3

7. The original patent was not void for want of novelty. *id*.

8. The defendant was held to have infringed, because he furnished

wooden bungs in iron casings, with a hole nearly through the bung, and intended to become the compound bushing of the re-issue, by the driving in of the remaining wood by the purchaser, by inserting a vent tube in tapping the barrel. *id.*

(2.) *McCloskey—Soft-metal trap.*

9. The decision (19 *Blatchf. C. C. R.*, 205) that letters patent No. 220,767, granted to John McCloskey, October 21st, 1879, for an improvement in soft metal traps, are void, for want of invention, confirmed. *McCloskey v. Dubois*, 7

10. A motion to open the case for new evidence was denied, the new evidence being designed to show only the improved quality of the metal in the traps of the patent, and such result being due to the process of manufacture. *id.*

(3.) *Meyer and Neubauer—Wire-cage.*

11. Re-issued letters patent No. 8,594, granted to John D. Meyer and Charles M. Neubauer, February 25th, 1879, for an improvement in wire cages, the original patent, No. 139,874, having been granted to Michael Grebner, June 10th, 1873, are invalid, being for a different invention from the original. *Meyer v. Maxheimer*, 15

12. The re-issue was, apparently, expanded beyond the original, to cover the intervening inventions of others. *id.*

(4.) *Maxheimer—Bird-cage.*

13. Letters patent No. 162,400, granted to John Maxheimer, April 20th, 1875, and letters patent No. 218,758, granted to him August 19th, 1879, each for improvements in bird cages, are valid. *Maxheimer v. Meyer*, 17

14. The first patent underlies all constructions of cages where the horizontal bands are held in place solely by shoulders formed on the upright wires. *id.*

15. An accidental and incidental effect, not observed, if it existed, held not to show prior invention. *id.*

16. An improvement, the use of which involves the use of a patented invention, infringes it, even though the improvement be patented. *id.*

(5.) *Gray—Head-covering.*

17. Letters patent granted to Robert Gray, September 9th, 1879, for an "improvement in head-coverings," are valid. *Bernard v. Heimann*, 21

18. The invention defined and distinguished from prior inventions. *id.*

(6.) *Mallory—Hat.*

19. Letters patent No. 74,392, granted February 11th, 1868, to George Mallory, for an "improvement in hats," are valid. *Mallory Mfg. Co. v. Marks*, 32

20. The claim of said patent, namely, "The combination of the brim of a hat with a drooping hoop, so that the brim is caused to droop at the front and the rear, and to rise at the sides, substantially as set forth," construed. *id.*

21. The question of novelty examined. *id.*

(7.) *Averill—Paint.*

22. Re-issued letters patent No. 7,031, granted April 4th, 1876, to Damon R. Averill, for an improvement in paints, the original patent, No. 66,773, having been granted July 16th, 1867, for an improved paint compound, are invalid. *Averill Chemical Paint Co. v. National Mixed Paint Co.*, 42

23. The original was for a paint composed of certain specified ingredients, two of which were emulsating agents, nothing being said about any vessel to contain the paint. The re-issue is for a paint of the same ingredients, other than the specified emulsating agents, with any emulsating agents, and packed in tight vessels. *id.*

24. The re-issue was granted on proof that, before the original application, the inventor had put up his paints in tight vessels: *Held*, that § 4,916 of the Revised Statutes did not authorize this to be done. *id.*

(8.) *Hetherington—Artificial Honey-comb foundation.*

25. The first claim of re-issued letters patent No. 8,962, granted to John E. Hetherington, November 11th, 1879, for an "improvement in artificial honey-comb foundations," the original patent having been granted to him October 1st, 1878, namely, "As a new article of manufacture, an artificial honey-comb foundation produced from a cake of wax having on each side a series of hexagonal depressions with flat bottoms, said bottoms forming a continuous sheet, from each side of which rise the ribs which form the borders of the hexagonal depressions, substantially as shown and described," claims nothing which was patentable, in view of what existed before. *Van Deusen v. Nellis*, 45

(9.) *Siedler—Plug-tobacco.*

26. Re-issued letters patent No. 7,362, granted, October 24, 1876, to Charles Siedler, for an improvement in plug tobacco, the original patent, No. 158,604, having been granted to him January 12th, 1875, are valid. *Lorillard v. Dohan*, 68

27. The invention covered by the re-issue, defined. *id.*

28. The date of an invention patented in Great Britain is the date when the specification was filed in the Great Seal Patent Office. *id.*

29. The question of the novelty of the invention, considered. *id.*

(10.) *Knibbs—Steam fire-engine pump.*

30. Letters patent No. 42,920, granted May 24th, 1864, to James Knibbs, for an improvement in steam fire-engine pumps, are valid. *Campbell v. The Mayor, &c.*, 67

31. The invention defined. *id.*

32. The question of its novelty examined. *id.*

33. Certain uses of the invention held to have been experimental. *id.*

34. Under §§ 7 and 15 of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119, 123,) and § 7 of the Act of March 8d, 1839, (*Id.*, 354,) a sale or use of an invention more than two years before the application for the patent, must, in order to defeat the patent, have been a public sale or use with the consent or allowance of the inventor. *id.*

(11.) *Strobridge—Coffee-mill.*

35. Re-issued letters patent No. 7,583, granted to Turner Strobridge, March 27th, 1877, for an improvement in coffee-mills, (the original patent, No. 159,467, having been granted to him February 2d, 1875, and re-issued to him as No. 7,174, June 13th, 1876,) are valid. *Strobridge v. Landers*, 78

36. The first claim of said re-issue, namely, "A coffee or similar mill, having a detachable hopper and grinding shell, formed in a single piece, and suspended within the box by the upper part of the hopper, or a flange thereon, substantially as and for the purpose specified," is infringed by a mill constructed in accordance with the description and drawings of letters patent No. 204,865, granted to Rodolphus L. Webb, June 11th, 1878. *id.*

37. The re-issue is not for a different invention from the original, and does not contain new matter. *id.*

38. The questions of novelty and patentability considered. *id.*

39. The devices contained in the first claim held to be a combination and not merely an aggregation of parts. *id.*

(12.) *Meyer and Evans—India-rubber shoe.*

40. Re-issued letters patent granted to Christopher Meyer and Mary A. Ev-

1875, the original patent, No. 100,385, having been granted to said Spear, as inventor, March 1st, 1870, and re-issued to him in two divisions, Nos. 5,459 and 5,460, June 17th, 1873, and again re-issued in two divisions, January 5th, 1875, No. 6,206, Division A, and No. 6,207, Division B, namely, "4. The combination of a fire-chamber having its clinker-discharge end E grated or illuminating and projecting downward within the air-chamber S, a grate surface or fire-bed projecting beyond the inside diameter of the grate and clinker-discharge end of the fire-chamber, and the clinker-clearing opening R, substantially as herein described," does not claim a patentable invention, because it was only the substitution, in an existing combination, for a fire-chamber with its clinker-discharge end non-grated, of an existing fire-chamber with a grated clinker-discharge end, the substitution working no change in the operation of the parts. *id.*

122. Claims 6, 7 and 8 of said patent, namely, "6. The combination of the vertical clinker-cleaning opening R, and mica lights d^2 , in doors opposite the opening, substantially as described." "7. The combination of the vertical clinker-cleaning opening R, mica lights d^2 , and clinker-cleaning doors C, opposite the opening, substantially as herein described." "8. The combination of a fire-chamber, the clinker-cleaning opening R, between the fire-chamber and grate surface, clinker-cleaning doors C, opposite the said opening, and mica lights d^1 , opposite the illuminating section E, of the fire-chamber, substantially as described," do not claim patentable combinations, there being no patentable combination between the mica lights and the other elements in those claims. *id.*

123. Claim 12 of said patent, namely, "12. The combination of a fire-chamber, having its grate and clinker-discharge end contracted and projecting downward, a grate-ring, K, and a clinker-cleaning opening, R, above the ring, substantially as herein described," does not claim any patentable invention, there being no rela-

tion or co-action between the lower end of the fire-pot and the laterally projecting grate and the space outside of the grate, which did not exist between the lower ends of prior uncontracted fire-pots and the projecting grates and the outside spaces in prior structures. *id.*

124. Claim 2 of letters patent No. 183,545, for an "improvement in heating stoves," granted to Andrew Dickey and John S. Perry, as inventors, October 24th, 1876, namely, "2. The combination of ascending and descending flues placed in the rear of a stove, a free open space between the top of the grate and the lower end of the fire-pot, sufficiently large to permit the removal of clinkers and other obstructions, illuminating windows opposite said space, and a grate or fire-bed having an open space between it and the walls of the stove, to admit of clinkers and other obstructions being dropped between the grate and said walls of the stove, into the ash-pit, substantially as described," does not claim a patentable combination, but only an aggregation of prior revertible flues with other features before existing in unison in the same stove, those features operating together in the same way whether with or without revertible flues. *id.*

(38.) *Perry and Sard, trustees—Stove.*
Perry and Sard, trustees—Stove.

125. Claims 1 and 4 of re-issued letters patent No. 9,247, granted to John S. Perry and Grange Sard, Jr., trustees, June 8th, 1880, for an "improvement in stoves," the original patent, No. 54,938, having been granted to John R. Moore, as inventor, May 22d, 1866, and having been re-issued as No. 6,732, November 9th, 1875, namely, "1. The combination with the grate or fire-bed of a stove, of a downwardly-contracted fire-pot, the two being so arranged relatively to each other as to leave an opening between them, substantially as and for the purpose set forth." "4. The combination, in a stove, of a downwardly-contracted fire-pot and a dumping-grate, the two being arranged relatively to each other so as

to leave an opening between them, substantially as and for the purpose set forth," do not claim patentable inventions, there being no invention in combining an old downwardly-contracted fire-pot with an old anti-clinker opening and dumping-grate. *Perry v. Co-operative Foundry Co.*, 505

126. Claim 1 of re-issued letters patent No. 9,252, granted to John S. Perry and Grange Sard, Jr., trustees, June 15th, 1880, for an "improvement in stoves," the original patent, No. 89,804, having been granted to Calvin Fulton, as inventor, April 27th, 1869, and having been re-issued as No. 5,907, June 9th, 1874, namely, "1. A stove grate so constructed and arranged relatively to the fire-chamber or fuel-receptacle as to leave between the two and around the edge of the grate a free open space, and to permit of the removal of clinkers and other refuse through such space, by use of the ordinary poker or slicer, substantially as described," does not claim a patentable invention, all that was done being to substitute an existing flat grate for a dished grate, in an existing arrangement of a dished grate and a fire-pot with an anti-clinker opening between them. *id.*

(39.) *Searls—Whip-socket.*

127. The second claim of re-issued letters patent No. 9 297, granted to Anson Searls, July 13th, 1880, for an improvement in whip-sockets, the original patent, No. 150,195, having been granted to him April 28th, 1874, is void, under the cases of *Miller v. Brass Co.*, (104 U. S., 350,) and *James v. Campbell*, (*Id.*, 356,) because the claim of the original was limited to a bell-shaped top and the claim of the re-issue is not so limited. *Searls v. Bouton*, 528

128. The question of delay in the re-issue held to be open for consideration under the answer. *id.*

(40.) *Brainard—Machine for washing shavings.*

129. Claim 4 of re-issued letters patent

No. 8,099, granted to Edwin D. Brainard, as assignee of Frederick Hinckel, February 26th, 1878, for an improved machine for washing shavings in breweries, the original patent, No. 85,528, having been granted January 5th, 1869, namely, "A vessel capable of rotation on its axis, in combination with a perforated pipe for producing jets of water within such vessel, substantially as described," is substantially identical with claim 1 of the original, namely, "A hollow perforated shaft, in combination with the cylinder and the frame arranged and operating substantially in the manner and for the purpose described," and is valid, although, in the original, the cylinder is described as suspended horizontally on the shaft, and as rotating by the revolution of the shaft, while in the re-issue it is not stated to be suspended horizontally, but to be so constructed as to admit of a rotating or reciprocating action. *Brainard v. Cramme*, 180

130. The re-issue containing claims for the process worked out by the apparatus, which claims were not in the original, the plaintiff was allowed to recover on claim 4 of the re-issue, without costs, on filing a disclaimer as to the claim for the process. *id.*

(41.) *Gardner, Gardner and Gardner—Chair-seat.*

131. Claim 2 of re-issued letters patent No. 9,094, granted, February 24th, 1880, to Oliver L. Gardner, William Gardner, and Jane E. Gardner, assignees of George Gardner, for an improvement in chair-seats, namely, "A chair-seat made of laminæ of wood glued together, with the grains in one layer crossing those of the next, concave on the upper surface, convex on the lower surface, and perforated, as a new article of manufacture, substantially as set forth," (the original patent, No. 127,045, having been granted to George Gardner, May 21st, 1872, and re-issued as No. 7,203, July 4th, 1876,) does not claim any patentable invention, the form of the seat being old, the material being old, and the method of impart-

burrs," on the invention of said Carr, considered, in view of the specification and claims of the original patent. *Campbell v. Kavanaugh*, 256

63. A hub, composed of two slotted rings, secured together, with an outwardly narrowed annular space between the inner ends of the rings, is not claimed in the re-issue, either by itself or in combination with the rings, but such a hub was claimed in claim 2 of the original, and was claimed in combination with the rings, in claim 3 of the original, and was made a prominent feature of invention in the original. The original showing that the inventor had no idea of using hub rings not slotted, or of an interior annular space in a hub not formed of two slotted rings, claims 2 and 3 of the re-issue must be construed as referring to no hub other than one formed of two slotted rings, and to no annular space except one between two slotted hub rings. *id.*

64. The patent is not infringed by making and selling rings like the ring of the patent, if they are not sold to be used in a burr like that of the patent, there being no claim in the patent to a ring other than a ring to be used in a hollow slotted hub. *id.*

(21.) *Searls—Whip-socket.*

65. The claims of letters patent No. 221,482, granted to Anson Searls, as assignee of John M. Underwood, the inventor, November 11th, 1879, for an "improvement in whip sockets," namely, "1. The combination with a whip socket having an annular recess in it, of a flexible elastic ring, which may be held in such recess by its own elastic force, and which is provided on its inner edge with non-contiguous projections, separated so that they cannot be pressed into contact with one another by the insertion of the whip stock into the ring. 2. The ring composed of a body with such projections," are invalid, for want of invention. *Searls v. Merriam*, 263

66. A ring with inward non-contiguous projections existed before, though not used with the annular recess, and

the annular recess existed before, used with a plain ring. *id.*

(22.) *Schneider—Shade-holder for lamp.*

67. Re-issued letters patent No. 7,511, granted to Bennett B. Schneider, February 13th, 1877, for an "improvement in shade-holders for lamps," the original patent, No. 182,978, having been granted to Carl Votti, as inventor, October 3d, 1876, do not describe the shape or size of the parts, or the proportion of the parts of the shade, or the principle which is to govern the construction of the shade as to size and proportions, and there is no infringement of the patent by a shade which is not of the form and dimensions and size and height and proportions of the shade shown in the drawings of the patent. *Schneider v. Lovell*, 311

(23) *Hart—Neck-tie.*

68. Re-issued letters patent, No. 7,909, granted to William H. Hart, Jr., October 9th, 1877, for an "improvement in neck-ties," the original patent, No. 159,921, having been granted to him February 16th, 1875, are not infringed by a pin constructed according to the description in letters patent. No. 206,673, granted to Albert M. Smith and Hiram H. Thayer, April 23d, 1878. *Hart v. Thayer*, 315

69. If the re-issue claims more than the original, so as to cover the defendant's pin, it covers new matter not found in the original, and is for an invention not shown in the original. *id.*

(24.) *Wells—Fur hat-body machinery.*

70. Claim 5 of re-issued letters patent No. 2,942, granted May 19th, 1868, to Eliza Wells, administratrix of Henry A. Wells, for "improvements in machinery for making hat bodies of fur," is not infringed by the Gill machine. *Brett v. Quintard*, 320

71. Under the decisions in regard to this patent, in *Burr v. Duryee*, (1 Wall., 531,) and in *Gill v. Wells*, (22

Wall., 1,) the Wells machine and the Gill machine contain two radically different vehicles for the transmission of fur. *id.*

(25.) *Ives & Miller—Wagon-hub.*
Miller—Carriage-axle.

72. Re-issued letters patent, No. 8,179, granted May 20th, 1879, to Ives & Miller, as assignees of Welcome C Tucker, for an improvement in wagon hubs, the original patent having been granted September 10th, 1867, and letters patent granted to Willis E. Miller, February 12th, 1878, for an improvement in carriage axles, are not infringed by carriage axles made under letters patent granted to Ellsworth D. Ives, June 10th, 1879, and November 2d, 1880. *Ives v. Hartford Spring and Axle Co.*, 383

73. Unless the general language of said re-issue is construed in accordance with the state of the art and with the limitations of the original patent in regard to the form of the flanges, the re-issue is broader than the invention, and includes devices different from those which were intended to be the subject of the original patent. *id.*

(26.) *Bruce—Printing-types.*

74. Letters patent No. 139,365, granted to David W. Bruce, May 27th, 1878, for an improvement in printing types, are valid. *Bruce v. Marder*, 355

75. The invention defined, and held to be patentable. *id.*

76. The claim construed by the language of the specification. *id.*

(27.) *Lindsay—Sleeve-supporter.*

77. Letters patent, No. 202,735, granted to John P. Lindsay, April 23d, 1878, for an "improvement in sleeve supporters," are valid. *Lindsay v. Stein*, 370

78. The patented supporter consists of two of the clasps patented to Lindsay by patent No. 156,429, November 8d, 1874, one at each end of a connection either elastic or non-elas-

tic. But the case is not one of a mere double use of the clasp. *id.*

79. Lindsay applied for a patent for the supporter in October, 1874. The application was rejected in November, 1874, and again in January, 1875, and nothing more was done upon it. In April, 1878, a new application was filed, on which the patent was granted: *Held*, that, under § 4,894 of the Revised Statutes, the first application was abandoned, because not prosecuted within two years after its rejection, but the invention was not thereby abandoned, and a second application could be made. *id.*

80. The patent would be invalid if the invention covered by it were in public use or on sale in this country for more than two years before the second application. *id.*

81. The features of Lindsay's invention pointed out, on the question of novelty. *id.*

82. The question of the infringement of the patent considered. *id.*

(28.) *Cross—Fountain-pen.*

83. Letters patent No. 199,621, granted to Alonzo T. Cross, January 29th, 1878, for an improvement in fountain pens, are valid. *Cross v. McKinnon*, 395

84. The principal distinctive feature of the patent is a spring working between the vibrating writing pin and the air-tube, to project the pin and restrain the flow of ink when the pen is not in use, and yield to the pressure of the point of the pin and make room for the flow of ink when the pen is in use. The invention is not anticipated by a pen in which the vibrating point was actuated by a weight instead of a spring. *id.*

85. A claim to the vibrating pin and spring combined with the air-tube, case of the pen and ink-tube, is a valid claim to a combination. *id.*

(29.) *Textor—Design for newel-post.*

86. The 5th claim of design letters pat-

- ent, No. 12,026, granted to Henry Textor, November 9th, 1860, for a design for newel posts, namely, "A design for the upper portion of a newel post, consisting of the scrolled ornaments, *l*, and the bead, *m*, the roses or rosettes, *n*, upon each side, as specified," is not a claim to a single ornament, within § 4,929 of the Revised Statutes. *Simpson v. Davis*, 413
87. It would seem that the design for the cap of a newel post is a design for a manufacture, within said statute. *id.*
88. A newel post of a certain shape, having ornaments and a cap, is an article of manufacture, within said statute. *id.*
- (80.) *Naylor—Tin-lined lead pipe.*
89. The second claim of re-issued letters patent, No. 3,744, granted to Peter Naylor, assignee of William Anthony Shaw, November 23d, 1869, for an improvement in the manufacture of tin-lined lead pipe, the original patent, No. 74,618, having been granted to said Shaw, February 18th, 1868, antedated February 6th, 1868, is valid. *Shaw v. Colwell Lead Co.*, 417
90. The invention defined. *id.*
91. The questions of novelty and infringement considered. *id.*
92. Public use for two years before the application for the re-issue of a patent does not affect its validity. *id.*
93. It is sufficient for an invention to be useful in itself to be patentable, and it is not necessary it should be better than what was before known. *id.*
94. The right to recover for infringements of a patent is assignable. *id.*
95. The question of a verbal license to the defendant to use the patented invention, considered. *id.*
- (31.) *Searls—Whip-socket.*
Searls—Whip-socket.
96. The second claim of re-issued letters patent No. 9,297, granted to Anson Searls, July 13th, 1880, for an improvement in whip sockets, the original, No. 150,195, having been granted April 28th, 1874, and letters patent No. 231,510, granted August 24th, 1880, to Anson Searls, assignee of John M. Underwood, for an improvement in whip sockets, are valid. *Searls v. Bouton*, 426
97. The question of the difference between the re-issue and the original patent cannot be considered unless the original is put in evidence. *id.*
98. The answer alleged prior knowledge by persons named, but not prior use, and alleged that said persons were "of" a place named, but did not allege knowledge there or at any other place. Although knowledge at the place named was proved, the proof was objected to because the defence was not alleged in the terms provided by statute, and it was held that the defence could not prevail. *id.*
99. The question of a license considered. *id.*
- (32.) *Hoe and Tucker—Printing-press.*
100. Claims 3 and 4 of letters patent No. 181,217, granted to Richard M. Hoe and Stephen D. Tucker, September 10th, 1872, for an "improvement in printing presses," namely, "3. Separating two following sheets of papers, in their travel to the fly frame, into two different paths, by an arrangement of tapes and switches, and making the travel of one sheet suitably longer than the other, so that, when they meet again, they will issue one upon the other to the fly, substantially in the manner described and specified. 4. The employment and use of the adjusting roller 59, for regulating the travel of the first sheet, constructed and operating substantially in the manner described and specified," are valid. *Hoe v. Kahler*, 430
101. Claim 3 is for an arrangement of tapes and switches, which separates two following sheets of the printed papers, in their travel to the fly-

frame, into two different paths, the travel of one of the two sheets in its path being suitably longer than the travel of the other of the two sheets in its path, so that, when the two sheets meet again, they will issue one accurately superimposed upon the other, to the fly. *id.*

102. The defendant's apparatus had no fly-frames, the sheets in it issuing in pairs to a folding apparatus, and it had single-acting switches, instead of double-acting switches, at the point where the longer and shorter paths took their departure, and it had no switches to separate the sheets after they had issued in pairs, but it was held to infringe claim 8. *id.*

103. H., one of the patentees, filed in the Patent Office, in 1854, a caveat describing the invention covered by claim 8, and illustrated it by drawings in a manner sufficiently full and clear to have enabled the apparatus to be built and put in practice. In the affidavit to the caveat, H. swore that he verily believed himself to be the original and first inventor of the improvement. The caveat was renewed in each year from 1860 to 1869, both inclusive. The patent was applied for in April, 1872. H. and T. were the joint inventors of what is embraced in the patent, and H. was not the sole inventor. H. believed, at the time, that he was the sole inventor. He was so advised by his counsel at the time, on the ground that, although he and T. were mutual inventors, the fact that T. was the hired employee of H. made the invention the property of H. and authorized the taking of the caveat in the name of H. alone. T. concurred at the time in that view: *Held*, that there was nothing connected with the caveat to interfere with the validity of the patent, or to prevent the carrying back of the invention, as a joint invention, to the date of the original filing of the caveat. *id.*

104. In the contents of the file-wrapper was an oath to the specification and application, sworn to by H., at London, England, before "a London commissioner to administer oaths in

common law." No other oath by H. appeared now among the contents of the file-wrapper. There was a proper oath by T. The London commissioner was not an officer specified in § 80 of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 202,) as one before whom the oath could be taken. The bill alleged "due application." The answer denied that allegation generally, but did not point out any defect as to the oath of H. The plaintiffs put in evidence the patent. The defendant put in evidence the file-wrapper and contents, under the plaintiffs' objection. The defendant took no objection, in the record of the testimony, as to the oath, or as to the putting in evidence the patent. The defendant did not show that there was no proper oath by H. or that the oath appearing was the only oath he made: *Held*, that it was not shown that there was not a proper oath by H., and that the presumption arising from the grant of the patent and from the recitals in it was not rebutted. *id.*

105. Priority of completion of mechanism, as well as priority of invention, determined in favor of H. and T., as between them and C. *id.*

106. Claim 4 is a claim to the adjusting roller for regulating the travel of the first sheet, in its longer path, relatively to the travel of the second sheet, in its shorter path, and involves the two several series of tapes of the two several paths. The adjustment of the relative lengths of the two paths to each other, by modifying the length of the longer one, through an adjustment of the roller acting on the longer tapes, is the point of the claim. Such invention was new. *id.*

(38.) *Tyler—Cheese-hoop.*

107. The first claim of re-issued letters patent granted, August 5th, 1879, to Leman W. Tyler, as assignee of William Sternberg, for an improvement in cheese-hoops, the original patent having been granted to said Sternberg, March 21st, 1871, is an inexact claim, which, if construed

according to its natural meaning, would include an invention broader than the one which was made. If a limited construction be given to it, it would be substantially the same as the second claim of the re-issue. The second claim of the re-issue being valid and infringed, the Court held that the plaintiff could have a decree on it, without costs, on disclaiming the first claim. *Tyler v. Galloway*, 445

(34.) *Blake—Sewing a shoe.*
Blake—Shoe sewed.

108. Lyman R. Blake invented an improvement in sewing machines, by which the soles and uppers of shoes could be sewed together by chain stitches, and obtained a patent for it, No. 20,775, July 6th, 1858. It was extended for 7 years and expired July 6th, 1879. August 14th, 1860, he obtained two other patents, Nos. 25,961 and 25,962, one for the process of sewing a shoe so sewed, and the other for the shoe sewed by such process. August 13th, 1874, they were extended for 7 years. January 13th, 1880, No. 29,561, was re-issued as No. 9,043. J. took a lease of a machine from the plaintiff, with the right to use it under all three of the patents, during the term of either, for license fees for all shoes made on it. After No. 20,775 expired, S. made machines for sewing shoes by said process and sold them to the other defendants, who used them. J. and S. and the other defendants were sued, after No. 20,775 expired, for infringing No. 25,962 and re-issue No. 9,043. Blake did not invent a shoe sewed with such stitch: *Held*, that the machine alone was patentable and not the process or the product. *McKay v. Jackman*, 466

109. The bill was dismissed as to all the defendants and subject-matter except the arrears of license fees due by J. for the use of the machine. *id.*

(35.) *Matthews—Soda-water apparatus.*

110. The 5th and 7th claims of re-issued letters patent No. 9,028, granted, January 6th, 1880, to John Mat-

thews, for soda-water apparatus, the original patent, No. 50,255, having been granted to him October 3d, 1865, are void for want of novelty. *Matthews v. Spangenberg*, 482

111. The 4th, 6th, 8th and 9th claims are valid. The parts patented in them being definitely distinguishable from the parts claimed in the 5th and 7th claims, and having been infringed, and the patentee having made the latter claims by mistake, supposing himself to be the first inventor of the parts claimed in them, without any wilful default or intent to defraud or mislead the public, and not having unreasonably neglected thus far to enter a disclaimer of those parts, it was held that he was entitled to maintain this suit, but without costs, on entering the proper disclaimer. *id.*

112. Some of the defendants' evidence was taken out of time, but, as no motion was filed to suppress it, it was allowed to stand and was considered. *id.*

(36.) *Hayes—Ventilator.*
Hayes—Sky-light (3 patents.)
Hayes—Sky-light turret and conservatory.

113. Re-issued letters patent, No. 8,597, granted to George Hayes, February 25th, 1879, for an "improvement in ventilators," the original patent, No. 94,203, having been granted to him August 31st, 1869, are void, because a feature nowhere alluded to in the original patent has been inserted in the re-issue and made an essential part of the invention, and a necessary element in each claim. *Hayes v. Seton*, 484

114. Claims 3 and 4 of re-issued letters patent No. 8,674, granted to George Hayes, April 15th, 1879, for an "improvement in sky-lights," the original patent, No. 100,143, having been granted to him February 22d, 1870, and having been re-issued as No. 5,693, December 23d, 1873, are invalid, because of the omission from the latter described in those claims, of a stay-plate, which the original patent describes as an essential feat-

ure of the invention. Claim 6 is invalid, because it omits a moulding and a stay-plate, designated in the original patent as essential features of the invention. As to claims 7, 9, 10, 11, 12, 13, 14 and 15, any right which the patentee may have had to secure by letters patent what is covered by those claims was lost by delaying to assert such right for over 9 years from the date of the original patent. *id.*

115. Claim 1 of re-issued letters patent No. 8,675, granted to George Hayes, April 15th, 1879, for an "improvement in sky-lights," the original patent, No. 106,157, having been granted to him August 9th, 1870, considered. Claims 2 and 6 held not to have been infringed. *id.*

116. Claims 1 and 3 of re-issued letters patent No. 8,688, granted to George Hayes, April 29th, 1879, for an "improvement in sky-lights," the original, No. 112,594, having been granted to him March 14th, 1871, are invalid, because for different inventions from those described in the original patent. Claim 2 considered. Claim 5 held to be void. *id.*

117. Claim 3 of re-issued letters patent No. 8,689, granted to George Hayes, April 29th, 1879, for an "improvement in sky-light turrets and conservatories," held not to have been infringed. *id.*

(37.) *Perry & Co.—Coal-stove.*

Perry—Stove.

Spear—Base-burning stove.

Dickey and Perry—Heating stove.

118. Claim 3 of re-issued letters patent No. 6,709, granted to Perry & Co., October 19th, 1875, for an "improvement in coal stoves," the original patent, No. 50,073, having been granted to Zebulon Hunt, as inventor, September 19th, 1865, namely, "3. The adjoining flues, D and D', situated at the rear of the stove, and having walls built on the casing of the same, in combination with the illuminating doors or windows in the draft-chamber base-section," does not claim a patentable combination, be-

cause the flues operate in the same manner whether there are illuminating windows in the place designated or not, and the operation of such windows is the same whether the flues are arranged as described or not. *Perry v. Co-operative Foundry Co.,* 498

119. Claim 4 of re-issued letters patent No. 5,894, granted to John S. Perry, June 2d, 1874, for an "improvement in stoves," the original patent, No. 67,288, having been granted to Charles H. Frost, as inventor, July 30th, 1867, namely, "4. A grate or fire-bed with its central and outer sections made separately, and placed in a plane below the base of the fire-pot or combustion-chamber proper, within the draft-chamber base-section, and isolated from the walls of the same, substantially as shown and described," does not claim any patentable invention, there being no invention in substituting, in the given combination, an old grate made in two parts for another old grate made in one part, preserving the same relation of the grate to the fire-pot and to the ash-pit walls, when no distinctive effect in the combination results from the substitution. *id.*

120. Claim 11 of said patent, namely, "11. The combination of mica or other transparent windows in the walls of the draft-chamber base-section, a grate or fire-bed placed in a plane below the base of the fire-pot or combustion-chamber proper, the free open space formed between the same, and the said grate or fire-bed isolated from the walls of the said draft-chamber base-section, substantially as shown and described," does not claim any patentable invention, because a window in an ash-pit cannot modify or affect the action or operation of the grate or of the anti-clinker space, or the isolation of the grate, nor is the operation or use of the windows affected or modified by the existence or non-existence of any of those features. *id.*

121. Claim 4 of re-issued letters patent No. 6,206, Division A, for an "improvement in base-burning stoves," granted to James Spear, January 5th,

1875, the original patent, No. 100,835, having been granted to said Spear, as inventor, March 1st, 1870, and re-issued to him in two divisions, Nos. 5,459 and 5,460, June 17th, 1873, and again re-issued in two divisions, January 5th, 1875, No. 6,206, Division A, and No. 6,207, Division B, namely, "4. The combination of a fire-chamber having its clinker-discharge end E grated or illuminating and projecting downward within the air-chamber S, a grate surface or fire-bed projecting beyond the inside diameter of the slate and clinker-discharge end of the fire-chamber, and the clinker-clearing opening R, substantially as herein described," does not claim a patentable invention, because it was only the substitution, in an existing combination, for a fire-chamber with its clinker-discharge end non-grated, of an existing fire-chamber with a grated clinker-discharge end, the substitution working no change in the operation of the parts. *id.*

122. Claims 6, 7 and 8 of said patent, namely, "6. The combination of the vertical clinker-cleaning opening R, and mica lights d^2 , in doors opposite the opening, substantially as described." "7. The combination of the vertical clinker-cleaning opening R, mica lights d^2 , and clinker-cleaning doors C, opposite the opening, substantially as herein described." "8. The combination of a fire-chamber, the clinker-cleaning opening R, between the fire-chamber and grate surface, clinker-cleaning doors C, opposite the said opening, and mica lights d^1 , opposite the illuminating section E, of the fire-chamber, substantially as described," do not claim patentable combinations, there being no patentable combination between the mica lights and the other elements in those claims. *id.*

123. Claim 12 of said patent, namely, "12. The combination of a fire-chamber, having its slate and clinker-discharge end contracted and projecting downward, a grate-ring, K, and a clinker-cleaning opening, R, above the ring, substantially as herein described," does not claim any patentable invention, there being no rela-

tion or co-action between the lower end of the fire-pot and the laterally projecting grate and the space outside of the grate, which did not exist between the lower ends of prior uncontracted fire-pots and the projecting grates and the outside spaces in prior structures. *id.*

124. Claim 2 of letters patent No. 183,545, for an "improvement in heating stoves," granted to Andrew Dickey and John S. Perry, as inventors, October 24th, 1876, namely, "2. The combination of ascending and descending flues placed in the rear of a stove, a free open space between the top of the grate and the lower end of the fire-pot, sufficiently large to permit the removal of clinkers and other obstructions, illuminating windows opposite said space, and a grate or fire-bed having an open space between it and the walls of the stove, to admit of clinkers and other obstructions being dropped between the grate and said walls of the stove, into the ash-pit, substantially as described," does not claim a patentable combination, but only an aggregation of prior revertible flues with other features before existing in unison in the same stove, those features operating together in the same way whether with or without revertible flues. *id.*

(38.) *Perry and Sard, trustees—Stove.*
Perry and Sard, trustees—Stove.

125. Claims 1 and 4 of re-issued letters patent No. 9,247, granted to John S. Perry and Grange Sard, Jr., trustees, June 8th, 1880, for an "improvement in stoves," the original patent, No. 54,988, having been granted to John R. Moore, as inventor, May 22d, 1866, and having been re-issued as No. 6,732, November 9th, 1875, namely, "1. The combination with the grate or fire-bed of a stove, of a downwardly-contracted fire-pot, the two being so arranged relatively to each other as to leave an opening between them, substantially as and for the purpose set forth." "4. The combination, in a stove, of a downwardly-contracted fire-pot and a dumping-grate, the two being arranged relatively to each other so as

to leave an opening between them, substantially as and for the purpose set forth," do not claim patentable inventions, there being no invention in combining an old downwardly-contracted fire-pot with an old anti-clinker opening and dumping-grate. *Perry v. Co-operative Foundry Co.*, 505

126. Claim 1 of re-issued letters patent No. 9,252, granted to John S. Perry and Grange Sard, Jr., trustees, June 15th, 1880, for an "improvement in stoves," the original patent, No. 89,804, having been granted to Calvin Fulton, as inventor, April 27th, 1869, and having been re-issued as No. 5,907, June 9th, 1874, namely, "1. A stove grate so constructed and arranged relatively to the fire-chamber or fuel-receptacle as to leave between the two and around the edge of the grate a free open space, and to permit of the removal of clinkers and other refuse through such space, by use of the ordinary poker or slicer, substantially as described," does not claim a patentable invention, all that was done being to substitute an existing flat grate for a dished grate, in an existing arrangement of a dished grate and a fire-pot with an anti-clinker opening between them. *id.*

(39.) *Searls—Whip-socket.*

127. The second claim of re-issued letters patent No. 9 297, granted to Anson Searls, July 13th, 1880, for an improvement in whip-sockets, the original patent, No. 150,195, having been granted to him April 28th, 1874, is void, under the cases of *Miller v. Brass Co.*, (104 U. S., 350,) and *James v. Campbell*, (*Id.*, 356,) because the claim of the original was limited to a bell-shaped top and the claim of the re-issue is not so limited. *Searls v. Bouton*, 528

128. The question of delay in the re-issue held to be open for consideration under the answer. *id.*

(40.) *Brainard—Machine for washing shavings.*

129. Claim 4 of re-issued letters patent

No. 8,099, granted to Edwin D. Brainard, as assignee of Frederick Hinckel, February 26th, 1878, for an improved machine for washing shavings in breweries, the original patent, No. 85,528, having been granted January 5th, 1869, namely, "A vessel capable of rotation on its axis, in combination with a perforated pipe for producing jets of water within such vessel, substantially as described," is substantially identical with claim 1 of the original, namely, "A hollow perforated shaft, in combination with the cylinder and the frame arranged and operating substantially in the manner and for the purpose described," and is valid, although, in the original, the cylinder is described as suspended horizontally on the shaft, and as rotating by the revolution of the shaft, while in the re-issue it is not stated to be suspended horizontally, but to be so constructed as to admit of a rotating or reciprocating action. *Brainard v. Cramme*, 130

130. The re-issue containing claims for the process worked out by the apparatus, which claims were not in the original, the plaintiff was allowed to recover on claim 4 of the re-issue, without costs, on filing a disclaimer as to the claim for the process. *id.*

(41.) *Gardner, Gardner and Gardner—Chair-seat.*

131. Claim 2 of re-issued letters patent No. 9,094, granted, February 24th, 1880, to Oliver L. Gardner, William Gardner, and Jane E. Gardner, assignees of George Gardner, for an improvement in chair-seats, namely, "A chair-seat made of laminæ of wood glued together, with the grains in one layer crossing those of the next, concave on the upper surface, convex on the lower surface, and perforated, as a new article of manufacture, substantially as set forth," (the original patent, No. 127,045, having been granted to George Gardner, May 21st, 1872, and re-issued as No. 7,208, July 4th, 1876,) does not claim any patentable invention, the form of the seat being old, the material being old, and the method of impart-

ing the form to the material being old. *Gardner v. Herz*, 588

PLEADING.

1. The defendant in a suit in equity for the infringement of letters patent, without answering the bill, filed a plea merely denying infringement. The plaintiff moved that the plea be stricken from the files as improper or else be ordered to stand as an answer. In answer to the motion, the defendant showed, by affidavit, that he had other defences which he wished to raise by answer, especially prior patents anticipating the plaintiff's patent, and, also, limiting its scope so as to render infringement impossible, and that to take evidence in regard thereto would be expensive to both parties: *Held*, that the plea must be stricken from the files, with leave to the defendant to answer. *Sharp v. Reissner*, 10
2. A defendant in a suit in equity for the infringement of letters patent cannot demur to the whole bill and also answer the whole bill, especially where the answer sets up everything that is in the demurrer, and he will, on motion, be compelled to elect between his demurrer and his answer. *Adams v. Howard*, 38
3. A plea to a bill in equity, that there are divers and sundry persons whose names are known to and ascertainable by the plaintiffs and not by the defendant, not setting forth any names, and not accompanied by an answer, but accompanied by a demurrer for want of parties, is not a good plea. *Dwight v. Central Vermont R. R. Co.*, 200
4. Stockholders in a railroad company filed a bill against the directors of that company, alleging a refusal of the directors to take legal measures to protect their rights, and against the party in possession of the road of that company, and the lessee of it, and persons claiming liens on it, to recover possession of the road for said company. To this bill a plea was filed alleging that the company had brought a like suit in a Court of

the State and had discontinued it, through its directors, by preconcert with the plaintiffs, that this suit might be brought to evade the proper jurisdiction of the State Court, and denying any breach of trust by the directors: *Held*, that the plea was bad. *id.*

5. Another plea was filed to the bill, alleging that the plaintiffs did not, before bringing the bill, in good faith request the directors to take legal measures to protect their rights, but by arrangement between the plaintiffs and the directors a simulated request and refusal were made, and this suit was brought by the company in the name of the plaintiffs, and denying that there had been any such refusal by the directors as amounted to a breach of trust: *Held*, that the plea was bad. *id.*
6. Another plea was filed to the bill, alleging that security holders of the same class as those made defendants had brought proceedings in behalf of themselves and all others like security holders, against the company, in a Court of the State, to enforce their security on the road, in which a decision favorable to the validity of their lien had been made, and which were pending, and setting forth the proceedings: *Held*, that the plea was bad. *id.*
7. Another plea was filed to the bill, by the party in possession of the road, alleging that it was in possession as a receiver of a Court of the State and setting forth the proceedings on which its possession took place: *Held*, that the plea must be overruled, and the case proceed to proofs. *id.*
8. In this case a demurrer to a bill in equity was sustained because the bill did not show definitely and distinctly a right in the plaintiffs to equitable relief against the defendants. *Dwight v. Smith*, 210
9. J. and others, citizens of New York, and executors in that State of G., late a citizen of New York, filed this bill to enforce liens on rolling stock,

and earnings of rolling stock, of two railroads, pledged by some of the defendants while in possession of those roads, and a corporation, their successors in possession, by consent of parties and order of a Court of the State of Vermont thereupon, for the security of several series of equipment loans, in which the plaintiffs, as executors, invested. Some of the defendants demurred on the ground that owners of the different series of the bonds had no common interest in the securities; that the bonds were not referred to as a part of the bill, nor made a part of, nor attached to, the bill; that the doings of the managers in possession prior to the possession of the corporation could not properly be joined with its doings; and that, on the face of the bill, it appeared that the Court had not jurisdiction. The corporation pleaded the proceedings of the State Court in bar of jurisdiction, part of which was a provision, in a decree in that Court, that that Court might be applied to for the realization of the securities held by the plaintiffs: *Held*, that the demurrer and the plea must be overruled. *Griswold v. Central Vermont R. R. Co.*, 212

10. The plaintiffs, although executors in New York, could sue in Vermont, their rights never having accrued to their testator. *id.*

11. The said provision for relief in said decree of the State Court did not exclude all other remedies. *id.*

12. The fact that property is being administered upon in State proceedings does not prevent citizens of other States from proceeding in the Federal Courts to establish their claims and obtain relief *id.*

13. A creditor's bill on a money decree alleged that the defendant had or had had property, without specifying any in particular. It prayed a discovery of property. It contained interrogatories making more specific inquiries, and required the defendants to answer such interrogatories as by the note thereunder written they should be required to answer, but there was no note thereunder

written. The answer denied generally that the defendant had any property, or that any was held in trust for him, or that he had conveyed away any since the decree, or before, in view of it, to defeat it. On exceptions for insufficiency, the answer was held sufficient. *Buerk v. Imhaeuser*, 274

See EQUITY, 1 to 3.

EVIDENCE, 7.

JURISDICTION, 7.

PATENT, 128.

PRACTICE, 9, 10, 12.

PRACTICE.

1. The plaintiffs in these suits, having been sued at law by the defendants in these suits, and having equitable defences to the suits at law, which could not be availed of therein, but which, if established, would warrant a perpetual stay of the suits at law, moved, in these suits, for an order that the service of subpoenas to appear and answer therein upon the attorneys for the plaintiffs in the suits at law be deemed sufficient and proper service upon said plaintiffs as defendants in these suits, they being either foreigners or citizens of California, and residents of California: *Held*, that the motion must be granted, and that a copy of the subpoena ought also to be served on the parties personally, if they could be found, wherever they might be. *Cortes Co. v. Thannhauser*, 59

2. Such a suit is not an original suit and the subpoena in it is not original process, within § 1 of the Act of March 3d, 1875, (18 U. S. Stat. at Large, 470,) and Rule 13, in Equity, does not apply to such a subpoena. *id.*

3. The defendant held to have been protected, in this case, while attending the examination of witnesses for the plaintiff, in New York, in an equity suit pending in Massachusetts, brought against him by the plaintiff, from the service on him in New York of a subpoena to appear and answer in this suit. *Plimpton v. Winslow*, 82

4. P., in a suit in equity against him

for the infringement of a patent, moved to set aside the service of the subpoena on him, on the ground that the service was made upon him while he was attending the examination of witnesses in New York on an interference depending between him and the plaintiff before the United States' Patent Office. His moving affidavits did not show where he resided or carried on business. The motion was denied. P. afterwards renewed the motion on papers showing that at the time of the service he was a citizen and resident of Massachusetts: *Held*, that the defendant had waived the objection to the service, as made while he was protected by a privilege, by not showing, on the first motion, where he resided. *Matthews v. Puffer*, 233

5. A motion for a trial before a jury, in an equity suit, on feigned issues, of certain questions of fact raised by the pleadings, was denied, no testimony having as yet been taken, and it appearing that the testimony would be, for the most part, in writing. *Herdman v. Lewis*, 266

6. In this case, after a verdict against two of the defendants for \$181,000, they applied for a stay of proceedings during the time allowed for making a case, and till further order. The applicants being in active business, the Court granted the application on their giving a bond, with two satisfactory sureties, in the sum of \$200,000, conditioned for the payment to the plaintiff of any judgment which might be rendered against them in this suit, or for the satisfaction of the judgment. *Fisher v. Meyer*, 273

7. An interlocutory decree for the plaintiff having been made in this suit, (18 *Blatchf. C. C. R.*, 237,) after a final hearing on proofs, application was now made, on affidavits, to open the decree and admit a new defence of public use of the patented article, purchased from the inventor, for more than two years prior to the application for the patent. But the witness to the use had made conflicting affidavits, and the identical article used was not produced, and the inventor

testified that the article purchased from him was not the completed invention. For these reasons the application was denied. *Munson v. The Mayor*, 358

8. A motion in this case by the defendants to have the decree opened to put in evidence additional matters of defence, was denied. *Coburn v. Schroeder*, 392

9. Before this action was removed into this Court the State Court had made an order restricting the plaintiff from setting up any cause of action in addition to one for breach of contract, on which an attachment had been granted. The plaintiff elected to consent to that order, as a condition of retaining the attachment, and it was in force when the action was removed. Nothing having occurred to change the rights or position of the parties, a motion by the plaintiff for leave to amend his complaint was denied by this Court. *Phelps v. Canada Central R. R. Co.*, 450

10. After the time for filing a plea in abatement in the State Court had expired, the defendant removed the suit into this Court, and then filed such plea in this Court: *Held*, that the plea must be overruled. *Wertheim v. Continental Railway & Trust Co.*, 508

11. In an action for a conspiracy, the jury rendered a verdict for a large sum against two of the defendants, and one for \$100 against N. N. moved to set aside the verdict, on the ground that its smallness showed that the jury did not find the issues against him: *Held*, that the motion could not be granted. *Fisher v. Meyer*, 512

12. The question whether a corporation of another State has been properly served with process in a suit in a Circuit Court cannot be raised by a demurrer to the complaint. *Robinson v. National Stock Yard Co.*, 513

See ATTORNEY, 1.

CRIMINAL LAW, 2, 8, 10, 11, 13.

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PROCESS.

See PRACTICE, 1 to 4.

PROTEST.

See DUTIES, 3.

R

RAILROAD.

1. The history given of the leases of May 20th, 1879, made by the Metropolitan Company and the New York Company to the Manhattan Company, and of the "tripartite agreement" of that date between the three companies, and of the litigation respecting said leases and said agreement, and of the agreements of October 22d, 1881, between the three companies, modifying the said leases and the said "tripartite agreement." *Flagg v. Manhattan Railway Co.*, 142
2. The agreements of October 22d, 1881, do not impair any vested rights of the stockholders of the Metropolitan Company. *id.*
3. There was no contract between the Manhattan Company and the individual stockholders of the Metropolitan Company, or between the latter company and its stockholders, that they should have a dividend of 10 per cent. per annum on their stock. *id.*
4. The directors of a corporation have a general power to make and modify its contracts, and its stockholders cannot control that power, nor was it necessary to the validity of the agreements of October 22d, 1881, that they should have been approved by any one or more stockholders. *id.*
5. The Act of April 23d, 1839, (*Laws*

of New York, 1839, chap. 218, p. 195,) authorized the making of the said leases and agreements. *id.*

6. The new agreements were made in good faith and with a fair exercise of the judgment and discretion of the directors of the Metropolitan Company. *id.*

See NEGLIGENCE, 1 to 3.

RECEIVER.

1. A receiver of "all the estate, property and equitable interests" of an insolvent banking corporation, created by the State of Illinois, cannot enforce against a stockholder in the corporation the liability imposed by the statute of Illinois on each stockholder for double the amount of his stock, such liability being one in favor of creditors of the bank and not in favor of the corporation. *Jacobson v. Allen*, 525

REMOVAL OF SUIT.

1. This case was remanded to the State Court because the petition for removal was not filed before or at the term at which it could be first tried. *Traders' Bank v. Tallmadge*, 39
2. This Court is to pass on such question even though the State Court passed on it. *id.*
3. S., a citizen of New York, brought a suit in the State Court against R. and C., citizens of Massachusetts, and J. and M., citizens of New York. R. and C. removed the suit into this Court. There being a separate controversy between S., on one side, and R. and C., on the other, to which J. and M. were not necessary parties, and which could be fully determined as between the parties to it without the presence of J. or M.: *Held*, that the suit was removable under § 2 of the Act of March 3d, 1875, (18 U. S. Stat. at Large, 470.) *Stevens v. Richardson*, 53
4. No prior notice to the adverse party of the presentation of a petition for removal is necessary. *id.*

5. A bond on removal is not required by § 3 of said Act to be executed by the petitioner for removal, if it be executed by sufficient surety. *id.*
6. A party does not, by voluntarily appearing in a suit in a State Court, waive his right of removal. *id.*
7. A motion that the plaintiff replead in this Court denied. *id.*
8. This suit was brought in a State Court of New York, against the receiver of a New Jersey railroad corporation, to recover damages for the death of the intestate of the plaintiffs, caused in New Jersey, by a train on the railroad of the corporation, while it was being operated by the receiver. The complaint alleged a liability under a New York statute and permission given by the said State Court of New York to sue the receiver. The answer alleged the appointment of the defendant as receiver by a Court of New Jersey, and his subsequent appointment by the said State Court of New York as receiver of the property of the corporation situated in New York, and that he operated the road as a New Jersey receiver. Afterwards, the defendant, as a citizen of New Jersey, the plaintiffs being citizens of New York, removed the suit into this Court, the State Court making an order of removal. The case was then tried by a jury in this Court, the plaintiffs being first allowed to amend their complaint by setting up, in addition, as a cause of action, a statute of New Jersey, and the defendant to amend his answer by setting up the order of the New York Court granting leave to sue and alleging that there was no other leave to sue. The Court held that the complaint must be dismissed because it set forth no cause of action against the defendant as a New York receiver, and because there was no leave to sue him as a New Jersey receiver. No order or judgment to that effect having been entered, the plaintiffs moved to remand the cause to the State Court: *Held*, that the removal was proper, when it was made, and that adding in the complaint the allegation as to the New Jersey statute did not affect the jurisdiction of this Court. *Davies v. Lathrop*, 397
9. In a suit in a State Court in New York, issue was joined by serving an answer which did not require a replication. Thereupon the plaintiff noticed the cause for trial, and placed it on the calendar in due season for a term. After the commencement of the term, but within 20 days from the service of the original answer, the defendant served an amended answer, having the right to do so as of course, subject to its being stricken out if served for delay and for causing the loss of a term. The amended pleading, if not stricken out, superseded the original answer and nullified the notice of trial. The plaintiff, if the cause had been reached before the amended answer was served, had a right to try the cause, and thereafter the amendment could not be made. After the term the defendant filed a petition for the removal of the cause into this Court: *Held*, that the petition was not filed before or at the term at which the cause could be first tried, within the Act of March 3d, 1875, (18 U. S. Stat. at Large, 471.) *Cramer v. Mack*, 479
10. A plaintiff, by delaying for over a year after the removal of a cause, before moving to remand it, loses his right to insist that the petition for removal was not filed in time. *Miller v. Kent*, 508

See JURISDICTION, 7.
PRACTICE, 9, 10.

S

SALVAGE.

1. In this case a service rendered by one steamer to another steamer, in towing her into port, after she had broken her steam machinery at sea, was held to be a salvage service. *The Leipsic*, 288
2. Notwithstanding a written agreement made at sea between the masters of the two steamers, that the disabled steamer should pay £3,000 for the service, but which agreement con-

tained the words "but leave it to the Court to prove the said agreement," this Court awarded as a salvage compensation, on a *quantum meruit*, \$5,500, giving to the owners of the towing steamer \$4,125, to her master \$150, and dividing the remaining \$1,225 among her master, officers, and crew in proportion to their respective wages, although the owners of the towing steamer had sued on the agreement alone, and not for salvage for owners, master and crew. *id.*

3. The District Court had awarded \$8,750, of which the owners of the towing steamer were to have \$2,250, her master \$150, and her master, officers and crew \$1,350, and, as both parties appealed to this Court, this Court awarded to the libellants costs in the District Court, because the claimant had made no tender, and awarded no costs in this Court to either party. *id.*

4. An average bond, after reciting that a vessel, with a cargo, had been stranded, and that the Coast Wrecking Company's vessels and men were sent to her, and her cargo was being discharged, authorized the vessel's owners to settle the salvage for any sum agreed upon between the salvors and underwriters, or to be awarded by a Court, and stated that losses and expenses had been and might be incurred, which, according to the usage of the port of New York, might constitute a general average, to be apportioned on vessel, freight and cargo, and other charges incurred might be due from specific interests, and thereby the signers agreed with J. & H., average adjusters, "that the loss and damage aforesaid, and other incidental expenses thereon," should be paid by them ratably, according to their interests in vessel, freight and cargo, if stated and apportioned by J. & H., in accordance with the established usage and laws of the State in similar cases. A libel in Admiralty, founded on the bond, was filed by the salvors and J. & H., against an insurer of cargo, a signer of the bond. The libel, in reciting the bond, recited it as one applying to an apportionment of only general

average expenses. But, the bond was in evidence, and in the answer the respondent submitted to the Court the question of the proper amount of salvage. There was no exception to the joining of the two claims in one libel. The respondent objected that the Admiralty had no jurisdiction, because the suit was one for general average charges; that there were no general average expenses, because the voyage of the vessel was abandoned; and that the claim of J. & H. was not one of Admiralty jurisdiction: *Held*,

(1.) The bond covered the services and disbursements of J. & H.;

(2.) It covered general average losses and expenses and other charges in respect to salvage and rescuing the cargo, and the services and expenses of J. & H.;

(3.) The services and expenses covered by the bond were those which, if performed and incurred by the owner of the vessel, would have been within his duty to save the cargo, and such duty would have extended to the services and disbursements of J. & H., which would have been maritime;

(4.) The bond was an express contract for a maritime service. *Coast Wrecking Co. v. Phenix Ins. Co.*, 557

5. As salvage, 50 per cent. of the value of the property saved was awarded. *id.*
6. The equipment and readiness of the vessels of the Coast Wrecking Company to save property, considered, in fixing the amount. *id.*

SEQUESTRATION.

1. Rule XI of the Circuit Court for the District of Vermont, providing that "the creation, continuance and termination of liens and rights created by attachment of property, or the arrest of a defendant, shall be governed by the laws of this State," covers the issuing and serving of a writ of sequestration in a suit in equity in the Circuit Court, after an interlocutory decree for the plaintiff, in a suit in equity for the infringement of letters patent, for an account of profits,

under which writ real estate of the defendant in the writ is attached, to be held as security for a final recovery, and the Circuit Court had power to make such Rule, applying to suits in equity. *Steam Stone-Cutter Co. v. Sears*, 23

2. Service of such writ by a return of attachment on a copy of it lodged in the town clerk's office where the town records are kept, without possession, is sufficient to create a lien on the real estate. *id.*

3. The writ is, in effect, strictly an attachment to create a lien. *id.*

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SUPERVISOR OF ELECTION.

1. The Court being required, by § 2,012 of the Revised Statutes, to appoint, in each election district, two supervisors of election "of different political parties," and there being a dispute as to who should be appointed from the Democratic party in the city of New York, the Court selected persons recommended by "The New York County Democracy." *In re Supervisors,* 13

T

TAX.

1. The Act of the Legislature of New

York, (*chap. 271, Laws of 1881, p. 382,*) purporting to validate certain assessments on shareholders in National and State banks in the city of Albany, is void, because it denies the shareholders a right to be heard, and makes a legislative assessment of a tax upon them without apportionment or equality, as between them and the general class out of which they are selected, or as between themselves. *Albany City Nat. Bank v. Maher,* 341

2. No tender of any sum for a tax is necessary in the case of a void assessment. *id.*
3. The shareholders having a right to sue the bank if it pays the tax or withholds their dividends, the bank can sue to enjoin the collection of the tax. *id.*

TOWN BOND.

See MUNICIPAL BOND.

TRADE-MARK.

1. A label on a bottle upheld as a trade-mark, in connection with the size, color, shape and material of the bottle, and held to have been infringed. *Hustetter v. Adams,* 326
2. The general effect to the eye of an ordinary person acquainted with the plaintiffs' bottle and label, and never having seen the defendants' label, and not expecting to see it, was, on seeing the defendants', to be misled into thinking it was what he had known as the plaintiffs'. *id.*
3. The differences which he would see on having his attention called to them were not of such a character as to overcome the resemblances to the eye of a person expecting to see only the plaintiffs' bottle and label and having no knowledge of another. *id.*

4. Prior to 1834, S. W. Collins, D. C.

Collins and another, copartners as Collins & Co., made edge tools, using as a trade-mark "Collins & Co." In 1834 they assigned to the Collins Manufacturing Company, a corporation, the right to such trade-mark. In 1843 the right to make all articles of metal was conferred on the corporation and its name was changed to the Collins Company, the plaintiff. It always stamped "Collins & Co." on its productions. In 1856 the firm of Oliver Ames & Sons began to put the stamp and label "Collins & Co." on shovels made by it, and sent to Australia. The plaintiff had not up to that time made shovels, but it had a market in Australia for the articles it made and stamped "Collins & Co." The object of Oliver Ames & Sons in putting the stamp "Collins & Co." on the shovels was to avail themselves of the credit and reputation and market which the plaintiff had established for itself, for articles stamped "Collins & Co." The plaintiff, at the time of bringing this suit, had not sent or sold any shovels to Australia. The defendant, in succession to Oliver Ames & Sons, continued to do what the latter so began to do in 1856: *Held,* that the acts of Oliver Ames & Sons and of the defendant were always unlawful. *Collins & Co. v. Ames & Sons,* 542

5. The plaintiff having had, from 1843, the right to make all articles of metal, and having gone on, from that time, both before and after 1856, extending its manufacture beyond edge tools into digging tools, such as picks and hoes, and having always put the mark "Collins & Co." on its best quality of articles, the fact that it did not before 1856 make a digging tool such as the shovel on which, in 1856, Ames & Sons put the mark "Collins & Co." does not warrant the conclusion that that mark was not, in 1856, the mark of the plaintiff's trade in respect to such shovels. *id.*

TRIAL.

See NEW TRIAL.
PRACTICE, 11.

V

VERDICT.

See PRACTICE, 11.

VESSEL.

See COLLISION.

W

WITNESS.

See EVIDENCE, 1.
PRACTICE, 8.

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